THE BRANDING OF THE AMERICAN MIND

How Universities Capture, Manage, and Monetize Intellectual Property and Why It Matters

JACOB H. ROOKSBY

VISIT…

The Branding of the American Mind

Critical University Studies
Jeffrey J. Williams and Christopher Newfield, Series Editors

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Jacob H. Rooksby

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To Foster—Dream big, and never settle

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Preface

Over the past two decades, intellectual property has precipitated a kind of gold rush for American colleges and universities. But there is a contradiction in higher education's effort to take advantage of intellectual property: one of this sector's historical aims is to serve the public good, but accumulating private rights seems to lead in the opposite direction. As colleges and universities turn to intellectual-property rights as vehicles for revenue generation, commercialization, and brand protection, their public orientation is at risk of being fundamentally recalibrated, in troubling ways.

How can the accumulation and enforcement of private rights further the public-interest sphere of higher education? What is to be gained and lost as institutions become more guarded and contentious in their orientation toward intellectual property? This book uses a mixture of methods to grapple with these central questions, employing the perspective of research in law, higher education, and the social sciences to expose and critique higher education's unquestioned and growing embrace of intellectual property.

This volume identifies higher education's root problem with intellectual property, which is the mounting love affair of its institutions with intellectual property itself, in all its dimensions: patent and copyright, as well as even-newer forms of intellectual property and related rights that are less tied to scholarly output and often less familiar to members of colleges and universities, such as trademarks, trade secrets, Internet domain names, and publicity rights. The result is an unwelcomed challenge to the public-interest aspect of higher education. While the creation and dissemination of knowledge

always have been at the center of the identity and the mission of its institutions, using intellectual property as a vehicle for asserting claims to private rights and rigorously enforcing them—in a manner that mimics the norms used by for-profit actors—is a relatively new and, as I argue, precarious phenomenon for higher education.

The Branding of the American Mind deals with the law, but I have written it to be read more broadly, by those interested in the state of higher education. It requires no background knowledge about intellectual property, which is why I explain laws, legal principles and rules, and developments in plain English. Publications about the law and legal issues, often dense and filled with much legalese, tend to inspire fear and dread in would-be readers without law degrees. To the uninitiated, they often read more like treatises or tomes than accessible, thought-provoking, or relevant works. This volume is different. While I am a lawyer by training, whose scholarly and legal-practice interests revolve around intellectual-property law, this is a study written primarily for nonlawyers.

Most people charged with handling institutional policy and practice in higher education are not lawyers and are unlikely to have had much exposure to how intellectual property works. Yet everyone involved—from trustees, administrators, faculty, student-affairs professionals, and students who study higher education—needs to know why intellectual-property law and policy matter in their spheres of interest. For them and for readers outside these areas, I use clear terms to explain why intellectual property is important in higher education—too important, in fact, to blindly trust its leaders to adequately resist temptations in this regard and make choices on their own that benefit us all.

This book is situated within a growing field, or movement, that has been called Critical University Studies, essentially a genre of analysis and critiques that takes the modern university as its subject, and whose adherents include scholars across various disciplines.[1] Critical University Studies recognizes that leadership within the modern university increasingly is marked by administrative managerialism, as opposed to faculty-centered shared governance, which

is higher education's traditional mode of power and authority. To those who study and write in this field, the modern university is not a neutral institution, indisputably devoted to furthering the public good in all that it touches.[2] Rather, Critical University Studies sees the modern university as a site of struggles and contests between those with different views of its future. Legal issues often serve as fault lines in competing visions of a university, and in that respect, this book's subject is no different.

My approach is observational, and often oppositional, but it is not intended to be alarmist. Intellectual property and intellectual-property laws are not the core problem; the issue here comes in what forms of intellectual production higher education institutions choose to protect, and how they go about providing and enforcing this protection. A central tenet of this book is that intellectual property is too important, and too rife with public policy concerns for all of us who care about higher education, to be left purely to the province of lawyers, whether they are in-house attorneys for colleges and universities, or lawyers in firms that advise clients in this sector. The uses and potential abuses of intellectual property in higher education should concern us all, and this volume explains why, delving across the range of intellectual-property disciplines in both traditional and allied areas. In short, everyone needs to understand the role intellectual property plays in higher education, particularly if the latter is to stay true to its intended purposes.

I recognize that for some, the mere term "intellectual property" can be off-putting, even intimidating. These words often conjure positive reactions of "I hear that's hot these days" or "I know it's an important topic," as well as being counterbalanced by doubtful thoughts or comments, along the lines of "But I'm not a scientist" or "I'm not a lawyer, so I can't fully speak to it." Some even confuse IP (intellectual property) with IT (information technology), thinking the two are synonymous; in reality, the terms are unrelated. Many believe that a lack of specialized knowledge precludes them from understanding intellectual property's basic tenets; it emphatically does not.

While chapter 2 provides some background information about intellectual-property law, my book does not aim to make its readers fully conversant with every legal dimension and nuance of the various principles and rules in the field of intellectual-property law. Instead, it uses qualitative, quantitative, and legal data as a lens through which to look at and understand the important policy ramifications of intellectual-property activity in higher education, particularly from the standpoint of institutional choices and decision making.

At the outset, I want to mention that I am an intellectual-property populist, not a purist, in the sense that I believe intellectual property impacts everyone and, for that reason, should be open to discussion and debate by all. As I like to tell law students taking my introductory course on intellectual property every fall, you do not have to think of yourself as an intellectual to understand and appreciate intellectual-property law. Once viewed as a highly technical and specialized field, whose practitioners often did everything they could to keep it that way, intellectual property now has fully emerged into public consciousness, with its importance in the global knowledge economy frequently making the daily news. The world's largest and often most prominent employers trade in knowledge and ideas, and the value of these commodities lies in their being protected. We need look no further for justification of this concept than to the prolonged battles involving the smartphone industry, and the substantial monetary judgments that resulted in some of those cases.[3]

Chapter 1 situates the central theme of *The Branding of the American Mind* within the larger narrative of private rights and public goods in higher education. The chapter opens with a story involving patent rights, and the concerns identified in it are far reaching, involving all areas of intellectual-property law, as well as allied topics.

Chapter 2 provides an in-depth look at the bedrock legal doctrines that underlay the investigations and discussions in subsequent chapters. This chapter is geared toward those who are new to the concept of intellectual property or who may desire a quick refresher regarding the key principles in this dynamic and often complex area of the

law. The general ways in which the legal doctrines of intellectual property impact higher education are highlighted throughout this chapter.

Chapter 3 starts by providing a narrative history of trademark use in higher education. Relying on historical data concerning federal trademark-registration activity, this chapter considers the phenomenon I call "trademark-rights accretion" in higher education, which has sometimes led to instances of questionable enforcement activity. It also discusses many of these misguided enforcement pursuits.

Chapter 4 considers patenting and licensing activities in higher education. While this topic is so immense that it probably deserves a book of its own, I focus here on three main issues of significant policy relevance: (1) the impact of licensing decisions made by universities; (2) university enforcement of patent rights through infringement litigation; and (3) university involvement in lobbying efforts regarding patent law.

Chapter 5 examines issues surrounding copyright ownership on campus, paying special attention to situations that pit ownership claims by institutions and corporate sponsors against those of students and faculty. Student entrepreneurship, corporate sponsorship of classes, and digitization trends involving humanities scholarship and special-collections materials in libraries form the major part of this chapter.

Chapter 6 looks squarely at the ascendance of brands in higher education. It considers a variety of brand-related trends within this sector, involving an array of intellectual-property and allied doctrines. I discuss ways in which trademark interests are fueling name changes in university technology-transfer offices, the promotion of institutional slogans, and contentious arbitration actions that are designed to obtain new and different Internet domain names. I also review how universities have usurped, for their own use and benefit, student-athletes' publicity rights, as well as how and why institutions are turning to the concept of trade secrecy as a means of building their brands.

Chapters 3 through 6 each begin with illustrative stories (much like the one that opens the first chapter) that help frame the main

issues and concerns explored in these chapters. Their goal is to help portray the human dimensions and impacts that are behind nearly every effort by institutions of higher education to claim intellectual property, protect it, and enforce private rights to it. Each of these chapters concludes with reflections on the predominant tensions presented in the chapter, highlighting how higher education has either failed or struggles to use private rights, in the form of intellectual property, to further the public good.

In sum, these chapters identify in detail the problematic practices occurring in higher education involving intellectual property, which should result in a question in readers' minds—what can be done to curb these practices and change these trends? Chapter 7 reviews those problems, provides suggested answers, and ends with a call to action. My proposed solutions entail everything from developing the specific best practices I recommend; to changing intellectual-property laws in ways that would benefit students, faculty, and institutions; to creating a new position within higher education institutions that would recognize the importance of the academic and policy dimensions of intellectual property, as opposed to simply the legal dimensions of the topic. In short, chapter 7 defines a path forward if colleges and universities are to fulfill their potential to utilize intellectual property in the public interest.

What may not be clear from this brief outline are those topics that I have left untouched. This is not a book about the politics or general history of intellectual property in higher education, nor does it address in detail the dynamics of the decision-making processes that occur in higher education regarding intellectual property. Each of these issues is important, and the present study hopefully will provide subsequent authors with additional fodder for contributing to those dialogues. Even from a legal perspective, comprehensive coverage has been sacrificed in certain areas in this volume, either because other writers have already addressed the salient issues or because those areas have less to do with the fundamental conflict identified in my book: the commitment institutions of higher education have to the public ver-

sus the competing enticements they face to create and enforce intellectual-property rights for predominantly private purposes.

This volume provides data and stories about higher education's interactions with intellectual-property law and the sometimes ill-conceived policies and practices that have emerged from those activities. My goal here is to present a lawyerly assessment of how colleges and universities choose to engage with intellectual property, using the legal protections available to them. I encourage others from disciplines outside of law—informed by valuable outlooks and frameworks in fields such as politics, history, and organizational theory—to add to our understanding of these decisions and activities. I make no claim to offer any comprehensive, nonlegal perspective in these pages. My intent is to convey the details and the nuances of the intellectual-property choices that institutions of higher education are making, so readers across and even outside of this sector will come to understand the temptations, the constraints, and the opportunities that these institutions face in this important and growing arena.

Intellectual property is a means, but it is not the end in higher education. Intellectual-property laws enable certain forms of rights to be created, but they do not dictate what is done with the rights that are claimed. My goal is that by understanding intellectual property's form and function in higher education, we might better assess the priorities of modern universities, to ensure that they align with society's expectations of what it means for higher education to serve the public interest.

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Acknowledgments

This book started in 2007, as a dream in my head. At that point, universities were adrift, and even out of control, in their uses of intellectual property. They needed fresh advice and clarity of purpose.

As happens with most dreams, this one did not seem real. I was a junior attorney in private practice with a large law firm in Richmond, Virginia. Writing a book on intellectual-property issues in higher education was more of a vague aspiration at that time. As it turns out, I did not even fully appreciate the entire extent of the issue. But the pursuit of it kept me captivated, leading me back to the University of Virginia in 2010, where I had received my law and master's degrees not too long before. There, on the grounds of Thomas Jefferson's *second* university, I had the good fortune of working with several top-flight scholars. Two people in particular, Brian Pusser and Madelyn Wessel, provided mentorship and friendship that fed and nourished this dream at every turn. Their contributions to my academic career cannot be understated.

Since those days, my life's project has been to keep the dream alive through a series of ongoing discussions, interactions, and collaborations with a host of people whom I consider kindred spirits on this personal and intellectual journey. At the top of that list are two fellow legal scholars, Peter Lake and Michael Olivas, whose frequent support and willingness to welcome my contributions to the fields of law and higher education sustained me at various stages of this project. Both have been exceedingly generous with their time and insights, and for that I am thankful. Bill Kaplin and Bob O'Neil are of the same stripe, and each provided additional warm support along the way.

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Outside of Duquesne University, I have two other affiliations that have contributed to my work in positive ways: the University of Pittsburgh School of Education, where I am an adjunct professor, and the law firm of Cohen & Grigsby, P.C., where I am of counsel. My thanks to Linda DeAngelo and Noland Cheung for welcoming me into each of those two organizations, respectively.

I would be remiss if I did not recognize Kathleen Capels, the book's copyeditor, whose careful work improved the final product immensely. Greg Britton, my acquisitions editor at Johns Hopkins University Press, also deserves recognition for the unflagging enthusiasm he showed for this project. He took a chance on a new author, and for that I am grateful. An added bonus was the professionalism and persistent good humor he demonstrated throughout the publication process. As he told me (doing his best to sound like an attorney) when I missed my first submission deadline, "Jacob, if I could sue you, I would." Missing a deadline never felt so good!

The work that appears in these pages represents years of devotion to the broader topic. Portions of this book first appeared in other venues, including *Academe*, the *Chronicle of Higher Education*, the *Yale Journal of Law & Technology*, the *Harvard Journal of Law & Technology*, the *Akron Law Review*, the *Brooklyn Law Review*, the *Duquesne Law Review*, the *Missouri Law Review*, and the *Review of Higher Education*, as well as in a few edited volumes. I thank the editors of those publications for including my work within their pages. I also thank the following organizations and institutions for providing me with the opportunity to test out my ideas on their members and audiences: the Association for the Study of Higher Education (ASHE); the Association of University Technology Managers (AUTM); the Pittsburgh Intellectual Property Law Association (PIPLA); the Federal Reserve Bank of Cleveland; Cleveland-Marshall College of Law at Cleveland State University; Indiana University's Robert H. McKinney School of Law; the University of Houston Law Center's Institute for Higher Education Law and Governance; the Pennsylvania State University's Center for the Study of Higher Education; Duke University's Sanford School of Public Policy; the University of Virginia's Curry School of Education; the University of Akron School of Law's Center for Intellectual Property Law and Technology; and the Stetson University College of Law's Center for Excellence in Higher Education Law and Policy.

Finally, I thank my wife and daughter for all that they do to bring joy and happiness to my life. I treasure you both every day.

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The Branding of the American Mind

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Chapter One

Intellectual Property, Higher Education, and the Public Good

Of Mice and Money

The 1980s were an important decade for intellectual property and a momentous decade for American higher education. Deregulation and neoliberal economic policies led to increased commercial activity for both business firms and institutions of higher education. More students than ever before were seeking some form of higher education, and this sector grew to meet the new demand. Spending increased as competition between institutions became more national in scope. At the same time, opinions issued by the courts and lessened regulations led actors in the marketplace to sharpen their focus on intellectual property and its potential for income generation.

Enter the OncoMouse, a proprietary mouse designed to aid medical research.[1] In the early 1980s, researchers at Harvard Medical School and the University of California San Francisco produced a genetically modified mouse that was highly susceptible to cancer, through the introduction of an oncogene that can trigger the growth of tumors. The National Institutes of Health and E. I. du Pont De Nemours (DuPont), the multinational chemical firm, funded the research.[2] The mouse held enormous potential as a research tool. Sensing a vast market for the discovery, the researchers provided information about their invention to Harvard's office of technology transfer, which, in turn, sought patent protection for it in 1984. Four years later, in 1988, the United States Patent and Trademark Office issued a patent to Harvard for the OncoMouse, the first patent issued for a transgenic animal. The patent provided Harvard with rights

not just to the OncoMouse (a coined word that DuPont protected as a trademark in 1992), but also to other transgenic mice and nonhuman mammals.[3]

Harvard's decision to seek patent protection for the OncoMouse, and its receipt of a patent on the discovery, was a watershed moment in the history of academic science and intellectual property. The United States Supreme Court had recently decided, in 1980, that "anything under the sun made by man" was eligible for a patent, even if it was a living organism.[4] Harvard's OncoMouse patent confirmed that edict, even if the university did not fully appreciate the ramifications of the patent at that time. On the one hand, the transgenic mouse held great potential for scientific development improvements in human health. Researchers could use it to better study cancers and cancer-fighting treatments. Protecting the OncoMouse by means of a patent would help ensure that investors could bring this new, living research tool to market. On the other hand, how would the public best benefit from the private rights that Harvard and DuPont sought and received for the OncoMouse, in the form of a patent and a trademark? The public's access to the mouse, and its ultimate utility, could be limited without careful protections and informed decision making by the university.

Harvard chose to license the patent to DuPont on an exclusive basis, meaning that only DuPont could sell the OncoMouse. Any other party attempting to create its own version of the mouse would infringe on the patent unless it paid DuPont a licensing fee. With its exclusive authorization to control the use to this groundbreaking discovery, DuPont was able to set license terms that benefited the chemical company's shareholders, not necessarily researchers across the world who wanted to use the OncoMouse. As one scholar noted, in assessing Harvard's use of its patents, "standing on the shoulders of the OncoMouse would come at a considerable cost."[5]

The terms DuPont imposed on academic licensees were onerous. First, it cost $50 to purchase one OncoMouse, roughly ten times the price of other experimental mice. Second, the standard license agreement prohibited licensees—academic institutions and their

faculty—from sharing the OncoMouse with anyone, as researchers commonly did prior to this time. Third, DuPont required licensees to report any and all research findings related to the OncoMouse to DuPont. Fourth, and most controversially, DuPont insisted on "reach-through" rights, meaning that DuPont would receive a percentage share of any sales or proceeds from a product or process developed by a licensee using an OncoMouse. In short, if a researcher developed a cure for a form of cancer through research conducted on an OncoMouse, DuPont would stand to financially benefit from that scientist's discovery.

Academic researchers and others within the scientific community found these license terms unpalatable. Yet more than 100 universities signed license agreements with DuPont, fearing that their faculty would be unable to keep pace with scientific innovation if they were denied access to the OncoMouse. Despite the fury over the patent and DuPont's strict enforcement of it, others within academia began to see firsthand the power that private rights can bestow in discoveries that affect the public. Many of the scientists who disliked DuPont's approach to licensing soon sought patents for their own work, either to accelerate or forestall similar profiteering results.[6]

Harvard's OncoMouse patent is believed to be one of the most valuable pieces of intellectual property ever created.[7] Perhaps for that reason, neither Harvard nor DuPont has ever disclosed the nature of the royalties each has received from sales of the OncoMouse. Conservative estimates place the dollar amount in the tens of millions. What we do know is the extent to which Harvard and its exclusive licensee have used the court systems, domestically and abroad, to seek and protect patents for the OncoMouse. For example, Harvard spent over eighteen years attempting to obtain patent protection on the OncoMouse in Canada, which it finally achieved, albeit in limited form, in 2003.

In the United States, Harvard's rights to the OncoMouse only ended recently, in 2014, thirty years after it first filed a patent application on the discovery in 1984. Harvard followed this initial application with two more, filed in 1988 and 1991. Making additional filings related

to the same invention is a common practice at the patent office, even if it does not always bear fruit for the applicant. Patent protection does not last forever, so extending the life of a patented invention can be a goal of applicants making additional filings. When Harvard filed its patent applications, patent protection lasted seventeen years from the date of issuance. Later-in-time applications result in later-in-time issuance dates, which means that the seventeen-year protection clock would start afresh at a later date if Harvard sought and obtained more patents.

Thus Harvard faced a choice: to allow its rights in the OncoMouse to rest on only one issued patent, or to attempt to prolong and even broaden those rights by seeking additional patents. Harvard chose the latter course of action. If the institution could obtain additional patents, based on new claims that covered other features of the OncoMouse, then the protection of Harvard's rights to it could extend past the expiration of the first patent, which was set to occur in 2005. That is exactly what Harvard sought to do with its second and third applications.

Unfortunately for Harvard, the patent office did not feel that its second-in-time application actually described a new invention, above and beyond what was included in its first patent, as the law requires. Instead, the patent office felt that the second application only covered obvious variations on claims contained in the first patent. Rejections issued for this reason are known as "obviousness-type double-patenting rejections," which means that the patent office considers the claims in a second patent application insufficiently distinct from the claims in the applicant's earlier patent, so it would be unfair to award the applicant a new patent that has an expiration date further into the future than the first patent's expiration date.

The only way in which an applicant can overcome this type of rejection is to file what is known as a "terminal disclaimer" with the patent office. This disclaimer allows the second application to mature into a patent, but the applicant must disclaim, or give up, the time period for the later-issued patent that would extend beyond the ending date of the earlier patent. In short, if an applicant agrees to a terminal

disclaimer, that applicant will receive a patent, but the second patent will expire on the same day as the first patent.

Harvard was forced to file a terminal disclaimer on its second application, which matured into a patent that was issued in 1992. Ordinarily, the term of the second patent would have extended to 2009, but because of the terminal disclaimer, this patent expired at the same time as the first, in 2005. Harvard's third patent application related to the OncoMouse was issued in 1999, leading Harvard to believe that this patent would remain in effect until 2016. Therefore, DuPont could continue to sell the OncoMouse at inflated prices, even after the first two patents expired in 2005. In 2010, however, an anonymous third party requested that the patent office reexamine the third patent, as a way of challenging its validity. The patent office, in its review, held that Harvard's third patent had expired, because the terminal disclaimer in its second patent was worded in such a way as to cover the third patent, too.

Harvard appealed the patent office's decision in a federal trial court, which ruled in favor of the patent office at an early stage in the case.[8] Harvard then appealed that decision in a federal appellate court that specializes in patent law, which again rejected Harvard's arguments.[9] At all levels, Harvard took the improbable position that the terminal disclaimer was not valid, because Harvard never paid the patent office the terminal disclaimer fee required by law. Essentially, Harvard's argument was that the law does not apply to its later applications, because the institution did not comply with the law. Harvard advanced this argument even in light of documentary evidence from its patent attorney, who, in corresponding with the patent office about the second application back in the early 1990s, had stated in a letter, "Accompanying this disclaimer is the fee set forth [by statute]."[10]

Harvard's efforts to expand the time period for its third patent on the OncoMouse are emblematic of the lengths to which many institutions go to claim, defend, and extend their intellectual-property rights. These activities can be complex and nuanced to those unfamiliar with intellectual-property laws; nonetheless, they are well

worth examining. Some institutions would much prefer that we give them a free pass, overlooking how they employ intellectual-property laws as they face important policy decisions that affect us all. In their interactions with the public, these same institutions often try to couch their uses of intellectual property in ways that make them sound more noble or innocuous than they really are.

Make no mistake about it—Harvard's position in its case was about protecting a valuable property right. Every year that the OncoMouse remained under patent meant additional revenues for Harvard and DuPont. Harvard's attempt to prolong the period during which it and DuPont could generate revenue from sales of the OncoMouse goes to the heart of the tension identified in this book: how do, or should, public-serving institutions of higher education use private rights in the public interest? Even though intellectual property that is developed within the bounds of higher education unquestionably can serve as a means of income generation for institutions and individuals alike, its ties to the public's welfare and our conceptions of higher education as working in the public's interest make the topic too important to ignore.

Hanging in the balance in Harvard's actions concerning mice and money was their effect on the public interest—in other words, on how our society would benefit (or lose) by the ways in which public-sector entities like universities use the intellectual-property rights they claim. Over thirty years ago, the public helped pay for the research that led to the discovery of what would come to be known as the OncoMouse. While the law permits Harvard and other universities to benefit from research conducted by their faculty, this benefit is intended to have a fixed and limited duration, not the extended period of protection that Harvard sought and more or less obtained. We reasonably might wonder what the public stands to gain when institutions of higher education use intellectual-property laws to engage in such sharp practices.

While Harvard's experience with the OncoMouse patents was a singular event, the tensions and opportunities it faced are not unique to this institution. Curbing invitations to indulge in intellectual-

property excesses is a problem at all levels of higher education, not just its highest echelons, as this sector as a whole has strayed too far in the direction of championing intellectual property. The private rights that intellectual-property protections afford can be tempting vehicles for institutions in their fierce competition for resources and rewards. As this book explains, the challenge for higher education lies in using these private rights as instruments primarily directed at furthering the public good, not impeding it.

Public Goods and Private Goods: Higher Education and Intellectual Property

Higher education and intellectual property have a long and complicated interrelationship. For some time, the former's dominant historical narrative has been that higher education is an inescapable public good, in large measure because of the intellectual fruits it produces for society as a whole.[11] This sector accomplishes its noble goals by serving as a site for unfettered research and discovery, a place where intellectual boundaries are pushed, new theories are produced and debated, and new knowledge is disseminated to the public in various forms: books, conferences, innovative products, and more-intelligent citizens. The conception of higher education as a special sector, set apart from others, reflects the bargain that society strikes with higher education regarding its intellectual capital: storing, creating, and disseminating new knowledge is a difficult but important undertaking, one that must be reasonably free from state-imposed restrictions and directives, lest the pursuit of truth suffer. In short, higher education deserves special treatment—in the form of tax subsidies and unparalleled freedom for its faculty to establish, pursue, and monitor their own research agendas—precisely because of the intellectual benefits to society that flow from higher education's principal undertakings: research, teaching, and service.

An economic and political narrative emerging with increasing force, one that is discussed at length in this book, is that intangible assets—such as the intellectual outputs in higher education—require the allowance of some form of ownership for their highest and best

value to be realized. In the United States, the genesis of this concept dates back to the formation of our country, when the Founding Fathers believed it important, in order "to promote the Progress of Science and useful Arts," to provide authors and inventors with exclusive rights to their writings and discoveries.[12] This clause of the Constitution, now referred to as the intellectual-property clause, paved the way for the subsequent enactment of patent and copyright laws aimed at encouraging the disclosure of valuable inventions and works whose creators otherwise might not choose to share them with the world. This exchange between society and individuals was intended to be mutually beneficial: society obtains knowledge it might otherwise not have received, while the individual receives a limited but private right to exploit that knowledge for a fixed period of years. This aspect of our democracy has been lauded as creating the appropriate amount of incentives for inventors and authors to undertake work that is laborious yet speculative, in the sense that without such inducements, it could never pay off. The historic theory at the heart of our intellectual-property system is that public good flows from establishing the possibility of granting private rights to those who make important scientific and artistic contributions to society.[13]

In modern times, this theory has been complicated by additional rationalizations for the existence of intellectual-property protection, particularly in areas outside of copyrights and patents. Reducing consumer confusion, recognizing brands to encourage investment in them, promoting start-up movements by marketplace actors, and rewarding labor have all been tendered as plausible justifications for intellectual property. Whatever the rationale, an enduring premise of the recognition and protection of intellectual property is that some intangible creations can be owned, and the legal system should accommodate ownership, and the right to sell or transfer these goods, in order to benefit us all.

Every story in this book is undergirded with these two competing narratives: the public's interest in higher education (that is, what accrues to the public from it), and the private interest individuals and entities have in intellectual property. Because of its research and ser-

vice functions, higher education is designed to generate scientific discoveries and artistic contributions. These creations unquestionably further the public good, but so can the ownership and restriction of them. The question becomes, to what extent must higher education's fruits be owned or claimed in order for the public to benefit the most? More to the point, among everything that higher education produces or views as *intellectual*, what should be styled intellectual *property*?

This book lays out how the private-rights aspect of intellectual property is on the rise in higher education, often to the detriment of this sector's long-standing narrative of providing for the public good. One of my main arguments is that much of what can be assigned as intellectual property in higher education is being claimed by its institutions, with the interests of the public being harmed in the process.

It is important to emphasize that these two, seemingly divergent constructs are not new, nor are they mutually exclusive. Private rights and public goods have coexisted in higher education, as it has served as a transformational forum and space for public debate and argument.[14] This sector finds itself historically rooted in the public sphere, a space that Brian Pusser calls "at once physical, symbolic, cultural, political, and semantic, not in relation to the state or the broader political economy but as a site of complex, autonomous contest in its own right."[15] Yet contestation currently is unfolding regarding the nature of higher education's persistence in the public sphere, reflecting deep tensions over the degree to which this sector's benefits should accrue primarily to private individuals and corporations, or to the public at large.[16] Coining an all-purpose definition of public interest, as it pertains to higher education, is not an easy task. Simon Marginson offers one useful way of conceptualizing the public dimension of higher education, imagining "the sector as an umbrella public sphere sheltering projects that pertain to the public good (singular) and more narrowly defined public goods (plural). Most such public functions are associated with the university's roles in knowledge, learning, and discourse."[17]

Public benefits and public goods, as Pusser, Marginson, and other scholars conceive of them, stand in contrast with private-good orientations in higher education. Universities grant private-good benefits to individuals by awarding them earned degrees, which lead to enhanced earnings over these persons' lifetimes. When universities facilitate forms of revenue going to corporations—for example, by performing sponsored research—this transfer is also a private good. When universities develop new knowledge, funded with public dollars, however, and distribute it widely and nonexclusively, that activity is a public good.[18] Other benefits to society that result from public support of higher education include greater rates of civic engagement and healthy behaviors by those who pursue some type of postsecondary education, as well as lower rates of crime and other activities that encumber public services.[19]

One way of viewing the landscape of public goods and private goods in higher education is through the lens of what Burton Weisbrod, Jeffrey Ballou, and Evelyn Asch call the "two-good framework."[20] Most activities in higher education have a dimension that advances a public-serving mission, such as educating students or improving society through research or service. These same or related activities may also be driven by a concern for revenue generation, or, more directly stated, money.[21] Money is important, because higher education's pursuit of mission (specific objectives or purposes) is expensive. Revenues must be generated so that missions can be furthered, even if the line between private (revenue) goods and public (mission) goods is seldom clear.

University engagement in technology transfer is a classic example of where mission-related goals often create tension with money-related goals. Universities that own patents may be tempted to license them on an exclusive basis to only one company (like Harvard did with its OncoMouse patents), as opposed to licensing them cheaply and nonexclusively to anyone willing to pay for a license. Institutions of higher education pursue these exclusive arrangements with industry because providing the benefits of research knowledge to only one firm, as opposed to many, enhances the potential for these institutions

to profit from that knowledge. Yet many argue that the creation and wide dissemination of research knowledge is indivisible from any university's mission, particularly given that taxpayers fund around 60 percent of all university research—at public and private universities alike—through the federal government, which awards sizeable competitive research grants to faculty.[22]

Private-good orientations in higher education have been compounded by what Gary Rhoades and Sheila Slaughter call "academic capitalism," or "the increasing engagement of higher education institutions and participants in market-like and market behaviors in creating and taking to the marketplace (1) research and education products and services that commodify higher education's basic work and (2) nonacademic products and services that feature higher education as a nonacademic consumption item."[23] Those who study the effects of academic capitalism in higher education tend to focus on the erosion of this sector's public-serving ideals, as well as perceived disruptions to its traditions of openness and sharing that are brought about by these trends.[24] As Slaughter and Rhoades argue, "Universities, strengthening their units that litigate, have moved to defend their intellectual property, firmly committing themselves to academic capitalism, even when it puts them in awkward positions with regard to their treatment of . . . the public trust."[25] An important, related criticism is one identified by Irwin Feller: the risk that universities, "tempted to pursue new financial opportunities to compensate for stagnant revenues from other sources," may exaggerate their own capabilities involving intellectual property and technological innovations.[26] This book provides data in support of both of these arguments.

Scholars such as David Kirp and Christopher Newfield view higher education's pursuit of market behaviors and ideals as antithetical to the traditional role of a university. As Kirp forcefully states, "Embedded in the very idea of the university—not the storybook idea, but the university at its truest and best—are values that the market does not honor: the belief in a community of scholars and not a confederacy of self-seekers; in the idea of openness and not

ownership; in the professor as a pursuer of truth and not an entrepreneur; in the student as an acolyte whose preferences are to be formed, not a consumer whose preferences are to be satisfied."[27] Newfield agrees, arguing that "the university and business are partners that should not fuse, neighbors that need good fences, friends that must remember that opposites attract."[28] The growing rift between the market's temptations, in the shape of intellectual property, and the university's highest purpose, which is public service and public trust, forms the heart of this book's thesis.

Society has only a limited ability to measure public goods, so the value and any consensus around higher education as a public good occurs in the arenas of public perception, policy, and debate. Various conditions either enable or hinder the degree to which public goods emerge in higher education.[29] The existence of intellectual-property protection, and how institutions choose to engage with the intellectual-property system, form one of those conditions. At its core, intellectual property is a system by which to organize competing claims for private rights to intangibles. As described in this chapter, each of the discrete legal protections that pertain to intellectual property tends toward exclusivity in favor of the claimant to a right, often to the exclusion of another claimant in direct or indirect competition with the first, including, most importantly, the public. When institutions of higher education seek and obtain these powerful rights, they impact the public's trust in their activities. While intellectual property unquestionably may be used to implement and further the public good, the difficult question for decision makers within higher education is when and how best to use the protections of intellectual-property law in service of the public good. Later chapters describe in detail these difficulties—and, all too often, failures—across a variety of intellectual-property and allied laws.

The trends related to intellectual property that are discussed in later chapters are not developing in a vacuum, but instead are occurring amid a higher education landscape that is becoming ever more corporatized, privately capitalized, and closely positioned to the market. These developments often mean that institutions of higher

education are replicating the intellectual-property norms and habits of for-profit industries. Decision makers at both public and private universities, who face pressures to find new sources of revenue yet remain steeped in an academic culture that views ideas as potentially proprietary and lucrative, often are predisposed to make money from intellectual property when possible. Copyrights, patents, trademarks, trade secrets, Internet domain names, and publicity rights all provide attractive vehicles for laying claim to intangible goods that the law recognizes as available for ownership and exploitation.

Historically, however, higher education and industry looked at intellectual property quite differently. Competition between institutions of higher education was not a zero-sum game, as all of them operated in a "knowledge commons"—a site where cultural and knowledge resources are generally available for all to use and consume at a relatively low cost—where sharing intellectual fruits trumped claiming them to the exclusion of others.[30] Corporations, on the other hand, have investors who want a return on their investment, which means that firms claim assets, exploit them, and prevent their use by competitors in the marketplace. Seeking, maintaining, and enforcing intellectual-property protection furthers those goals, which now have been adopted in earnest by many institutions of higher education—frequently, I argue, to the public's detriment.

The public loses when higher education adopts the trappings of corporate practice, because the former is not designed or equipped to claim, manage, and enforce intellectual property in a manner similar to business firms. The infrastructure of human resources and the nature of decision making in higher education are radically different from their counterparts in the corporate world. Faculty—the lifeblood of any college or university—for the most part are independent agents who self-govern and rarely view themselves as having to report to academic managers, let alone to those nonacademic staff who often have day-to-day oversight over intellectual-property matters. Moreover, higher education as a whole believes in openness, transparency, and sharing—qualities that often conflict with the combative, winner-take-all corporate approaches to intellectual

property, where firms stake claims to rights and then enforce them. Even when institutions adopt those approaches—and they most certainly have, as later chapters discuss—they generally struggle to make sense of why they are accumulating these private rights and what they should be doing with them.

"More is better" may be a defensible strategy for corporations when approaching intellectual property, but that strategy seldom aligns with the ethos of public-serving colleges and universities. The aptitude of these institutions to achieve success in the intellectual-property arena, at least as this is defined by corporations and lawyers, tends to be grossly overstated, both in terms of its ease of implementation and its cost. Yet, despite the pressures for institutions to compete in this realm, their interest in it only rarely leads to the development of coherent intellectual-property strategies that are consistent with higher education's overriding, public-serving purposes and goals.

While intellectual property and the public interest often are in tension within higher education, the two are not irreconcilable. The choice is not either/or, but one of degree. This book makes the case that in colleges and universities, the pendulum has swung too far in the direction of championing private rights, in the form of intellectual property, at the expense of the public good. While the situation in many cases is dire, the problems outlined in subsequent chapters are not insurmountable. The landscape of higher education will always be hybrid, influenced by competing concerns: to serve the interests of the public, while simultaneously serving the private interests of the institution, its students, its funders, and its alumni.

The challenge lies in realigning higher education's use of intellectual property with its role as an instrument of public good. Colleges' and universities' priorities and points of emphasis have gone astray, but they are amenable to correction. For that reason, this book ends with a call for such a recalibration, including suggested practices, policies, and laws that could promote an intellectual-property atmosphere on campus that is more consistent with higher education's noble purposes and best ambitions.

Private Rights, Public Goods, and the Role of Institutional Agency

This book presents a story of brewing conflict: how higher education grapples with intellectual property's principles and rules regarding private rights in its effort to further the public good. This dichotomy goes to the heart of how we conceptualize higher education in the public sphere—as a historically public-facing sector that the marketplace gradually pulls in private, rights-rich directions, a sector that is simultaneously influenced by concerns over commerce, brands, and academic missions. At this intersection of priorities and values, made all the more pronounced and visibly contested through the data and anecdotes relayed in later chapters, we find higher education struggling to use private rights in the service of a greater public good. Its behaviors occasionally seem schizophrenic, as the dual motives of self-preservation and self-aggrandizement intermix.

For most readers familiar with the workings of modern higher education, recognition of these symptoms does not take a leap of faith. Scarcely a week goes by in my role as a professor when someone does not send me an article or share a comment to the effect that intellectual property is "hot" or "important right now," particularly in higher education. The potential revenue to be generated from intellectual property, or the commendations that can come from "protecting" some previously unclaimed intangible asset, often are cited as proof of these assertions. If the symptoms can be recognized as higher education's growing fascination with intellectual-property rights and their accumulation, the larger issue entails identifying the causes of these behaviors and taking stock of their long-term effects.

On that point, opinions diverge. Some have suggested to me, often privately, that the symptoms are not troubling enough to identify causes. They argue that across multiple sectors, actors are turning to intellectual property in greater numbers than ever before. They also note that each year, more patent and trademark applications are being filed, more copyrights are being registered, more rights are

enforced, and so on; higher education is simply keeping up with others in these regards. In short, what is happening with intellectual property within the domain of higher education is not unique to higher education.

These trends are real, and critics are right in observing that higher education, in many ways, faces the same marketplace pressures and forces as other actors in the global economy. Where these detractors miss the mark, however, is in believing that higher education is designed to behave similarly to for-profit actors, or that the intellectual-property system is one in which higher education realistically can expect to effectively compete without incurring irreversible harms, due to its historic placement in the public sphere. Higher education's modeling itself on for-profit behaviors is worrisome, if we believe that the former serves public purposes and furthers public interests that the private sector does not. The use of private rights for public goods is a delicate proposition to begin with, and, as this book hopefully makes clear, that proposition has limits and breaking points.

Behind all of this rhetoric about higher education's capacities, missions, and aptitudes lurks an uncomfortable fact, one often overlooked by those who believe that taking intellectual property seriously means defending every instance where an institution has laid claim to something that is intangible. Intellectual property is not a phenomenon that simply *happens*. The accumulation, use, and enforcement of intellectual property by colleges and universities reflects choices to engage in a system that, by its very design, takes knowledge and information that is otherwise subject to largely unfettered public use and restricts it, by attaching private claims to it. "We have to do it because the law requires it" is a frequent rejoinder by institutions of higher education whose actions involving intellectual property are scrutinized, but this response can be misleading, in that it seeks to downplay or remove human behavior from the effects of institutional or individual decisions. Intellectual-property laws set requirements for those who seek to enjoy their protections. But colleges and universities face choices, not constraints, involving when and how to

employ intellectual-property protections. This book aims to make those choices clearer to a wide audience, so ones that do not serve the public interest can be more readily identified and challenged.

Why Intellectual Property Law and Policy Matter to Higher Education

A related point involves understanding the importance of how higher education uses and enforces intellectual property. Some may be inclined to view these actions on a microscopic level: a foolhardy decision by institution X regarding intellectual property does not seriously affect the public good, they say, since that decision pertains to one institution only. These same critics may also note that few policies in higher education exist on a macroscopic level, and no specific laws—other than the Bayh-Dole Act, concerning patents—pertain to higher education's involvement with intellectual property. Therefore, no collective action in this regard can really be expected. In short, intellectual-property policy is not of the same order as, say, affirmative-action policy or gender equity, both of which are subject to weighty Supreme Court precedents, ongoing legislative attention, and vigorous debates on state and institutional levels.

Intellectual property is just as important to higher education's long-term role in serving the public interest as these other topics, even though national dialogue has not focused on this particular subject. In addition, minor transgressions in this arena matter, because, collectively, they shape cultures, norms, and expectations across institutions, often in subtle but invidious ways. Higher education is a sector marked by intense competition. When one institution offers a new service, others face pressures to do the same or risk falling out of the mainstream—examples include the advent of climbing walls in campus recreation centers in the past ten years, and steady improvements in the quality and variety of campus food services. These same pressures shape institutional behaviors with respect to intellectual property. Few college and university presidents are appointed to office without saying that they will outperform peer institutions on any number of measures, or that they will adopt the

trappings of their most sought-after competitors. If one of those rivals decides to pursue intellectual property with zeal, other institutions align themselves accordingly.

Higher education's choices with respect to intellectual property matter to all of us, because they affect our health, our marketplaces, and our shared cultural and knowledge commons. Decisions and activities in this realm are not so minor, isolated, or picayune, having no lasting consequences, as some might lead us to believe. Armed with information about how intellectual property works and can work, we might decide that higher education's use of it merits concern and reconsideration by the public. This book makes that case.

Chapter Two

Intellectual Property Explained

What, exactly, is intellectual property, and what are the laws related to it? This chapter offers in-depth explanations and baseline facts about key doctrines, principles, and terminology. Relevant information about each of the four areas that make up what is known as intellectual property, in addition to Internet domain names and the rights of publicity, is provided in order to lay the groundwork for understanding discussions in the subsequent chapters in this book. While there are many nuances in these areas of the law, this chapter focuses on conveying basic doctrines and principles, as well as a general sense of how these different legal principles and rules impact higher education.

"Intellectual property" is an umbrella term that commentators generally agree includes four different legal sectors: patents, copyrights, trademarks, and trade secrets.[1] Each of these areas has distinct precepts and doctrines, some of which appear in governmental rules and regulations, while others are created judicially. These four divisions, any or all of which constitute what commentators may mean by the words intellectual property, fall within a larger domain of the law concerning the regulation of commerce and competition. Accordingly, other areas of law are related to intellectual property, or are influenced by one or more of its principles or rules. Antitrust law, which punishes marketplace actors who engage in commercial practices that effectively reduce competition, is a prime example. Publicity rights and the regulation of Internet domain names are two other legal aspects influenced by intellectual property, which this book addresses because of college and university interest and activity in those areas.

Difficulty often arises for lawyers and nonlawyers alike in understanding the differences and commonalities between the various principles and rules regarding intellectual property. Clients often think what they need is a copyright, when they really mean a trademark. They then become surprised to learn that what they want to protect with a trademark is not subject to trademark protection. Other misunderstandings within and across these areas abound.

One source of misunderstanding involves defining *who* and *how* different individuals within higher education are impacted by intellectual property. As will become evident from reading this chapter, intangibles that may constitute intellectual property in higher education come in different formats and are subject both to creation and claims of ownership by various and sometimes overlapping actors—namely students, faculty, staff, and institutions of higher education themselves.

One final introductory note concerns the sources of law that govern these various legal principles and rules. The landscape is complicated, as the sections below describe. Two areas, copyrights and patents, fall within the province of federal law only. Three more, trademarks, trade secrets, and publicity rights, are protected by both state and federal law, although how states treat the right of publicity varies significantly. Finally, Internet domain names are influenced by international protocols and agreements, with the resolution of disputes pertaining to them subject to mandatory arbitration and, in some cases, federal-court jurisdiction in the United States.

Copyrights

Copyright law is notoriously complex and somewhat ethereal. Like the concept of patents, copyright is one of the two aspects of intellectual property specifically mentioned in the Constitution, and it is governed entirely by federal law. Copyright is the legal mechanism that allows authors to protect their original works of expression from being copied by others. The underlying concept is that the public benefits when authors share their original works with the

world. If society, in return, provided no protection for authors, few works of importance would see the light of day. Why write the next great American novel if anyone could copy it wholesale and provide no revenue to you, its author?

The original expression must be "fixed" in a tangible medium in order for the protections of copyright to apply. Everything from words on a page, to graphical depictions on a canvas, to images on a screen, and to ones and zeros on a microchip meet this requirement.[2] Literary works; musical works; dramatic works; choreographic works; pictorial, graphical, and sculptural works; motion pictures and other audiovisual works; and architectural works are all potentially subject to copyright protection.[3]

Copyright is famously nondiscriminatory in its application. High art, low art, and everything in between is subject to copyright, presuming that the baseline elements of protection are met. In short, the law does not require that a work be elegant, or memorable, or unique to the world in order for copyright protection to exist. While popular novels, movies, and music all are subject to copyright, so, too, are emails, instructional manuals, and organizational bylaws, provided that these works are sufficiently original and do not constitute merely an idea, procedure, process, system, or method of operation.[4]

Copyright is not a single right, but rather a bundle of rights.[5] The most popularly understood of these rights include the right to reproduce the copyrighted work, the right to distribute it, and the right to prepare derivatives, or adaptations, of it. Additional rights apply to certain kinds of copyrighted works, including the right to perform the work publicly (for example, in the case of a play) or to display it publicly (for example, in the case of a motion picture). Each of the protections that copyright affords can be divvied up, according to what the copyright owner chooses to do. For example, if I own the copyright for a written manuscript, I can license or assign to another the right to perform the work publicly, while reserving for myself all other rights. "All rights reserved" is the common phrase used when the copyright owner retains all the rights of copyright.

Infringement occurs when someone trespasses on one of the copyright owner's exclusive rights of copyright without license or permission. For example, just because I like a certain work of fiction does not mean that I have the right to negotiate with a Hollywood studio to make that novel into a movie. The movie would be considered a derivative work, and only the owner of the copyright for the original book has the authority to license derivatives. What if I read the book and become inspired to create a movie that involves themes similar to the ones in the book, however? At what point does my movie become a new work in its own right, in which I would hold the copyright, as opposed to an infringing derivative?

Questions of this sort are thorny and frequently arise when infringement is alleged. In order to succeed in a copyright-infringement lawsuit, a plaintiff must establish that the defendant had access to the plaintiff's copyrighted work and that the defendant's work is "substantially similar" to the plaintiff's. A jury generally decides whether the substantially similar requirement has been satisfied in any given case. The defendant may insist that he independently created the work in question—essentially arguing that any similarities between the two works are purely coincidental. In theory, two people, working separately, could create works that closely resemble each other, or even are identical. If they do so, the one whose work comes second in time is not an infringer on the first author's work.

The 1976 Copyright Act went into effect in 1978 and provides the modern basis for copyright law in the United States. Prior to 1978, works of authorship had to be registered with the United States Copyright Office, housed in the Library of Congress, before the protections of copyright applied. Additional formalities existed—such as renewal filings, and a requirement that copyrighted works bear a notice of the copyright or otherwise lose this protection—that often had the effect of limiting the duration of the copyright, as authors frequently failed to comply with these ancillary items for one reason or another.[6] Once the copyright protection ended, the work entered the public domain and became available for anyone to use in any way, free of charge.

For any work created on or after January 1, 1978, different rules apply. Now copyright automatically belongs to the author as soon as the original work is fixed in a tangible medium of expression. Copyright exists for that work, regardless of whether the author places a copyright notice on the work or chooses to formally register the work with the copyright office. Also, the duration of copyright protection is lengthy. Since the Copyright Term Extension Act of 1998, the copyright for a given work lasts for the author's lifetime, plus seventy years. For example, if a person creates a work at age twenty-two, and then dies seventy years later, at age ninety-two, the effective duration of that work's copyright is 140 years. Copyrights for some works are owned by entities (for example, a corporation or a university), not individual authors. For those types of works, the period of protection is 120 years from the date of creation, or 95 years after the work's first publication, whichever is earlier. All of these terms of protection are extraordinarily long. Because copyright protection automatically applies for an author once a copyright-eligible work becomes fixed in a tangible medium—without regard to registering, renewing, or giving notice of a claim for copyright—few works created in modern times will enter the public domain any time soon.

While obtaining registration is optional, applying for and receiving a copyright registration certificate from the copyright office is a prerequisite to suing for copyright infringement. Therefore, routine players in the copyright system, such as movie studios and book publishers, obtain registrations as a matter of course, to protect their business interests. Registering a work soon after its fixation provides certain benefits to its owner. Namely, in an infringement lawsuit, attorneys' fees and what are known as "statutory damages" can be awarded to a copyright owner who registers a work within three months of its first publication or one month after learning of its infringement, whichever is earlier.[7]

Statutory damages differ from what lawyers call "actual damages." The former allow a court to presume that damage has happened from the mere fact that infringement has occurred, without requiring the plaintiff to establish any concrete damages. Proving actual damages

can be difficult—expert testimony typically is required, and experts often disagree on the extent to which a copyright owner has actually been harmed by another's infringement (for example, maybe the dollar figure the plaintiff claims for the damages is too speculative). Ultimately, a jury decides the appropriate amount to award for such damages; there, too, much is left open to chance and the argumentation of lawyers. By comparison, statutory damages, as the term suggests, are set by statute (written laws or regulations): an amount of not less than $750 or more than $30,000 for each work infringed on, according to what the court considers to be just.[8] The $30,000 maximum figure can be increased to $150,000 if the court finds that the infringement was committed intentionally.

While provisions of the copyright law dealing with damages may seem esoteric, in reality they provide sharp legal teeth for copyright owners. Many copyrights are essentially worthless. Think, for example, of the emails you write every day. Each one is bound to have some measure of original expression, which is fixed when you type it. Those original expressions are subject to copyright automatically. You might not like if someone took your email and decided to copy and distribute it to others. In order to prevail in a copyright infringement lawsuit, however, you would have to establish that you had been damaged by the defendant's infringement.[9] Actual damages would be difficult to prove—what is the value of a licensed use of your email?—so having the ability to obtain statutory damages would be quite helpful. Copyright owners often rely on the threat of pursuing statutory damages in order to convince an infringer or would-be infringer to follow a different course of action.

Copyright rewards originality, not effort or artistic merit. One of its famous doctrines, known to copyright cognoscenti as the "sweat of the brow" doctrine, states that hard work or effort does not automatically equate with copyright protection. In a legendary Supreme Court case from 1991, the court held that a phone company that arranged names and telephone numbers in the typical fashion (alphabetized, A–Z, by last name) in a phone directory did not own a copyright for that directory.[10] The company tried to convince the

court that it held a copyright for the compilation of the directory, such that another firm could not create a competing phone book containing all the same entries, listed in exactly the same way, without infringing on the plaintiff's copyright, but the court was not persuaded. Although the company had expended much money and effort to create the directory, its phone book lacked even a modicum of creativity or originality, which the court called "the *sine qua non* of copyright."

It is important to note that originality does not mean novelty. A work need only be original to the author who created it in order for copyright protection to exist. That said, the copyright office has promulgated certain rules that complicate our understanding of originality. For example, the office will not register a copyright for names, titles, or short phrases, no matter how original they are ("Just Do It!" is protected by a trademark, not a copyright, and Will Ferrell and fellow *Saturday Night Live* writers have no copyright claim to the coined word "strategery"). Nearly anything else is subject to copyright protection.

The copyright registration process can be completed online, without the aid of an attorney, and is inexpensive, compared with the costs involved in obtaining patents or trademarks. The official governmental registration fee is $35–$85 per work.[11] Authors must submit a copy of the work they wish to register to the copyright office, although the office's review of the work is minimal. No one at the copyright office reads 300-page novels to ensure that every expression in them is original. The office simply notes that works like novels are subject to copyright eligibility and issues a registration certificate on the basis of the author's application.

A finely detailed evaluation of a work, to determine what, precisely, is an original, protected expression versus an unprotected expression, such as a common element from the public domain, occurs only in the context of litigation, if it occurs at all. Copyright protects original expressions, not ideas per se. Nearly every artistic work contains certain stock elements that are not protectable through a copyright. For example, only so many genres of story exist

in literature. To cite the famous American novelist Willa Cather, "There are only two or three human stories, and they go on repeating themselves as if they had never happened before."[12] No one has a copyright on the concept of a love story, or even on variations of a love story. You can write your own without infringing on the copyright for any of Danielle Steele's books. What is subject to copyright protection are identifying details in a particular story, original dialogue and character descriptions, and maybe even highly creative forms of character and plot development. Distilling what the original segments are from those elements typical of the genre is more art than science, and it surely is something that animates copyright lawyers more than it does authors. Because of the complexity and uncertainty of this undertaking, many copyright holders seek to claim more protection than they actually have when they engage in discussions with licensees or alleged infringers.

Authorship is another key concept within copyright. Authorship requires human action, and humans often work for others. A doctrine called "work made for hire" helps determine the ownership of certain types of works. The default presumption is that whoever creates a work owns the copyright for it. This presumption changes, however, if it is a work made for hire. These come in two variations: (1) those prepared by an employee within the scope of that person's employment, or (2) those specially ordered or commissioned by another, if it is a certain type of work, and the parties involved expressly agree in writing that it shall be considered a work made for hire.[13]

The first scenario concerns employers owning works employees create that are incidental to their work for that employer. When a boss asks a direct employee to create a marketing plan for their company, the company automatically owns any copyright for the resulting product. The same is not true for copyrightable works the employee may come up with outside of the workplace, such as musical compositions created with a band on the weekend. Distinguishing the personal from the professional is easy to do in this example, but in other cases, the line between works created in a personal capacity versus those produced in an employment capacity is more difficult to draw.

Higher education provides a classic example. Faculty often work autonomously and independently. They frequently choose their own research projects, as well as what they will write, how they will write it, and where and when they will seek to publish it. For these reasons, many faculty feel that they own the copyright for whatever they create. Their employer, the university, often views ownership of these works differently, which can lead to controversy if the one in question proves to be particularly valuable. Chapter 5 discusses in more detail how work made for hire arises and operates in higher education.

The second scenario envisions someone hiring an independent contractor to create one of a limited array of works, specifically defined by statute, where it makes the most sense for the person contracting out the work to own the copyright for whatever gets created. For example, I did not produce the index at the back of this book. Instead, I engaged someone else to do it as a work made for hire. If the law presumed that the creator of the index owned the copyright to it, authors would have to obtain a copyright assignment from whoever created their book's index, which most likely would come at an additional price, beyond the cost of producing the index itself. Yet there is no independent market for book indexes—they are of little or no value without the content of the book itself—so possessing a copyright is of no real use to the indexer. The second work-made-for-hire scenario, therefore, seeks to prevent the tail from wagging the dog in situations like this. What people often fail to recognize is that this second scenario is incredibly narrow. It only applies to certain kinds of commissioned works, which mostly are not of much relevance for our purposes here, and then only if the parties agree in writing that the commissioned work is a work made for hire.[14]

Parties commonly engage others to create copyrightable works that do not fall within the scope of either the first or the second work-made-for-hire scenario. Take, for example, wedding photographers. Most offer their clients a choice between two prices for their services: one that is cheaper, because they retain copyright for the photographs they take at your wedding, and one that is more expensive, because they assign their copyrights in the photographs to you, the person

contracting with them. If the photographer retains the copyright, you pay the photographer for each print of a photograph you wish to have. If you own the copyright, you can print as many photographs as you want and even sell them if you wish.

The final large piece of the copyright puzzle concerns the doctrine known as fair use. The concept of fair use is intended to provide breathing room for other authors within creative landscapes that are often overly constrained by copyrights. Fair use recognizes that authors often need to incorporate the creative expressions of others into their own original works. In order to contribute to a vibrant cultural commons, authors must be free to comment on, criticize, and use (in some limited fashion) existing works protected by copyright, without seeking permission. Many of these uses do not produce direct benefits for the copyright holder. In fact, the copyright holder may adamantly prefer that you not use the copyrighted work, or at least not use it without paying a licensing fee. Without a fair-use doctrine, rights holders would always have the upper hand, deciding on what terms and for what purposes others could use their work. Some uses, even if socially valuable, would be prohibited by rights holders.

Fair use is embodied in Section 107 of the Copyright Act, which sets out four nonexclusive criteria that courts must consider in determining whether an alleged infringement is protected by fair use. These criteria are: (1) the purpose and character of the use (favored uses are ones that transform the purpose of the original, or imbue it with new meaning or understanding); (2) the nature of the copyrighted work (uses of factual works are favored, compared with uses of highly creative works); (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole (minimal copying is favored, unless that person needs access to more of the original so that others realize the second author is commenting on the original); and (4) the effect of the use on the potential market for or value of the copyrighted work (uses that disrupt established licensing markets are not favored).[15] Resolution of these factors is notoriously fact specific, and no single factor is sufficient to reach a

definitive conclusion. Other language in the statute suggests that some uses are potentially favored, including uses "for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research," although the weight these uses should be given in a fair-use analysis is unclear, and some courts have been stingy in their application of fair use, even in these presumably favored instances.

What we do know through past case law is that simply crying "Fair use!" in response to an allegation of infringement does not make it so. Because fair use is a legal determination, which takes time and substantial amounts of money to achieve through litigation, we actually have fewer judicial guideposts as to what constitutes fair use than we might expect. Copyright holders often make exaggerated claims about their rights, which can result in uncertainty for prospective fair users. Unfortunately, this behavior frequently is intentionally designed to deter individuals who wish to make reasonable but otherwise unauthorized, unlicensed uses of someone else's copyrighted work.

In many creative endeavors where the balance of power between authors claiming fair use and copyright holders claiming infringement is skewed in favor of the latter—for example, in documentary filmmaking, publishing, and museum-related industries—the murky areas regarding what constitutes fair use and the possibility of being subjected to litigation have made peace-of-mind payments the norm.[16] Because uncertainty over the disposition of legal rights has a way of dampening the interest of investors and insurers, many choose to pay these licensing fees, even when they have strong arguments that what they propose to do falls under the heading of fair use. As one of my former law partners liked to quip to clients flummoxed at the thought of having to pay a licensing fee for something they believed the fair-use doctrine permitted them to use for free: "You can be right, but it's costly. How much is being right worth to you?" For many, peace of mind is worth a licensing fee, in order to avoid the time and expense of having their position vindicated through litigation.

Fair use is of critical importance in higher education. In their teaching and research capacities, professors often work with copyrighted materials, and reliance on fair use permits them to use those works in ways that benefit society—namely, for the purposes of teaching, commentary, criticism, and scholarship. In higher education, too, certain norms have developed regarding the unlicensed use of copyrighted materials for teaching and scholarship. "How much is too much?" is the perennial question involving fair use, one that often leads to different answers, depending on whom you ask.

Patents

Like copyright law, patent law is federal in nature. Patents come in three forms: utility patents, design patents, and plant patents. The most common of the three is a utility patent, which is a limited monopoly right granted by the federal government in exchange for an applicant's disclosure, or detailed description, of a new, useful, and nonobvious "process, machine, manufacture, or composition of matter, or any new and useful improvement" to one of those things, to the United States Patent and Trademark Office (USPTO).[17]

The Patent Act of 1952—updated substantially by the America Invents Act of 2011—sets the regulatory criteria for patent eligibility. Establishing the novelty, utility, and nonobviousness of the invention are the primary hurdles that must be cleared by an applicant for a utility patent. In recent years, satisfying the USPTO that the invention described in the application is appropriate subject matter for patent—and is not, instead, a law of nature, a natural phenomenon, or an abstract idea, all of which are ineligible for patent protection—has taken on new importance.

The novelty requirement simply means that the invention described in the application must be new. Patents will not be granted for old inventions, and the rules are strict concerning the window during which an inventor can file for patent before forever losing the ability to patent that invention.[18] Typically, the window is one year from the first public disclosure of the invention.

The utility requirement, by contrast, is easier to fulfill. It simply means the applicant must establish that the invention is useful. Meeting the utility requirement does not require evidence that the invention is in use. In short, few patent applications are rejected for a failure to meet the utility requirement.

The most onerous of the three major criteria, and what has been called the "ultimate condition of patentability," is the nonobviousness requirement.[19] Nonobviousness is an imprecise concept that essentially means patents will not be granted for items that are not sufficiently inventive, even if they are new. The nonobviousness requirement recognizes that some advancements in certain fields have not occurred, yet this is not because those advancements are not known or are not knowable. In patent parlance, some inventions are "obvious to try," or would be obvious to someone having ordinary skills in a particular field, because they involve using known techniques to yield predictable results. These advancements are not eligible for patent protection, as they are considered to be obvious or are not significantly inventive enough to merit patent protection. Patent examiners at the USPTO look at existing publications—patents, scholarly articles, treatises, and the like—in order to understand the state of knowledge in a given field. They then make a determination as to whether the applicant's invention is nonobvious in light of the state of the art in the relevant field.[20] Knowledge regarding the state of the art is not measured against what the most expert of experts know, but rather against the knowledge of a person having "ordinary skill in the art," an imaginary but theoretically objective construct. The goal of the nonobviousness requirement is to protect the public by drawing a line between what Thomas Jefferson called "the things which are worth to the public the embarrassment of an exclusive patent, and those which are not."[21]

Utility patents—the type most people probably imagine when they think of patents—are presumed to be valid at the time they are issued and extend for twenty years from the date of the application, provided that the owner pays the USPTO the required maintenance

fees, which become due and are owed at 3.5, 7.5, and 11.5 years after the patent's issuance.[22] The application process at the USPTO is costly and rigorous, and applications that do not meet the statutory requirements are rejected. For patents that are granted, typically three to four years elapse between filing and issuance. While patent applications require various disclosures, a patent's claims are of primary importance, as they delineate the specifics of the invention that the patent's owner can prevent others from using, manufacturing, importing, selling, or offering to sell without the owner's permission, once the patent is issued.[23]

The second-most-common type of patent—which is of increasing importance lately, particularly in the smartphone industry—is the design patent, which protects any new, original, and ornamental design for a manufactured article. Design patents contain only one claim (as opposed to the multiple claims typical of utility patents) and are valid for fifteen years from the date of issuance, with no fees required to maintain them.[24] Design patents are much cheaper to obtain than utility patents, costing only $180 to file an application, with the associated legal fees averaging only $1,800, compared with the tens of thousands of dollars required, on average, to obtain a utility patent of moderate complexity. Everything from the shape of saddles and coat hangers, to the design of kitchen appliances, to ornamental handles on silverware, to features on smartphones have been protected by design patents.

The third type of patent available in the United States is the plant patent. Plant patents reward the creation of new, distinct varieties of asexually reproducing plants. The protection provided by plant patents lasts for twenty years from the filing date. Plant patents give the patent owner the right to exclude others from asexually reproducing, selling, or using the patented plant.

Owners of any of the three types of patents are referred to as "patentees." Their status is unique, in that there is no requirement that they utilize any invention covered by their patent, nor do they have any guarantee that they may do so without encroaching on the patent rights of someone else. For these reasons, patents have been called

negative rights, as the "grant of a patent does not ensure that the owner of the patent will be able to make use of the patented device without infringing on the rights of another legitimate patent owner."[25] In short, a patent provides the patentee with a right to exclude, not a right to create. A patentee's patent may describe a new invention, A + B, but if A is patented by someone other than the patentee, the patentee commits infringement if the invention is manufactured or otherwise brought into existence without obtaining a license from A. While many view patents as granting their holders a monopoly, this monopoly is not, in any sense, a marketplace monopoly that enables the patentee to be the only person or firm to manufacture and sell the patented invention. Rather, the monopoly is technically an economic one, permitting the patentee only the right to *exclude others* from manufacturing and selling the patented invention *without the patentee's permission*.

The rules pertaining to patent eligibility, protection, licensing, and enforcement are many and quite complex. Some of the unique features of patent law as they affect universities are covered in chapter 4, but for our purposes here, a macroscopic understanding of the patent system, particularly as it relates to the public good, is sufficient. Patent law operates from the premise that inventors need an incentive to reveal their inventions to the public. Patent applications, after all, are detailed descriptions of valuable innovations—why would an inventor make such a description publicly available without some type of inducement to do so?

Here, the incentive is the patent, which can be used or not used at its holder's discretion. Patents are issued in response to applications to the USPTO describing items that meet the written legal criteria for patent protection. The award of a patent is no guarantee that the invention solves a marketplace need, or even that its holder intends to commercialize the patent. Some seek patents because they are crucial to meeting business objectives. For example, pharmaceutical companies that specialize in marketing brand-name products gauge their success by how many FDA-approved drugs they have under patent. Patent protection provides and protects goods of value to the

company, and it essentially is what permits the company to charge monopoly prices during the time when the drug remains patented. Once a drug "goes off patent" after the patent period ends, companies making generic pharmaceuticals can manufacture the same compound and sell it for slightly more than cost, which is always dramatically less than the price of the patented version of the drug. In short, shareholders like companies with patents; the more patent protection a firm has for its products, the greater its potential market share.

Other players in the patent system seek patents for different, nonfinancial rewards, such as prestige or the value patents signify to others. University inventors often fit this description. Many like the look of patents framed in display cases, or as line items on a curriculum vita. The university itself is not a manufacturer; therefore it will have to license any patent it owns to others in the marketplace that are positioned to do something with it. The applicant's intentions or plans for using the patent do not matter to the USPTO. Provided that a person gives the patent office an adequate description of the invention, which meets the criteria for eligibility, the applicant receives a patent. You may elect to pay the maintenance fees throughout the life of the patent. Or you may choose not to pay the maintenance fee that is due 3.5 years after the USPTO issues a patent, which eventually causes your patent protection to lapse and allows the invention to fall into the public domain much earlier than the twenty-year term otherwise available to the patentee. Or, once a patent is granted, you may decide not to create the item after all. In any of these situations, a prospective patentee's intentions have no bearing on the eligibility of an application for patent protection.

Patent law is viewed as highly specialized, in part because the courts treat it that way. In 1982, Congress created the United States Court of Appeals for the Federal Circuit (CAFC), which is the only federal appellate court whose operation is based on subject matter, not geography.[26] The CAFC enjoys exclusive jurisdiction over appeals, or reviews of court decisions, in patent cases. While patent-infringement trials occur in federal district courts across the country,

appeals regarding decisions in those cases can only be heard at the CAFC, which is based in Washington, DC. Prior to the CAFC's creation, reviews in patent cases were heard at the various regional courts of appeal. Inconsistent opinions across appellate courts led to a mishmash of laws pertaining to patents. Different rulings in similar cases led to some appellate courts being viewed as more or as less favorable than others to patentees or accused infringers. Congress worried that confidence in the American innovation system would suffer without unified interpretations of patent law.

The CAFC tended to issue opinions that favored patents for the first two decades of its existence. Unsurprisingly, judges on the newly created court had incentives to solidify the need for this court and highlight its authority. Opinions that weakened the vitality of the patent system, or made the laws and court decisions involving patents seem to be in common with other areas of the law, could have damaged the court's fledgling esteem. The U.S. Supreme Court heard very few appeals arising from CAFC decisions during the early years of the court, leading many in the patent community to believe that, for purposes of patent law, the CAFC *was* the Supreme Court.

The Supreme Court's interest in patent issues changed, beginning in the early 2000s, just as the importance of patents in the growing knowledge economy came of age. From 2000 through 2014, the court decided more cases involving patent law—twenty-eight in all—than it did in the 1970s, 1980s, and 1990s combined, when it heard a total of twenty-five cases.[27] Most of the patent cases the Supreme Court has heard in the 2000s and 2010s have resulted in the court overturning CAFC decisions, often in cases involving what many viewed as settled issues, or bedrock principles of patent law. Generally speaking, the trend in these cases is for the Supreme Court to dislodge from CAFC rulings any CAFC-made doctrine that suggests that patent principles are somehow different from other principles of law. The specialized patent principles developed by the CAFC over the years often worked to the advantage of patentees, and to the disadvantage of those who would prefer a legal system that is more cautious in granting and enforcing patent rights. While many long-term

patent-law practitioners lament the Supreme Court's recent interest in patent law, viewing it as disruptive to long-established expectations, others welcome Supreme Court scrutiny of CAFC doctrines that perhaps favored patentees at the expense of the public.

Despite these developments in the appellate courts, patents continue to be of great value in litigation, in part because of the nature of the negative right they convey. A person or a company manufacturing, without permission, a product covered by a patent may be made to pay monetary damages to the patentee, and may possibly even be prevented from further production of that item, even though the patentee does not manufacture any product covered by the patent or has not licensed others to do so. This feature of patents—which lead some to view them as government-granted rights to sue—most likely contributes to why we have seen an increased number of patent-infringement lawsuits filed in recent years.

Contributing to the increase in patent-infringement filings are lawsuits brought by what many pejoratively call "patent trolls," or companies that view patent enforcement as their primary or sole means of revenue generation. These firms typically do not employ any workers and, generally speaking, exist only on paper. Those less inclined to view litigation brought by patent trolls as a negative activity use more neutral phrases to describe them, such as "patent aggregators," "nonpracticing entities," "patent monetization entities," or "patent assertion entities." Some studies suggest that, for the first time ever, patent trolls now file more patent-infringement lawsuits each year than do businesses providing actual goods or services.[28]

Some, like me, view patent trolls unfavorably, because they see these entities delaying when the fruits of innovation can reach and benefit the public, costing society billions of dollars in lost income and revenues. Even though patent trolls do not manufacture or sell any products, they can derail the launch of new technologies until entrants in the marketplace either pay them off or prevail in defending themselves against the infringement actions the patent trolls often initiate.[29] Others see patent trolls as efficient innovators that create patent marketplaces by appropriately using the patent system

to extract "rents," or payments, from those entering the market.[30] Whatever your view of patent trolls and their often opaque business models, they are undisputed players in today's "complex, heterogeneous patent ecosystem."[31]

The debate over the function of patent trolls in the U.S. patent system touches on a historical tension between the government's interest in the widespread dissemination of useful technological innovations and its competing interest in providing appropriate economic incentives for inventors to reveal their inventions. This tension has challenged inventors and patent examiners as far back as the time when Thomas Jefferson was alive.[32] Universities, which conduct publicly funded research, are not immune to this tension. Some worry that universities behave in a troll-like fashion when they pursue litigation as a commercialization strategy, traffic with trolls through licensing arrangements, or otherwise participate with their licensees in litigation that appears to be more strategically driven than reluctantly pursued. Chapter 4 discusses all of these concerns in much greater detail.

To quote CAFC precedent, at all points in the patent system—from the time when an applicant files a patent, to when a patent examiner at the USPTO studies the application, to when a patent is issued, to when the owner of a patent licenses it to a third party, to when the owner of a patent sues someone for patent infringement—"the name of the game is the claim."[33] Much of any issued patent does not consist of claims, but rather is a written narrative about a specific field, and a particular invention, that helps situate the patentee's contribution within this larger field. But the claims are the most vital aspect of any patent, as they set forth the precise boundaries and limits of the invention described in an application to the USPTO and recognized as meeting the criteria for patent protection. Drafting patents, or writing patent applications, ultimately comes down to drafting claims, which is a unique combination of art and science. The person drafting a claim must be deeply familiar with the relevant field of science, but also know how to word the description of an applicant's invention in the most fitting and advantageous way.[34]

Patent claims are numbered, and most patents contain several claims, although some have only one claim.[35] Broadly worded claims typically are better, as they provide more protection to the patentee.[36] Examining attorneys at the USPTO often try to narrow claims during the application process. Claims in issued patents are what interested parties review in order to obtain an understanding of the current state of the art in a given field. Knowing what is already claimed allows you to evaluate whether your actual or contemplated activities are likely to arouse the attention of a patent owner. Attorneys for patent applicants also look at the claims of issued patents. They will want to draft their client's application so that the claims for the invention described in it do not tread too closely on the claims of other issued patents within the same field; otherwise, the application risks being rejected.

Claims are also what courts must interpret in patent-infringement lawsuits, so that a jury can understand what a patented invention consists of and compare its protected features with the product or activity of the alleged infringer. Technically speaking, infringers encroach on patent claims, not patents. That is because a defendant could possibly infringe on only one or just a few of a given patent's claims, not all of them. If your patent claims a certain feature that a competitor adopts in its product, without your permission, the competitor's product is said to "read" (infringe) on your patent's claim. Another way of conveying the same meaning is to say that your patent's claim "covers" the competitor's product. Patent infringement essentially is a strict liability offense (a wrongful act, regardless of intent). That means that a defendant's knowledge of your patent, thoughts about its validity, or intentions are irrelevant to the ultimate question of whether he infringed on your patent.[37] Damages are increased, however, if a defendant knew about your patent, but decided to go ahead with the infringing activity anyway.

How patents come to be owned by universities bears mention. Rights to patent-eligible inventions initially rest with their inventors. Universities can receive ownership of an invention through a contractual agreement between the faculty member who made the

invention and the institution. Under employment policies governing the relationship between faculty and their university employers, faculty typically are required to assign to the university all patent rights to any invention they make while employed by the university. Some, although not all, university employment policies are clear in stating that the university will not claim ownership of a faculty member's patentable invention if that person did not use substantial university resources in "conceiving the invention" (coming up with the patentable invention) or "first reducing it to practice" (figuring out how to make the invention work). What constitutes "substantial university resources" often is less clearly defined than you might expect, and the language in university employment policies concerning patent ownership varies widely from institution to institution. In addition, some faculty, particularly in the natural and applied sciences, move with regularity between professional positions in academia and industry, often simultaneously holding posts in both sectors. For these reasons, the timing and circumstances surrounding faculty inventions, or discoveries, is one area of potential dispute between universities and their faculty.

Trademarks

Trademarks are unusual creatures. Governed by state common law as well as state and federal statutes, trademarks are relatively easy to create and maintain. These features distinguish them from their intellectual-property brethren, copyrights and patents. Patentable inventions are seldom easy to create, and although copyrights can protect even trivial expressions, the most valuable works covered by copyrights (books, movies, software, artwork) are not born in a day. Whereas the periods of protection for copyrights and patents have expanded dramatically throughout history, neither compares with the extent of protection for trademarks, which, in theory, can be protected in perpetuity, as long as they are still in use.

Many are familiar with the ® and ™ symbols, which pertain to trademarks. Only those whose trademarks registered with the USPTO are permitted to use the ® symbol in connection with their trademarks.

Use of the ™ symbol is unregulated. Anyone claiming the rights to a distinctive word, phrase, or symbol may use the ™ symbol in connection with it, although using the symbol does not automatically confer any rights to the person or entity using it. The symbol ℠ is similar to ™ and stands for "service mark." "Trademark" is a term that technically applies to goods (for example, wallets), not services (for example, advertising services), but many use it to refer in general to both goods and services, or simply use the word "mark" for either a trademark and/or a service mark. This book follows the latter convention.

Use is an essential aspect of trademark protection, which differentiates trademarks from copyrights and patents in yet another way. Common-law rights do not apply to marks that are not used, and trademark-registration certificates—whether from a state or the federal government—are not issued unless the applied-for mark is being used. Ultimately, registration at either the state or the federal level is not necessary in order to instigate an action for trademark infringement, as common-law protection extends wherever the mark is used. If a mark is only used in two states, the mark holder's presumed zone of protection only extends to those two states, subject to the rights of any ongoing users of the same mark who began their use of it before the later-in-time user.

Although the use requirement is strict, what qualifies as a protectable trademark is quite expansive. Under the federal Lanham Act of 1946, which provides the foundation for much of trademark law, "any word, name, symbol, or device, or any combination thereof" is eligible for protection, provided that it indicates a source, identifies goods and/or services, and distinguishes those goods and/or services from those of others.[38] State statutes and common-law protection mirror these requirements. What is critical is that the mark must indicate a source, as opposed to merely serving as a description of a product or service. Source indication means that a generic word such as "apple" cannot serve as a trademark for a brand of apple, since awarding protection for it would effectively prevent others from accurately describing their product. But the word "apple" can serve to

indicate a source if it is used in relation to something other than the edible fruit. In short, distinctiveness is what is required.

At the outset, I should also mention that a popular conception of trademarks often leads to a discussion of brands, with a common assumption being that trademarks and brands are one and the same. Brands and trademarks are similar, but they are not synonymous. A coherent brand strategy typically involves the use of trademarks "to provide information regarding source and quality and simultaneously to convey image components regarding power, value, and personality."[39] In short, brands perform trademark functions, but they also do something more: they interact with consumers by enticing, shaping, and impacting their behavior. Consumers are more loyal to brands than they are to trademarks. I discuss the power of brand, and higher education's growing infatuation with it, in more detail in chapter 6.

We often think of trademarks as simply consisting of words or designs, but even items such as colors, smells, and sounds can serve as trademarks, given the broad wording of the Lanham Act. For example, the shade of blue used by Tiffany & Company on its jewelry boxes is a protected trademark. Tiffany does not own that eggshell-blue color outright, and the company could not prevent a manufacturer of birdseed from using the same hue on its packaging. Tiffany does possess certain rights to the use of eggshell blue, however, and thus it could prevent a competing jewelry store from using that color on its jewelry packaging.

In trademark parlance, trademark rights in things like colors are possible, provided that the claimed mark is "nonfunctional"—in other words, no competitive need exists for someone to use the particular color claimed as a mark. Such is the case for something like the eggshell-blue hue that Tiffany & Company has chosen for its jewelry boxes and other packaging. There is no competitive need to use that shade of blue, so granting Tiffany exclusive rights to use that color with respect to its boxes does not put competitors at what courts call "a significant, non-reputation related disadvantage."[40] There is nothing about such boxes dictating that eggshell-blue is a favorable color

for jewelry companies to use; instead, it represents an arbitrary choice made by Tiffany. The company could just as well have picked mauve, and competitors still would not have been placed at a non-reputation related disadvantage. Most consumers who see eggshell-blue on a jewelry box think to themselves, "Tiffany," which shows the power of nonfunctional colors that serve as trademarks.

A competitive need for a color varies, based on the use to which it is put. Take, for example, the color orange in orange-flavored soda. Extending exclusive rights to the color orange, used in relation to orange-flavored soda, to Sunkist *would* put competitors at a significant, non-reputation related disadvantage. Why? Because consumers expect a soda tasting like oranges to be colored orange. In fact, they *want* their orange soda to be orange. If competitors could not use that color, because Sunkist enjoyed trademark protection for it, they would sell less soda for reasons that have nothing to do with the reputation of their product. Black-colored soda that tastes like oranges simply is not appealing to consumers. Therefore, the color orange in the context of orange-flavored soda would be considered functional and not be subject to trademark protection.

The same result applies with respect to the color orange when it is used as the predominant hue on traffic cones. Orange is an appealing choice for the product, given the nature of traffic cones, which need to be highly visible in adverse conditions. Therefore, a competitive need exists, rooted in a concern for consumer safety, to use bright orange on traffic cones, so the color orange would be considered functional in that context, as well.

It is also true that this color on traffic cones is not likely to be viewed as distinctive, even if a manufacturer were to try to claim trademark protection for it. That is because consumers generally view the orange coloration as part of the product itself—traffic cones are orange, just like orange-flavored soda is orange—not as an arbitrary flourish selected by the manufacturer. Change the color being claimed from orange to black and the arguments would shift entirely. No manufacturer needs to have exclusive rights to the color black in order to compete effectively in the traffic-cone business. In fact,

because black blends in with pavement, it is a particularly poor color choice for traffic cones. Because consumers would not expect or require black on traffic cones, and because it provides no advantages, consumers would probably come to view that color as a distinctive source identifier, and competitors would find it nonfunctional, so trademark protection for the color black, used on traffic cones, would be possible.

Determining the scope of trademark protection requires assessing how a mark is used. For example, the registration system maintained by the federal government does not permit Apple, Inc., to enjoy exclusive rights in the word "apple" with respect to every product or service imaginable. Instead, Apple's rights in the word pertain to how the company uses it. Registration certificates issued by the USPTO contain a listing of the goods and/or services in which that trademark is used and protected, and registrants cannot use these certificates as evidence of any superior right (one that legally trumps another's right) to use the mark in relation to goods and/or services outside of those listed on the registration certificate. The USPTO requires trademark applicants to divulge additional information during the application process, such as the date the applicant claims to have first used the mark in commerce with respect to the claimed goods and/or services. Applicants must also submit a specimen of the mark—evidence showing the mark in actual use—before the USPTO will permit its registration.

Common-law, state, and federal trademark protections overlap in complicated ways. Ultimately, however, being the first to employ a particular mark confers certain protections on the initial user, who enjoys superior rights to that mark, at least in connection with that particular good or service. These rights permit the first user to expand its employment of the mark into new geographic regions (although not into new product markets). A superior right becomes constrained, however, should a second-in-time user succeed in registering the mark on the federal level or on a state level. This type of registration provides its holder with federal or state rights to use the mark, limited geographically only by any third-party uses of the mark

that predate the second-in-time user's registration. If you own a federal trademark registration for GIZMO, used in relation to boomerangs, you can shut down any competitor who adopts the same or a confusingly similar mark subsequent to your registration. What you cannot do is shut down a competitor who used GIZMO on boomerangs before you began employing it, although your federal registration effectively constrains this rival firm to the area in which it was using the mark before your registration was granted and prevents it from expanding that area. Nor are you likely to succeed in an action against an ice cream manufacturer who adopts the use of GIZMO on ice cream, subsequent to your registration of it for boomerangs, as the markets for boomerangs and ice cream are distinct and unrelated.

Many mark holders prefer to seek federal registration over state registration, although the latter is easier and cheaper to obtain. Federal registration—which may be maintained in renewable, ten-year terms, assuming the mark is still in use and any required filings are made with the USPTO—provides several benefits over state registration. First, federal registration provides a rebuttable presumption (an assumption accepted by a court until it is disproved) in favor of the mark owner that the mark is valid and owned by the holder of the registration; it also conveys that the owner has exclusive right to use that mark in commerce, with respect to the goods or services listed in the registration.[41] Second, a federal registration provides rebuttable evidence of use of the mark in all fifty states, regardless of whether actual use has occurred in all of those states. Third, it provides national "constructive notice" of the registrant's claim to those rights. This benefit means that later adopters of the mark are viewed as being "on notice" regarding the senior user's rights to the mark. Fourth, it allows the mark to become incontestable after five years of continuous use. "Incontestability" means that the registration serves as conclusive evidence of the holder's exclusive right to use the mark for the claimed goods or services in interstate commerce, which is a valuable asset for a company to have if it wishes to use its trademark registration to help substantiate a high valuation for that company in the event of its sale or acquisition.

No matter what kind of protection is granted—in common law, through use, or through registration at the state and/or federal level—the primary theory behind providing trademark protection is the same. Trademarks allow consumers to quickly identify those goods and services that emanate from or are affiliated with a source they have come to recognize as denoting a quality product or offering.[42] This effectively rewards the trademark holder's continuous and ongoing investment in a distinctive brand and serves as a quality-control measure for consumers. Imagine the disruptive effect on your behavior if you were not certain that the Yoplait-brand yogurt that you reached for in the grocery store one day was the same Yoplait-brand yogurt that you had purchased and enjoyed just last week. You would spend additional time at the grocery store, sifting through the various yogurts—many of which would be branded Yoplait—trying to determine which of them was the one you wanted. Chances are you would make the wrong choice, and so would others. Eventually, brand owners would have no incentive to invest in their brand, as anyone could easily produce knock-offs of their brand without repercussion. Consumer and producer faith in the marketplace would suffer, thus affecting market economics.

Trademark registration allows the holder to initiate legal action regarding trademark infringements, in order to prevent these types of harms from occurring. A jury's determination that a "likelihood of consumer confusion" could or does exist forms the core of such actions, and plaintiffs can plead their case in federal court under the Lanham Act, whether or not their trademark is registered with the USPTO.[43] The Lanham Act allows a legal case to be made for any use of a "word, term, name, symbol, or device, or any combination thereof . . . which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities of another person."[44] Historically, courts required plaintiffs to establish consumer confusion regarding the *source* of the defendant's goods or services, although over time, courts broadened the type and scope

of confusion that is actionable, and Congress amended the Lanham Act accordingly. For example, now courts will entertain claims based on the argument that a defendant's use of a certain mark causes consumers to think that the defendant is sponsored by or affiliated with the plaintiff, even if consumers know that the defendant is the source of the product in question.[45]

Each federal appellate court has articulated a set of factors that should be considered in likelihood-of-confusion analyses, and these factors, plus the weight they should be given when they apply in a particular case, vary slightly from court to court. Typical factors considered in a likelihood-of-confusion analysis include the extent of similarity—in sight, sound, appearance, and meaning—between the plaintiff's trademark and the alleged infringer's mark; the degree of relatedness between the two parties' respective goods or services; the degree of overlap between the trade channels used by the parties; the conditions under which a typical consumer buys each of the products (for example, a child making an impulse buy versus a sophisticated customer engaging in a major purchasing decision); the number and nature of similar marks in use on similar goods; and the extent to which any evidence of actual consumer confusion exists (for example, consumers calling the defendant's company for information about the plaintiff's product). If a likelihood of confusion exists, the court rules that trademark infringement occurred. Prevailing parties in these actions can receive financial compensation (monetary relief) as well as a court order (known as injunctive relief) that the opposing party refrain from future acts of infringement.

Not all trademarks are created equally, which the likelihood-of-confusion analysis takes into account. Trademark law recognizes a continuum of distinctiveness for marks, relative to their uses. Simply put, some trademarks are stronger than others. The USPTO evaluates trademark applications to ensure that only distinctive marks are registered. Categories for marks include generic, descriptive, suggestive, arbitrary, and fanciful. Suggestive, arbitrary, or fanciful marks are considered to be distinctive and therefore can be registered. Generic words are never capable of being registered, and if a mark ever be-

comes generic, it can lose its trademark protection.[46] Marks that are merely descriptive generally cannot be registered, unless there is compelling evidence that a secondary meaning (a source-identifying meaning that is different from the descriptive meaning) exists in the marketplace. Descriptive marks are presumed to be incapable of serving a trademark function, since allowing trademark protection for a descriptive mark could prevent others from accurately portraying a feature or characteristic of their product.

Consider the following example to help clarify these concepts. If I intend to market a new brand of cookie, I can't call them "cookie-brand cookies" and expect to obtain trademark protection. "Cookie" is the generic term for the class of a particular type of baked goods, so it is unavailable to be claimed as a trademark. "Delicious" would also be a poor choice of a trademark for my product line. You probably know this intuitively, but from a trademark perspective, the putative trademark "delicious" merely describes an attribute or characteristic of the product, which means that consumers are unlikely to view it as an indication of its source. If consumers view "delicious" as simply a description of the product, no trademark meaning is conveyed. Furthermore, competitors most likely would need access to the word "delicious" to accurately describe their own cookies. If I had "delicious" as my trademark, legal damage (mischief) would occur if competitors wished to proclaim "Buy our cookies—they are simply delicious!"

If I used "delicious" in relation to computer keyboards instead of cookies, however, "delicious" would be an allowable trademark, as it does not describe any attribute or characteristic of keyboards. In that instance, the mark would be considered arbitrary, as it bears no semantic relationship to the corresponding product. Arbitrary marks are strong (very distinctive) marks.

Suggestive marks are situated between descriptive marks and arbitrary marks on the distinctiveness continuum. These types of marks suggest, but do not describe, the good or service to which they are related. Because some thought is required in order to decipher the connection between the mark and the offering, the mark is deemed

to be distinctive. "London Fog," when used with regard to raincoats, is an example of a suggestive trademark.

The strongest type of mark on the distinctiveness continuum is the fanciful mark. Fanciful trademarks are coined words—that is, they have no meaning in the English language other than as trademarks. Exxon and Kodak are two such examples. Pringles is another. Fanciful terms enjoy the strongest trademark protection, as any use of them in commerce by someone other than their owner is presumed to infringe on a registered trademark. That is because people have no way of understanding fanciful marks other than as trademarks, so multiple uses of the same fanciful mark would confuse consumers. While fanciful marks are the strongest, they are also the hardest to develop, as building consumer recognition between the mark and the related product or service requires significant advertising expenditures.

Trademark-infringement cases always require a careful consideration of the nature of the defendant's use of the mark. While trademark law does not have a written set of fair-use criteria, like copyright law, courts do recognize that some unlicensed uses of protected trademarks must be permitted, provided either that those are not "uses in commerce" or, if they are, that they are not likely to cause consumer confusion. For example, courts permit competitors to refer to each other's products by name for purposes of a true comparison. This is why the maker of a breakfast cereal that wishes to state on this product that its cereal is "lower in sugar than Kellogg's Frosted Flakes" may do so without seeking Kellogg's permission (provided that the statement is true). Likewise, journalists, authors, and other commentators can mention trademarks by name in their works, without seeking permission from the trademark owner, provided that none of these instances amounts to a confusing use in commerce. For example, you will find several registered trademarks mentioned in this book, but none on its cover, where consumers could potentially be confused by the placement of a mark and think that Johns Hopkins University Press was using that mark to help sell the book.

As for the mechanics of registering a trademark with the USPTO, applicants must specify the goods and/or services to which the marks they wish to register apply. All conceivable goods and services are divided into various sets, or classes, that form a uniform classification system, composed of forty-five different classes.[47] For example, an applicant wishing to register a trademark with respect to paint would register the mark in Class 2, which covers paints, lacquers, varnishes, and the like. A salon providing hair-care services would seek registration in Class 45.

Once an application is submitted, a trademark examiner at the USPTO investigates the applied-for mark, assessing whether the mark actually is in use by the applicant, whether it is distinctive, and whether any identical marks exist in the same class or in related classes in which the applicant seeks registration. The examiner searches the official records for previously registered marks, as well as conducts Internet searches to locate similar marks in use that perhaps are not registered. The existence of an identical trademark does not defeat the applicant's ability to register the applied-for mark. Think, for example, of all the different goods and services in relation to which DELTA is used as a mark (the airline and the faucet company being two prime examples). What *does* jeopardize an applicant's chances of registering a particular mark is the existence of any similar marks for the same or nearly the same goods and/or services as those claimed by the applicant. Even though two parties may be using the same marks for the same type of product without causing consumer confusion, the USPTO will decline to grant protection if the trademark examiner believes that a likely basis for confusion exists.

Applicants have opportunities to challenge rejections made by the examining attorney. Assuming that there are only a few rejections (and that the applicant overcomes any objection), an applicant can expect to receive a registration certificate from the USPTO within twelve to eighteen months after filing. Once a trademark attorney is satisfied that an application meets the criteria for registration, the attorney nonetheless does not immediately issue a registration

certificate to the applicant. The application must first pass through a stage where it is "published for opposition." The USPTO publishes all applications that it is considering for registration in an official gazette, mostly read by trademark attorneys. Third parties (or, more often, their attorneys) who believe they would be harmed if the USPTO registered a mark appearing in the gazette have thirty days from the date of publication to formally oppose the prospective registration by filing what is called an "opposition."

Oppositions are filed with an administrative court, known as the Trademark Trial and Appeal Board (TTAB), within the USPTO. Various grounds for opposing a trademark registration exist, the most common being that the entity challenging the registration believes the applicant's mark is likely to be confused with its own mark and, for that reason, should not be registered. If the parties involved do not settle the dispute, the opposition goes to trial, and the TTAB makes a ruling as to whether the applicant's mark can be registered.

While individuals can represent themselves before the USPTO, most choose to engage the services of a trademark attorney. These attorneys typically charge $1,500–$5,000 to handle the trademark application, depending on where they are located, where they practice, and the complexity of the application.[48] The cost of a trademark-registration application goes up significantly if an opposition is filed. The USPTO's charge to review applications is minimal—$275–$350 per class—although applications can become costly if the applicant seeks protection in multiple classes.

Once a trademark is registered, the registrants must pay maintenance and renewal fees (one set of fees per class) to the USPTO at various intervals: the first ones are due between the fifth and sixth years after registration; the second ones, between the ninth and tenth years; and then every ten years thereafter. At each of these points, the registrant must certify that the registered mark is still being used in commerce. Marks that are no longer being used, but for which registrations still exist, are subject to being cancelled if a third party files

a cancellation action with the TTAB. Third parties often take this step if a trademark registration exists for a mark they believe is no longer being used, yet a trademark examiner has cited it as a reason to reject their own application to register the same or a similar mark.

Although there is no shortage of both legal and higher education commentary focusing on the treatment of patents and copyrights by postsecondary institutions,[49] trademark activity by colleges and universities is much less studied.[50] The main reason for this oversight is understandable. Trademarks are the outlier in the traditional intellectual-property triad, consisting of copyrights, patents, and trademarks. The fundamental underpinnings of trademarks differ substantially from those of copyrights and patents, which the Founding Fathers contemplated as rights in gross, meaning rights granted by the government that can be freely transferred between parties, regardless of the owner's use of those rights or connection to or involvement with the works or inventions subject to protection. Rights in gross are awarded for a limited time, in recognition of the need "to promote the Progress of Science and useful Arts."[51] Accordingly, copyrights and patents overlay nicely with higher education's traditional responsibility to create and disseminate new knowledge. The creation of works and innovations protected by these legal principles and rules can be tracked to individuals, who, in higher education, consist of the faculty, the traditional locus of resources and power in colleges and universities.[52]

The granting of trademark protection, on the other hand, has its roots in Congress's ability to regulate commerce between the states. This is viewed as a right applying to commercial activity, and trademark protection for rights holders exists to guard consumers from confusion in the marketplace over the sources of goods and services. This objective is important, but at first blush it may seem ancillary to, or even in tension with, higher education's traditional detachment from the marketplace. Instead of individual authors or inventors, the creation of trademark rights can also lead back to an entity, which, in higher education, means looking at a college or a university as an

institution, traditionally a secondary actor thought of as subservient to, or at least controlled by, the faculty.

Nonetheless, as outlined in chapter 1, the history of modern higher education is a story of higher education's gradual embrace of the marketplace and the weakening grip of faculty over issues of governance and decision making.[53] Consistent with these trends, you might expect colleges and universities to have fully adopted the pursuit of trademarks as an activity that serves institutional interests while providing a possibility for revenue generation. Trademarks, after all, have value because of their meaning in the marketplace, as readily attested to by a visit to any Football Bowl Subdivision institution on a Saturday afternoon in the fall. For colleges and universities, trademarks most visibly involve logos and insignia, sweatshirts, and jerseys.

It would be easy to think of trademarks in higher education as beginning and ending with marks such as these, and certainly the vast majority of the sparse commentary on trademarks in higher education focuses on collegiate licensing programs and the use of institutional trademarks in athletics.[54] But athletics and athletics-related trademarks are only one part of a larger story. For years, institutions of higher education have quietly been amassing substantial trademark portfolios, with marks that go beyond athletics and touch more squarely on topics of teaching and research—the very activities widely thought of as defining higher education. Chapter 3 examines these trends in more detail.

Trade Secrets

Trade-secret law protects information that (1) derives economic value from not being generally known, and (2) is subject to reasonable efforts to keep it secret. Common examples of trade secrets include formulas, technological information, business plans, customer lists, marketing strategies, techniques, patterns, and the like. Until 2016, when the Defend Trade Secrets Act was passed into federal law, state law, not federal law, exclusively governed trade secrets, although forty-six states continue to follow a uniform law, called the Uniform Trade Secrets Act, that defines what constitutes trade secrets and the mis-

appropriation of them by others. As a result, trade-secret law tends to be very similar across states, and now is also uniform at the federal level.

Trade secrets are protectable in perpetuity, without application to or registration with the government, provided that the aforementioned two conditions of eligibility continue to be met. Therefore, trade-secret law arguably encourages people not to share: by keeping an innovation secret, its owner can, in theory, maintain its value in perpetuity. In reality, however, not every trade secret lasts forever. Sometimes their owners tire of the cost and expense of keeping them secret, so they permit them to become known. At other times, the secret loses its economic value. Market conditions change. Or someone else reverse engineers the secret (literally or figuratively taking it apart to discover its components and then attempting to duplicate it), so that other competitors start to use it. Provided that a competitor uses proper means to discover a secret, such as reverse engineering it, the owner whose secret is discovered has no grounds for legal action. The same applies for an owner whose secret is independently discovered by another person, without reverse engineering it.

In light of these features, trade-secret law has an important relationship with patent law: patent law can be viewed as providing an incentive structure so that inventors do not choose trade-secret protection over patent protection. Without governmental involvement, inventors presumably would never freely share the exact nature of their economically valuable inventions with the world, preferring to keep the details of them secret. That is where patent law steps in. The government offers innovators an inducement to reveal their valuable secrets to the public: in exchange for disclosing to the USPTO a new, useful, and nonobvious invention, described in such a way that a person having reasonable skill in the applicable field could make that invention work without undue experimentation, the innovator receives a government-granted private right, in the form of a patent, allowing that person to exclude others from replicating this invention for a limited time period. Without this inducement, innovators might horde their best ideas and never share them with the public—in effect, keeping them as trade secrets. When they do share them, by

seeking patent protection for them, others can incorporate these ideas into "follow-on" innovations by adding new elements onto the original, and the public benefits accordingly.

Despite the incentive offered by a patent, many innovators prefer trade-secret protection over patent protection. Coca-Cola offers a useful illustration. The formula for Coca-Cola is an especially well-guarded trade secret. Had the makers of the soft drink sought patent protection when Dr. John Pemberton invented the beverage in 1886, that patent would have expired over 100 years ago, at which point the formula would have entered the public domain, and anyone could market and sell a beverage with the same chemical composition and taste.[55] Instead, the soft drink's makers chose to keep the formula a trade secret, and the company has maintained that secret for decades. No one (outside of a few individuals in the Coca-Cola company) knows the beverage's exact recipe, and while imitations exist, no one has successfully reverse engineered the product. Should that happen, the competitor could market the same exact beverage, although that rival firm could not call it Coke or Coca-Cola, which are protected trademarks.

While some interplay exists between patent law and trade-secret law, one further point of distinction merits discussion. Trade-secret law protects valuable information that may not be eligible for a patent (and patent protection), because it may not meet patent law's stringent requirements (with novelty, utility, and nonobviousness chief among them). In this sense, trade-secret protection is an easier bar to clear than patent protection. Many things have economic value that would never be patentable. Customer lists are a great example. The neighborhood boy who mows lawns in the summer derives economic value from his list of customers. If a competitor knew the identity and location of each of those clients, and the price they paid to have their lawns mowed, that information would be valuable. In one afternoon, the competitor could disrupt or destroy the kid's business by offering to cut each client's lawn for $5 less than the amount each person currently paid. While this customer list is subject to trade-secret protection—automatically and without applying for it,

provided that the boy makes reasonable efforts to keep it secret—the USPTO would never grant him a patent for it.

In light of this discussion, trade-secret law at first might seem irrelevant to higher education. After all, higher education is a sector traditionally built on openness and sharing. Why would a college or a university refuse to share, or at least provide access to, information that might have value to others? Society looks to higher education to supply it with information of value. Yet, as further discussed in chapter 6, some institutions are now turning to trade-secret law as a method of claiming ownership for some types of information and then refusing to grant others access to this information, because the institution designates it as a trade secret.

Internet Domain Names

Internet domain names do not constitute intellectual property, as it is classically defined. Instead, they reflect contractual rights, obtained through a registration system, to intangible space that can serve a similar function to that of trademarks. Trademark holders often view their domain-name holdings as equivalent to intangible property or as extensions of their trademarks. A trademark registrant's inability to register a domain name that corresponds to its trademark, because someone else has already registered that name, may signal larger problems the registrant faces involving the strength and validity of its trademark. For that reason, online space can be contested space, particularly because Internet domain names are pieces of virtual real estate that can generate intense rivalry. Their registration generally operates on the age-old premise of "first come, first served," which can surprise the unwary.

From a technical standpoint, domain names are strings of letters and numbers that are substitutes for the numerical addresses actually used by Internet host computers to locate one another and provide requested information to end users. One example of a domain name is AMAZON.COM. The domain-name system (DNS) essentially is a directory, or a lookup system, that allows users to interact with online information in relation to alphanumeric strings, as opposed to Internet

protocol addresses whose numbers are seldom memorable. Compare the ease with which you can remember CNN.COM versus its corresponding Internet protocol address, 157.166.226.26. Like tangible property, every domain name is unique, and their scarcity means that their function as a brand is important. As Dan Burk recognized in 1995, domain names are "both names and addresses; they both locate and identify Internet sources."[56]

While the technical function of domain names, as Internet locations, is the reason for their existence, the identifying importance of domain names is the feature that is of interest for trademarks and brands. If your brand is Coke, owning COAK.COM but not COKE .COM will not do. General rules of thumb dictate that "the more memorable a domain name, the more value it enjoys. Also, less is more; a short domain name is worth more than a long domain name."[57]

The Internet Corporation for Assigned Names and Numbers (ICANN)—a nonprofit corporation based in Marina del Ray, California—has technical oversight authority over most of what we think of as the functioning Internet. ICANN's ties to academe run deep. The late Jonathan Postel, formerly a computer scientist at the University of Southern California, was a driving force behind the formation of ICANN, and Tamar Frankel, a law professor at Boston University, oversaw early meetings designed to respond to the federal government's request that a not-for-profit entity be created to perform the technical functions the government no longer wished to coordinate in the fledgling medium.[58]

Prior to the founding of ICANN, oversight authority for the Internet's architecture was shared by a variety of entities, including the National Science Foundation, the National Aeronautics and Space Administration, the U.S. Army, the University of Southern California, Stanford Research Institute, the University of Maryland, the Internet Software Consortium, and a couple of additional entities.[59] ICANN's primary mission consists of keeping the Internet secure, stable, and interoperable across countries and platforms. ICANN delegates key technical-coordinating functions—such as the space allocation of

Internet protocol addresses, protocol parameter assignments, and management of the DNS and root-server functions of the Internet—to the Internet Assigned Numbers Authority (IANA), a California-based subsidiary. Together, these two entities play important roles in promoting the fair and manageable use and functioning of the global DNS, most particularly as it relates to the creation and maintenance of new Internet root zones, which are the letters that appear in the space after the period farthest to the right in a URL address. While ICANN, by necessity, devises and disseminates policies to accomplish its mission, as a nongovernmental organization, it technically does not possess global policy-making authority over the Internet. This virtual power vacuum means that various national and state legislatures, as well as nonprofit organizations, contribute significantly to the formation of what we might think of as global Internet law and policy.[60]

Name space on the Internet is parceled out into distinctly manageable, top-level domains (called TLDs), or root zones, which are demarcated with the final period in the string, or root. TLDs are further separated into generic TLDs (called gTLDs) and TLDs distinguished by a two-letter country code (called ccTLDs). Originally only seven gTLDs—.COM, .ORG, .NET, .EDU, .INT, .GOV, and .MIL—and 236 ccTLDs existed. ICANN introduced seven additional gTLDs in November of 2000—.BIZ, .MUSEUM, .PRO, .INFO, .NAME, .AERO, and .COOP—although none of them proved as popular as the original seven gTLDs. More gTLDs were soon added, including .CAT, .JOBS, .MOBI, .XXX, and .TRAVEL.

Space within TLDs may be further parceled out and registered to end users, creating what we think of as domain names, which technically are second-level domain names, like NIKE.COM. Records of space allocation in a given TLD are kept by one entity, called a registry. Registries permit entities called registrars, which must meet certain criteria established by each registry, to sell rights to space in the TLD that the registry controls. Examples of popular registrars include GoDaddy and Network Solutions. Registration in some TLDs, such as .COM, is open to all comers willing to pay the yearly

registration price, whereas registration in other TLDs—particularly ccTLDs—is restricted and available only to those who meet certain eligibility criteria, such as owning a trademark registered in the corresponding country or being a citizen of the corresponding country. For example, Americans cannot register domain names in Canada's extension, .CA, without establishing that they meet one of several rigid "Canadian presence requirements."[61]

Registries require registrars to collect contact information from registrants and make that information publicly available through what is called a WHOIS database. These databases are accessible through registrar websites and allow browsers to determine the name, email address, and mailing address for the registrant of any given domain name registered through that registrar. Rampant inaccuracies exist in these databases, however, as the information submitted by registrants is not independently verified, nor is there any penalty for providing incomplete, inaccurate, or fraudulent information.

In 2012, after a period of lengthy consideration and discussion, ICANN began accepting applications for the creation of new gTLDs, including ones in non-Latin characters (like Cyrillic, Arabic, and Chinese). These new domain-name extensions were intended to serve a variety of Internet users. ICANN contemplated that products (such as .IPAD), companies (such as .MICROSOFT), industries (such as .BANK), and regions (such as .SOUTH), among others, might all be reflected in the new root space. The application process was not designed to be easy. Applicants had to pay $185,000 to ICANN and satisfy a variety of criteria that organization established, mainly aimed at ensuring the applicant's financial and technical viability to serve as a registry for a domain-name extension.

ICANN received nearly 2,000 applications once the application period opened. New extensions were approved and, beginning in October 2013, registrars began selling registrations using these extensions to the public.[62] The first seven new gTLDs made available to the public were .BIKE, .CLOTHING, .GURU, .HOLDINGS, .PLUMBING, .SINGLES, and .VENTURES.[63] The extensions .COLLEGE and .UNIVERSITY both were approved in April 2014, but neither is oper-

ated by an accredited higher education institution. The marketers behind the .COLLEGE extension see it as innovative space capable of challenging the traditional .EDU extension that they claim "does not allow for the full spectrum of education-based services to establish an Internet presence."[64]

Only three universities in the world, all located in Australia, opted to apply to create their own branded extension. In January 2014, Monash University in Melbourne became the first to receive ICANN approval to operate its extension.[65] According to a press release, the university viewed the acquisition of .MONASH as a reflection of its presence as a "global institution," and a tool for helping the university develop a new "customer-focused University web presence."[66]

Some argue that the only people likely to benefit from this most-recent expansion of the DNS are attorneys and marketers, who stand to earn fees based on their ability to help their clients understand and navigate these new virtual spaces. Detractors argue that for brands that have carefully cultivated their image online, the new extensions simply create more boundaries to police, patrol, and manage. Should Coca-Cola apply to create the extension .COKE? What about registering second-level domain names in seemingly relevant new extensions, like COKE.BEVERAGE or COKE.DRINK? ICANN's founding chairperson, and a critic of the expansion, voiced her concern, stating that "the problem is not the shortage of space in the field of all possible names, but the subdivision of space in Coca-Cola's cultivated namespace."[67]

This unease touches on an inescapable reality regarding domain-name space: just like trademarks, domain names convey meaning to Internet users, and people expect trademarks to be predictably reflected in domain names. Commercial harm can result, however, for quite simple reasons: (1) anyone willing to pay a minimal registration fee can register a domain name in unrestricted TLDs, such as the .COM, .NET, or .ORG extensions, and (2) registrars in unrestricted extensions require no proof from applicants that the applicants are within their legal rights to register a given domain name incorporating a trademark. In light of these features of the DNS, savvy companies often defensively register a variety of domain names that

consumers might use to locate them online. Otherwise, firms risk ceding domain-name space that either references them, or incorporates their trademarks, to other entities, whose claims to that space may only grow in strength over time.

With these realities in mind, the allure of having but one domain-name registration in a restricted, dedicated space that at once conveys authenticity and legitimacy seems compelling. The .EDU extension is an example of a restricted online space, as registration within it is tightly regulated by EDUCAUSE, the entity that serves as the .EDU's registry. Unlike purely commercial concerns, forced to proactively register dozens of domain names across a variety of unrestricted domain-name extensions, such as .COM, .NET, and .ORG, registrants in a handful of restricted extensions like .EDU do not face the same compulsion to cover the board with proactive domain-name registrations. Only those who meet eligibility criteria can register space in restricted extensions like .EDU, and registrations outside of a restricted extension may be superfluous, given that the value of a restricted extension is the sense of authenticity and legitimacy it conveys, by virtue of its exclusivity, to those with space within the extension.

Incidentally, authenticity and legitimacy are what many in higher education were given, in the form of the .EDU extension, from the creation of the Internet, well before others lobbied ICANN to expand the root zone to accommodate more-commercial domains. Chapter 6 discusses in more detail the .EDU extension, its history, and the dispute-resolution mechanisms that higher education has turned to in order to lay claim to cyberspaces outside of the .EDU extension.

Right of Publicity

The right of publicity is an intangible right recognized in many states, although it is not traditionally viewed as a form of intellectual property in the United States. Publicity rights share some features in common with trademark law, and for that reason, publicity rights can also become an area for legal action under the federal Lanham Act. The right of publicity protects the economic interest you pos-

sess in your name, voice, image, and likeness. It is closely related to a type of legal action for invasion of privacy, known as appropriation, which protects a less tangible interest—your dignity—in the unlicensed use of your name, voice, image, or likeness. These two rights differ in that the right of publicity protects an economic interest for the famous, whereas appropriation protects dignity, an interest held by *all* individuals. Fame, however, is an elusive concept, and many courts recognize degrees of fame, which permits those with a limited amount to be able to recover damages under the right of publicity.

The concept of economic injury that animates the right of publicity is that famous individuals have a marketplace interest in their identifying features. People are willing to pay money to famous individuals in exchange for the right to use their names, voices, images, or likenesses in connection with products and services. Publicity rights are what, for example, prevents a car dealership from using the image of George Clooney in its advertising without his permission. People would be likely to react favorably to the advertisement, or at least remember it, precisely because of George Clooney's fame, not the fame or notoriety of the car dealership. In effect, Clooney's image, in conjunction with the ad, would signal his endorsement of the car dealership. That endorsement has a price, determined by Clooney's level of fame, and his publicity rights help protect that economic value.

While publicity rights and the right of appropriation are not traditionally viewed as types of intellectual property in the United States, this book discusses them, because they form part of the laws of competition that often overlap or come into play with intellectual-property rights. In particular, publicity rights share common features with trademark law and copyright law. Trademark law protects the economic value of associations with signs and symbols in much the same way as publicity rights perform that function with respect to famous individuals' names, voices, images, and likenesses. A famous person's image, like a trademark, signifies something in the minds of consumers, whether it is good, bad, or something in between.

The right of publicity is similar to copyright in that both have built-in tensions with the First Amendment value of free expression. Copyright law's fair-use doctrine helps alleviate this tension by safeguarding certain favored forms of expression that otherwise would constitute copyright infringement. Similar to the first factor in a copyright fair-use analysis (the purpose and character of the use), courts in right-of-publicity cases look at whether the alleged violator's expression transforms the name, voice, image, and/or likeness of the plaintiff by changing them or placing them in a new light. This transformativeness is a key determinant in deciding whether the expression violates the plaintiff's right of publicity. Some breathing room must exist for unlicensed uses of authors' copyrights; otherwise, every book review would constitute copyright infringement if it included unlicensed quotes from the book. The same principle applies in the right of publicity. Every magazine or newspaper that published a photo of a celebrity without payment to that individual would violate the celebrity's right of publicity if the transformative nature of the photo's use were not taken into account.

As the California Supreme Court has commented regarding the tension between the right of publicity and free expression, the balance between the two turns on "whether the celebrity likeness is one of the 'raw materials' from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether the product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness."[68] The extent to which the use of the celebrity's name or likeness relates to the conveyance of news—an important First Amendment activity—has a bearing on this assessment. The less tied to news, commentary, or opinion your unlicensed use of a celebrity's name or image is, the more likely that use is to be viewed as commercial, not expressive, and thereby regarded as treading on publicity rights.

The connection between the right of publicity and higher education may not be immediately obvious, and for good reason: institu-

tions themselves have no rights of publicity, as grounds for legal action in this regard are personal, applying to an individual.[69] Many superstars within higher education, however, are turning to such actions to protect their rights, sometimes even bringing suit against their own universities. For example, the publicity rights enjoyed by famous football and basketball coaches, as well as student-athletes, often pit the interests of these individuals against those of the institution for whom they coach or play a sport. Institutions increasingly are aware of the economic values and opportunities that come from uses of their coaches' and athletes' likenesses. In chapter 6, I discuss high-profile litigation over these very issues, involving the National Collegiate Athletic Association (NCAA), current and former student-athletes, and an electronic-game maker, EA Sports.

Chapter Three

University™

Rolling Heads, Rolling Tide

Mary Cesar owns Mary's Cakes and Pastries bakery, which she describes as "a small shop located on a little back alley in downtown Northport, Alabama."[1] Specializing in custom cake orders, many of the bakery treats Mary sells in her shop are Crimson Tide–themed cookies and cakes—that is, baked goods incorporating the capital letter *A* and University of Alabama's color scheme. Given her location just outside of Tuscaloosa—the university's home—many are eager to buy these goodies.

But lawyers for the Collegiate Licensing Company (CLC)—the entity that handles the University of Alabama's trademark licensing—at first did not appreciate Cesar's commercial endeavors. Because she had not licensed the use of Alabama trademarks from the CLC, lawyers for the company sent her a cease-and-desist letter in 2012, alleging that her use of the marks was confusing and harmful to the university.[2]

Many in the local community viewed this enforcement effort as absurd and hurtful. Did the university intend to put Mary's Cakes and Pastries out of business? What was there to harm the university, given that her cakes and pastries did not denigrate the University of Alabama, but lauded it? One of Cesar's special Crimson Tide cakes had once even been purchased by the university's football coaching staff for display and enjoyment on National Signing Day. The reaction of one of the university's alumni, described in the *Tuscaloosa News*, was typical: "I say 'for shame, alma mater.' You are behaving like a

greedy shrew defending a girlie Script 'A.' This is a poor representation of a university that at one time I had been extremely proud of."[3]

Fortunately, Cesar and the university were able to settle this dispute, with the university issuing an apology and the two agreeing that Cesar could continue her sales of Crimson Tide–themed pastries with the payment of a $10 licensing fee.[4] But the situation was not without harm to the university's reputation, and Cesar considered a lawsuit. She ultimately decided against it, stating, "It's one of those things where doing the right thing and the practical thing may not be the same."[5] The website for her business now states that "Mary's Cakes & Pastries is an OFFICIAL, licensed vendor of University of Alabama themed sweets."[6] It also features Mary in a video, noting in a sentence that sounds too careful to have been drafted by anyone other than the University of Alabama's attorneys, that "we are officially licensed to put their indicia on any baked good that we make."

The dispute between Mary Cesar and the University of Alabama was not an aberration. The university has developed a history of aggressive assertion with regard to its trademarks, issuing over 150 trademark cease-and-desist letters in the past ten years alone.[7] In 2005, the university sued another of its alumni, Daniel Moore, who, since 1979 (doing business as New Life Art), had been painting famous football scenes depicting the university's team.[8] The paintings feature realistic portrayals of the team's uniforms, including helmets and jerseys, in the university's crimson and white colors. Importantly, however, no university trademark appeared outside of the image area of these paintings, which means that the appearance of any trademark was related to Moore's artistic expression, and not to any advertising of it.

In an attempt to suppress this creative activity (because Moore refused to pay licensing fees to the university), the University of Alabama argued that Moore could not use any of the university's trademarks or colors in his paintings, even though they were incidental to his depiction of historical events. An appellate court roundly rejected this argument, concluding that "the First Amendment interests in artistic expression so clearly outweigh whatever consumer

confusion that might exist on these facts that we must necessarily conclude that there has been no violation of the Lanham Act."[9]

Twenty-seven universities with major athletics programs filed a supporting brief in the case. They wrote in favor of the University of Alabama's expansive view of trademark protection, which the university spent nearly $1.5 million in legal fees to advance.[10] These other universities couched their limited and dangerous view of artists' rights in terms of concern for their institutions' image, which they argued was critical in maximizing philanthropic donations. They wrote, "[Universities] control their image, in part, by controlling those symbols that identify and distinguish them to the public—viz., their trademarks and service marks, which are typically presented in the specific school colors of each university, as well as those colors themselves."[11]

More recently, the University of Alabama and the estate of its late football coach, Paul "Bear" Bryant, opposed a trademark application filed by two Alabama football fans who sought to register HOUNDS TOOTH MAFIA in stylized fashion, overlaid on a houndstooth pattern.[12] An opposition is a legal proceeding in which a trademark holder has the chance to prove that it would be harmed by the registration of a new trademark that the USPTO has approved for registration (see chapter 2). Only after a USPTO attorney examines an application, and decides that it is fit for registration, do third-party mark holders have a chance to oppose an application, as the University of Alabama did.

Since at least as early as 2009, the university has sold merchandise and apparel featuring a crimson-and-white houndstooth pattern, modeled after the fedoras that "Bear" Bryant often wore on game days. The university's use of the pattern, however, dates back to 1983, the year that Coach Bryant died, when Alabama football players wore helmet stickers bearing a houndstooth pattern to commemorate their late coach. In the opposition, the university claimed that its use of the pattern had come to be identified with Coach Bryant, as well as with the university's goods and its educational and athletic services. Even though the applicants seeking registration of HOUNDSTOOTH

MAFIA admitted that their trademark referenced the houndstooth hat that Coach Bryant wore at Alabama football games, the TTAB rejected the university's argument. It held that the houndstooth pattern, as it was used by the university, did not serve as an indicator of a source or of sponsorship, but rather was used in an ornamental fashion as a nondistinctive background design. The TTAB concluded that "the mere fact that Coach Bryant was recognized for wearing patterned fedoras at the University's football games does not endow . . . the University with trademark rights in the Houndstooth Pattern."[13] The University of Alabama's financially self-sufficient athletics department reportedly spent over $150,000 in legal fees to advance its losing argument but eventually extracted a settlement from the company behind the HOUNDSTOOTH MAFIA.[14] Under the terms of the settlement, the start-up company signed over to the university all rights, title, and interest to the HOUNDSTOOTH MAFIA trademark, which the university now owns.[15]

While these trademark tactics by the University of Alabama may, at one time, have been seen as an exception, other stories and data presented in this chapter show that they increasingly are becoming the norm in higher education. I examine the two-fold problem regarding trademarks in higher education: the growing belief that everything protectable as a trademark needs to be claimed as such, and the noxious enforcement temptations that come from these rights. Both of these activities represent uses of private rights that endanger higher education's orientation toward acting in the public interest. Mary Cesars of the world, watch out.

The Emergence of Trademark Protection in Higher Education

Comprehending the current state of trademark activity in higher education first requires understanding how trademarks emerged in this sphere. The prevailing narrative is that colleges and universities only seek trademark protection in order to engage in licensing arrangements with athletics firms and other companies, which use the marks on t-shirts, coffee mugs, and similar items.

While this perception is no longer true today, the use of college and university names, logos, and insignia on tangible products has deep roots. Collegiate athletic teams have worn uniforms adorned with marks identifying their sponsoring institutions for as long as teams have been fielded, and individual college and university bookstores sold folders, binders, and pencils imprinted with college and university marks since at least the early 1900s.[16] But these activities were always incidental undertakings, intended only to benefit the institution and its students and alumni directly—they were never industries unto themselves for the consuming public.

The market for the widespread sale of products featuring the marks of colleges and universities emerged in the mid- to late 1970s, coinciding with the boom in televising collegiate sports. Commentators point to the Ohio State University and the University of California–Los Angeles (UCLA) as being the first institutions to establish official licensing programs, although records are incomplete and other evidence points to earlier, informal licensing efforts at a variety of institutions.[17] The University of Notre Dame, for example, licensed the production of its class rings in 1930.[18] The University of Pittsburgh (Pitt) registered the design of its class ring at the state level in Pennsylvania in 1961 and subsequently licensed it to jewelers who produced the rings. Ohio State launched its licensing program in September 1974, by decree of its board of trustees.[19] UCLA licensed the UCLA Bruin mascot to a manufacturer of watches in July 1973, at a royalty of four percent.[20] More licensing deals for UCLA soon followed.

Seeking and obtaining federal registration for their trademarks was important in these university licensing initiatives, as trademark registration provides the basis for claiming the exclusive rights that are needed to use and license the trademark without fear of being sued. The University of Houston maintains that it was the first college or university to obtain federal registration of its institutional seal as a trademark in 1971. Two years later, the Ohio State University achieved federal registration for its name and mascot, which some viewed as a path-breaking event.[21]

According to recent estimates, collegiate licensing—where institutions of higher education license the use of their trademark-protected names, logos, and insignia to companies that manufacture products such as sportswear, stationery, and office goods—is a $4.6 billion industry, up from $100 million in 1981.[22] Royalties generated from the sale of officially licensed merchandise are paid to those institutions that license their trademarks.

Though no one today seriously questions the existence of this industry or the ability of colleges and universities to participate in and profit from it, the emergence of collegiate licensing about forty years ago was met with heated debate. Some viewed the collection of royalties by colleges and universities as akin to taxation. Others were opposed to the notion that colleges and universities could exert control over who could capitalize on their names and insignias, in the belief that higher education served a public purpose that yielded public ownership. Regardless of the ownership question with institutional trademarks, some simply resisted licensing out of fear that it would alter the traditional nonprofit ethos of higher education.[23]

In view of these concerns, the collegiate-licensing industry started slowly. Typically, only large institutions had licensing programs until the 1980s, when they became more pervasive. By 1984, about seventy colleges and universities had licensing programs.[24] That decade saw several important events that would help set the course for the industry's formation.

The first developments were on the legal front. In 1981, the Internal Revenue Service (IRS) issued an important private-letter ruling concerning the licensing of trademarks.[25] The ruling stated that payments to licensors for the use of their names, logos, and insignia were royalties and, as such, were not taxable as unrelated business income. This ruling came at an important time in the growth of licensing, and at a point when other aspects of higher education operations were under scrutiny for possible unrelated-business-income infractions.[26]

In 1982, the University of Southern California (USC), UCLA, and Pitt sued Champion Products—the biggest supplier of branded athletic merchandise at the time—for trademark infringement.[27] For

years, Champion had taken the position that it could sell athletic merchandise imprinted with college and university names and insignia to the general public without licenses from the institutions whose names and insignia appeared on the merchandise. Most institutions at that time did not have federal trademark registrations for their names, logos, and insignias, or robust licensing programs, which seemed to bolster Champion's position.

Whereas USC and UCLA settled with Champion early in the case, Pitt continued on to trial in a district court in western Pennsylvania, seeking to have Champion stop selling Pitt-related items. That court ruled against the local plaintiff, finding that years of inaction and effective acquiescence by Pitt invalidated its infringement claims. The Court of Appeals for the Third Circuit reversed that decision. Although Pitt had failed to enforce its rights to its marks against the use of them by Champion—which had been selling Pitt-imprinted merchandise in Pittsburgh since 1936 or earlier—the circuit court ruled that the university's previous inaction regarding its rights did not have a negative impact on the sporting-goods supplier, and injunctive relief, where the defendant would have to cease its infringement, therefore was possible.[28] The appellate court also noted that the case did not present a situation where Pitt, through inaction, was attempting to capitalize on the efforts of Champion.[29] To the contrary, "it is Champion which seeks to profit from Pitt's investment, particularly in its athletic program."[30] The court correctly recognized that the alleged confusion at issue in the case did not involve the products' source of manufacture, which was the only source of confusion recognized by courts at the time,[31] but rather the sponsorship, affiliation, or approval of the products by Pitt, whose names and emblems were the "triggering mechanism[s]" for the products' sales.[32]

The circuit court sent the case back to the trial court for reconsideration of Pitt's claim of trademark confusion. This time, the trial court conceded that "the notion that a university's name and insignia are its own property, to do with as it chooses, has a certain commonsense appeal."[33] The court ultimately decided, however, that there

was no likelihood of confusion—"whether of source, origin, sponsorship, endorsement, or any other nature"—a surprising finding for many.[34] Even though, in the end, Champion won the case, the company executed a licensing agreement with Pitt in November 1983, and the district court's decision was nullified as part of the agreement. The market for affinity wear was expanding rapidly, and Champion most likely realized that it stood to make more money by working with colleges and universities to license their marks in new markets, as opposed to pursuing a course that inevitably would lead to additional distracting and costly legal challenges.

Despite the outcome and ultimate settlement in this particular legal case, the Third Circuit Court's opinion in *University of Pittsburgh* was of vast importance to the growth of the collegiate-licensing industry. The appellate court thoughtfully considered and legitimized an emerging and broader theory of confusion—that consumers can become confused about a product's sponsorship, affiliation, or approval, not solely its source of manufacture. Other courts around the country soon adopted this broader understanding of confusion in other contexts as well, and in 1989, federal trademark statutes were amended to reflect these developments.[35]

Recognition of this theory was of particular importance to trademark holders who sought to capitalize on their brand by applying it to wares outside of their primary service market. Courts and commentators initially had doubted whether federal trademark law permitted mark holders to license collateral, or noncompetitive, uses of their marks—that is, those occurring in channels unrelated to their primary uses (in the case of colleges and universities, uses apart from educational services). The United States Court of Appeals for the Third Circuit's opinion in *University of Pittsburgh* clarified that such collateral uses are trademark eligible, opening the door for universities to "maximize royalties" by widely licensing products unrelated to educational services.[36] The decision further established that college and university names, logos, and insignias are not actually in the public domain, even if their owners did not actively police their use in the past.

A second development in the 1980s that helped burnish the budding collegiate-licensing industry was the emergence of licensing consortia. The first such group—International Collegiate Enterprise (ICE)—was formed in late 1979.[37] The purpose of the group was to provide an efficient mechanism by which member institutions could partner with quality manufacturers that would produce licensed merchandise. To manufacturers that wished to market collegiate apparel, consortia offered the lure of one-stop shopping that reduced transaction costs and offered economies of scale.[38]

Other trademark-licensing management companies were created in the early 1980s, such as Golden Eagle Enterprises, which merged with ICE in 1983, creating a licensing group of sixty member institutions called Collegiate Concepts.[39] Now known as the Collegiate Licensing Company, and owned (since 2007) by IMG Worldwide, the company represents the NCAA, the Heisman Trophy award, and nearly 200 colleges, universities, athletic conferences, and football bowls.[40] Although the CLC is the industry leader, not all institutions are affiliated with it. Some license their trademarks independently, while others are members of a competitor consortium, Learfield Licensing Partners, which represents more than 180 institutions.[41]

For activity outside of the domestic market, some colleges and universities contract with different companies to license their names, logos, and insignia internationally. Although monitoring international uses of collegiate marks may seem unimportant to all but the largest and most famous of institutions, more modest ones like Western Kentucky University (WKU) have also encountered trademark issues on the international front. In 2004 in Italy, WKU sued an Italian media company, challenging the company's wholesale appropriation of the university's furry mascot, known as "Big Red," for use in a popular television show.[42] Even though the show's creator admitted that he copied the show's character from the WKU mascot, the Italian judge ruled in favor of the media company, which happened to be owned by the country's former prime minister, Silvio Berlusconi.[43]

Dating back to their formation, licensing consortia have played an important role in exposing colleges and universities to new markets and providing one-stop shopping for institutions looking to conduct business with companies that purvey products of known quality. Institutions typically initiated such programs by licensing their trademarks for use on athletic apparel, but this involvement with consortia allowed an easy expansion into nonapparel markets, such as paper products, leisure equipment, and even coffins.[44] This marketplace expansion continues, seemingly unabated. In 2013, the University of Notre Dame unveiled a branded fragrance line, which comes in his and her versions, called "ND Gold Eau de Toilette" and "Lady Irish Eau de Parfum."[45] The bottles first hit the market retailing for $60 each.

The licensing consortia proved to be a timely antidote to profiteers who wished to capitalize on college and university iconography, often in a tawdry fashion. For example, in the late 1980s and early 1990s, enterprising students in Madison, Wisconsin, took to selling—without authorization from the University of Wisconsin—condoms emblazoned with the logo of Bucky Badger, the university's mascot. The packaging read "Get Lucky Bucky."[46]

Given the services these consortia provide, and the income they generate from doing so, you might wonder why the NCAA—ever in search of revenues from collegiate athletics—has no involvement with them, and instead is a client of the CLC. The NCAA did endeavor to capitalize on collegiate licensing in the 1970s but achieved only limited success. In 1974, the NCAA sent letters to the athletic directors at 125 institutions well known for their sports programs, asking them to give the NCAA the right to use their names and other distinctive marks so that it could license such uses in Japan.[47] Amazingly, 84 institutions agreed, and a licensee in Japan soon made millions of dollars selling apparel bearing these institutions' marks. The company even went so far as to apply to register, in its own name, many of these marks in Japan and other foreign countries, which its agreement with the NCAA purportedly allowed it to do. Some institutions withdrew from this arrangement once they learned its full

parameters, which only highlighted the importance of seeking trademark rights in institutions' names, logos, and insignia and carefully monitoring their use.

A third development in the 1980s that bolstered the growth of collegiate licensing was the formation of an industry group, the Association of Collegiate Licensing Administrators (ACLA). Formed in 1986, the ACLA held its first meeting in Anaheim, California, in 1987, where more than thirty institutions were represented.[48] The ACLA's annual meetings and programming helped to professionalize and unify a fledgling industry. In 2002, the ACLA merged with another industry group to form the International Collegiate Licensing Association, which is administered by the National Association of Collegiate Directors of Athletics.

A fourth and final development that contributed to the institutionalization of the collegiate-licensing industry was the academic attention it received, beginning in the 1980s. Finus P. Gaston devoted his 1984 doctoral dissertation to understanding all aspects of the emerging collegiate-licensing industry, and others credit his work for sparking further study of the movement.[49] He surveyed over 150 university administrators (presidents, financial vice presidents, athletic directors, and chairpersons of intercollegiate athletic committees) to learn their views on various aspects of collegiate licensing. Targeted participants were administrators at universities holding membership in either the College Football Association, the Big Ten Athletic Conference, or the Pacific Coast Athletic Conference. One important finding from his study concerned the organizational units that housed trademark-licensing programs at the institutions he surveyed. Unlike patenting—which universities largely managed through institutional offices of technology transfer—trademark activities were centered in a wide variety of institutional offices: financial affairs (41.9%); student affairs (2.3%); academic affairs (2.3%); athletic departments (16.3%); offices of the president (11.6%); development (2.3%); and other areas (20.9%), such as the offices of general counsel, public relations, and auxiliary services.[50]

Consensus, however, not differences, characterized Gaston's findings. The majority of respondents were in agreement concerning legal and financial principles central to collegiate licensing, although they had varied opinions as to how licensing income should be distributed. Fundamental agreement also existed concerning the legitimacy of the activity for institutions of higher education and these institutions' legal right to protect the use of their names, logos, and insignia on commercial products. Most respondents felt that the primary reason for establishing a collegiate-licensing program should not be to create a source of unrestricted income for the institution. Respondents also recognized that litigation might be necessary to protect their trademark rights.

Gaston spent most of his career handling trademark licensing and disputes for the University of Alabama, where—as of 2016—he was the senior associate athletics director and chief financial officer of the university's athletics department.[51] Gaston's dissertation led to further examination of this nascent industry by academics, a number of whom—like Gaston—themselves had ties to or roles within the collegiate-licensing industry.[52]

These developments meant that the 1990s saw increasing numbers of institutions establish licensing programs, staffed with full-time licensing professionals. As competition for market share escalated, however, licensing revenue leveled off as the marketplace became saturated and oversupplied with inventory. Colleges and universities no longer competed primarily with each other for closet space and shelf space. Teams, institutions, and companies of every kind and level of fame found that consumers were interested in purchasing items emblazoned with their names, logos, and insignia.

As the trademark-licensing industry became professionalized within higher education, the 1990s and 2000s saw efforts by colleges and universities to enforce their trademarks.[53] Many of these cases concerned interests close to home. For example, some colleges and universities went after local businesses with names that might suggest sponsorship, affiliation, or approval by the local college or university, including everything from a minor league baseball team, a health

care–services provider, and a dental laboratory, to prep schools and sports bars.[54] To give but one example, Emory University, in Atlanta, pursued enforcement activity against a laser vision-correction center, a flower shop, a dental practice, an animal hospital, and a Chinese-language academy.[55]

Taken together, these efforts were part of a larger movement in higher education—initiated or continued with the earnest support of the collegiate-licensing consortia—to police unauthorized uses of college and university trademarks, even ones made by persons or groups with some plausible tie to the institution, such as alumni associations.[56] Occasionally, these efforts led universities to advance novel arguments in favor of protection for institutional trademarks, such as when the University of Florida claimed that its course-numbering system—including course numbers, the locations of classes, and times when classes met—was a service mark that prevented a third party from selling information to students about that university's course offerings.[57]

By the end of the 1990s, colleges and universities also faced new challenges to their trademarks, brought about by the advent of cyberspace and the cheap availability of domain names. EDUCAUSE has managed the generic, top-level domain-name extension .EDU since 2001 (see chapter 2). Although this organization establishes the eligibility requirements for registering space in the .EDU domain-name extension, it has no ability to prevent individuals or companies from registering domain names in other top-level extensions that may replicate or incorporate trademarks owned by colleges and universities. Thus, in the late 1990s, when cybersquatters began registering .COM, .NET, and .ORG domain names that incorporated college and university trademarks, institutions were without an external ally to prevent or provide a remedy for offending registrations. Many of the domain names and their associated website contents were of a sexually explicit nature, and colleges and universities turned to the arbitration and litigation avenues available to all trademark-rights holders when these activities surfaced, as further described in Chapter 6.

Trademark-Rights Accretion in Higher Education

This history of trademarks in academia leads to several questions. What kinds of trademarks have colleges and universities sought to protect through federal registration? How common is trademark-registration activity in higher education, and which institutions engage in it? What are the trends in terms of the numbers and types of trademarks registered?

By the end of 2012, American colleges and universities owned 10,265 federal trademark registrations.[58] It is important not to confuse *trademark registrations* with *trademarks*. Institutions often have multiple registrations—covering different classes of goods or services, or different graphical displays of the mark in question—for what consumers would consider the same trademark. For example, many institutions commonly register their name with respect to "educational services, namely conducting courses of instruction on a university level," as well as in relation to other areas, such as "entertainment services, namely presenting intercollegiate sporting events" or "clothing, namely caps, t-shirts, and sweatshirts."[59]

For institutions that own at least one trademark registration at the federal level, the average number of federal trademark registrations owned per institution is ten. The number of registrations owned ranges from one registration to several hundred. For example, the University of Texas System owned 294 federal trademark registrations through the end of 2012. Other top owners of federal trademark registrations during that same period included the University System of Georgia (264), the University of Pennsylvania (145), Harvard University (145), the Indiana University System (140), the Arizona University System (126), and the University of California System (118).

Not all American colleges and universities own trademark registrations, although over 1,000 different American institutions of higher education own one or more trademark registrations at the federal level. Of these, nearly 40 percent owned three to twelve federal trademark registrations through the year 2012, although 25 percent owned only one (figure 3.1). Nonprofit colleges and universities owned

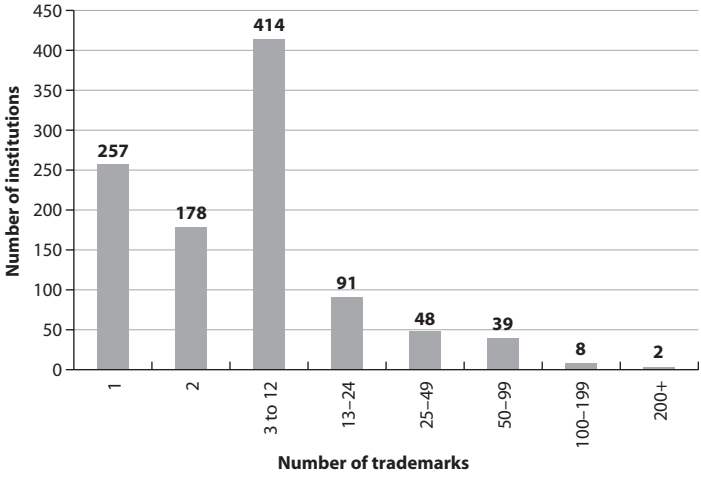

Figure 3.1. Federal trademark registrations owned by American colleges and universities through 2012

nearly 98 percent of higher education's federal trademark registrations. Public institutions held slightly more registrations than private ones: 5,344, compared with 4,711. Religiously affiliated colleges and universities owned approximately 17 percent of all federal registrations, most of which (656 in all) came from Catholic institutions. The next-closest denomination was Methodist institutions, which owned 254.

Ownership of federal trademark registrations by American colleges and universities has increased dramatically in the past decades (figure 3.2).[60] The earliest-issued and still-valid federal trademark registration is one owned by LeTourneau University in Longview, Texas, issued in 1947.[61] Moderate growth occurred from the 1970s through the 1980s, followed by significant growth thereafter. The USPTO has issued over 800 federal trademark registrations to American colleges and universities every year since 2008,[62] and 2010 brought the most awarded to American colleges and universities—roughly 1,000—compared with any other year.

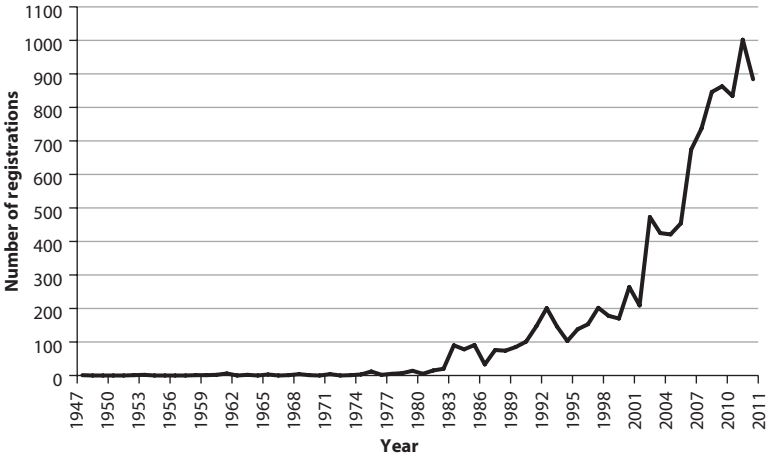

Figure 3.2. Federal trademark registrations issued to American colleges and universities per year

An uninformed view of trademark activity in higher education would suggest that institutions only seek protection of marks with some licensing potential—for example, institutional names and nicknames, athletic logos and insignia, and school seals. In reality, college and university trademark holdings can be labeled in various ways, including the following nonmutually exclusive categories:

- *Name trademarks*: trademarks that consist of a college or a university name, nickname, or abbreviation (for example, UNIVERSITY OF THE VIRGIN ISLANDS for "clothing, namely, sweat shirts, t-shirts, and hats; educational services, namely, university level courses of instruction"[63])
- *Logo trademarks*: trademarks that consist of a graphical depiction of a college or a university seal, emblem, crest, or other insignia or design
- *Product trademarks*: trademarks that may, on their face, bear no connection to a college or a university, but do relate to a product that is somehow tied to a college or a university (for

example, AZULUNA, for "food products, namely, dairy products, namely, European style cow, sheep, and goat cheeses, meat and meat products, namely, beef, pork, chicken and chicken parts, lamb, and goat, and frozen dinners, namely veal and pork entrees,"[64] arising from a Tufts University project to design a system farmers could use to naturally raise their male calves for veal and create a market for the product, or TICK BITE PATCH for "transdermal patches for use in the treatment of humans to evoke: a tick-borne disease immune response, acquired tick-borne disease resistance, and tick-borne disease transmission blocking effects,"[65] the result of a University of Rhode Island project to solve a tick-bite problem)

- *Athletics trademarks*: trademarks that relate in any way to college or university athletics, such as team names, nicknames, mascots, or cheers (for example, REGALS for California Lutheran University "tank-tops; entertainment services, namely, arranging and conducting of competitions for athletic events, tournaments, competitions, and exhibitions,"[66] or NC A&T AGGIES for "metal key rings; license plates made of metal"[67])
- *Program trademarks*: trademarks that consist of the name of a college- or university-sponsored program, school, initiative, conference, or other event or undertaking (for example, HARVARD LIBRARY for "libraries; on-line library services, namely, providing electronic library services which feature books, pamphlets, photographs, diaries, manuscripts, magazines, and catalogs; on-line academic library services; electronic publishing services, namely, publication of text and graphic works of others on-line in a wide range of topics;"[68] or ARIZONA STATE UNIVERSITY—PHOTOVOLTAIC TESTING LABORATORY for "product research and development; laboratory services, namely, testing fuel cells and photovoltaic cells; materials testing and evaluation; product testing; testing, analysis, and evaluation of the goods of others for the purpose of certification"[69])
- *Slogan trademarks*: trademarks that consist of mottoes, sayings, catchphrases, and other refrains used by a college or a university

to market or brand itself or some aspect of its operations (for example, THE FUTURE OF MEDICINE for "educational services, namely, offering workshops, conferences, and seminars on the subjects of patient health care and medical issues related thereto; and providing courses of instruction at the college and graduate levels in the fields of medicine and health,"[70] or GETTING TO OUTCOMES for "educational services, namely, providing presentations, training classes, workshops in the fields of setting and accomplishing goals and problem solving"[71])

- *Domain-name trademarks*: trademarks that consist of a second-level domain name, whether as a word or part of a design mark (for example, GMU.EDU for "providing university level educational courses through distance learning and enabling on-line registration of students via an on-line global computer network,"[72] or BUCKSCORE.COM for "providing information about bucks and deer in the field of buck and deer observations and hunting via a global computer information network"[73])

Table 3.1 depicts the array of higher education trademark registrations across multiple decades. Logos were classified according to whether they mainly consisted of an institution's name or an institutional seal, or whether they primarily pertained to a program, athletics, or a product.[74] Some slogans were also further subdivided into classifications related to a program, athletics, or a product.[75]

Initial trademark activity in the 1970s and 1980s by American colleges and universities predominantly focused on protecting institutional names, seals, and athletic names and logos. While additional registrations in these areas in the 1990s occurred at similar levels, programmatic-related trademarks nearly doubled in percentage terms, from 7.8 percent of all college and university trademarks registered in the 1980s to 12.8 percent of all such trademarks registered in the 1990s. This number jumped to 18.7 percent in the 2000s, and the data for the first years of the 2010s reflects a similar level of activity—18.2 percent through the year 2012.

Table 3.1. American college and university federal trademark registrations across years

	Number of Registrations				
Trademark Type	≤1970s	1980s	1990s	2000s	≥2010
Name	9	168	390	715	296
Program	5	44	197	1,003	496
Athletics	8	68	103	226	93
Product	9	22	125	629	291
Logo = name	7	51	144	488	277
Logo = seal	20	107	242	348	164
Logo = program	0	18	79	592	315
Logo = athletics	5	69	183	543	293
Logo = product	10	3	21	111	69
Slogan	0	6	27	334	181
Slogan = program	0	0	22	255	160
Slogan = athletics	0	10	7	54	42
Slogan = product	0	0	1	45	34
Domain name	0	0	0	23	8
Total	73	566	1,541	5,366	2,719

Also on the rise since the 2000s is the registration of slogans, whether for the institution as a whole, or for some programmatic aspect of it. From the 1990s to the 2000s, registrations of slogans jumped from 1.8 percent to 6.2 percent of all college and university trademarks registered in each respective decade, while registrations of programmatic slogans grew from 1.4 percent to 4.8 percent. Chapter 6 further discusses this activity and its relation to brand.

The registration of institutional names has tapered off from a peak of 29.7 percent during the 1980s. In the 2000s, only 13.3 percent of trademarks registered to colleges and universities constituted institutional names. The registration of logos that predominantly incorporate an institution's name, however, has been steady through the years, at about 9 to 10 percent.

The registration of domain names as trademarks has recently become popular, although this activity is minimal when considered as a percentage of total registrations. A few of the registered domain names consist entirely of an institution's .EDU domain.[76] Others pertain to athletics, products, or programs of the institution.[77]

The Harms That Come from Trademark-Rights Accretion

The chief concern these trends raise pertains to the kinds of trademarks that colleges and universities are amassing. Many of these trademarks hold implications for higher education's position in the public sphere, as a sector largely removed from the activity common in more-commercial markets, where claims for such rights are routinely asserted. No longer satisfied with protecting merely their names and related athletic insignia, colleges and universities are seeking and obtaining trademark protection for a wide variety of marks. Some of these registrations, and the exclusive rights they represent, risk altering the public-serving soul of nonprofit colleges and universities, conferring rights to trademarks that, by virtue of the mark itself and/or the registered goods or services, involve rights intimately connected with a traditional teaching, research, or service function of higher education. Representative examples fitting this description, listed according to the most recent year of their registration, include the following:

- PATSTATS.ORG, registered to the University of Houston, for "providing on-line information in the field of patent law litigation statistics"[78]
- BIOFLEX, registered to Kent State University, for "laboratory research in the field of biological and medical devices and technologies enabled by the use of flexible materials; scientific research; scientific study and research in the fields of biological and medical devices and technologies enabled by the use of flexible materials"[79]
- FOOD, WINE & ALL THAT JAZZ, registered to Grand Valley State University, for "fundraising services, namely, raising funds for providing educational, informative, and entertaining programs for the benefit of non-profit organizations; entertainment services, namely, providing food and wine tasting"[80]
- BE THE DIFFERENCE, registered to Marquette University, for "education services in the nature of courses at the university level"[81]

- THE PREMIER ONLINE HIGH SCHOOL, registered to the University of Miami, for "educational services, namely, providing on-line courses of education at the high-school level"[82]
- RESOLVE, registered to Lehigh University, for "printed periodicals in the field of engineering and applied science"[83]
- STUDENT LIFE, registered to Washington University in St. Louis, for "printed publications, namely, periodicals featuring news and information associated with a university; electronic publishing services, namely, providing online periodicals featuring news and information associated with a university"[84]
- THE FIRST-YEAR EXPERIENCE, registered to the University of South Carolina, for "educational services, namely, conducting conferences, seminars, workshops, and college courses for secondary and postsecondary educators and students addressing transition from high school to the university level"[85]
- FAST-TRACK MBA, registered to Eastern University, for "educational services, namely, providing courses of instruction at the college level and distributing course material in connection therewith"[86]
- COMPLEMENTARY CONCENTRATIONS, registered to St. John's University, for "educational services; namely, providing courses of instruction at the college level"[87]
- ONE-COURSE-AT-A-TIME, registered to Cornell College, for "education services—namely, the conduct of college-level educational courses and/or programs"[88]

These trademarks are inappropriate for institutional ownership, because each confers rights that suggest exclusivity over some traditional aspect of college and university functions. We expect colleges and universities to conduct laboratory research, provide educational services, publish the results of university research, and even entertain us and ask us to donate money. All of these customary higher education activities can be conducted successfully without colleges and universities seeking rights in marks other than ones that identify the institution by name.

So what happens when one institution obtains federal trademark rights that it may use to claim the exclusive ability to market education services, "in the nature of courses at the university level," using the phrase BE THE DIFFERENCE? Should we care that THE FIRST-YEAR EXPERIENCE, used as a mark related to educational services for high school students transitioning to college, belongs to only one institution?

Registrations such as these are problematic, as the rights conferred by them have the capacity to repress the very teaching, research, and services we traditionally have looked to higher education to perform. To be clear, these registrations do not actually prevent uses of BE THE DIFFERENCE or THE FIRST-YEAR EXPERIENCE on college campuses other than by their owners. Nonetheless, misunderstandings and misimpressions over how free-speech rights overlap with trademark rights—and the understandable desire not to want to spend scarce discretionary dollars on legal fees to find out who is right—may lead to constraints on discourse and its related activities on campus. Such an outcome would be unfortunate, as concerns about trademarks do not often make for good pedagogy.

We should question the propriety, as well as the perceived need, for colleges and universities to seek these types of private rights in the first place. Will Marquette University send a cease-and-desist letter to another college or university that uses BE THE DIFFERENCE in relation to its educational services? How much confusion over this phrase will trigger legal action? Will Eastern University demand a royalty from any graduate school of business that offers a fast-track MBA? Is "fast-track" ever descriptive? What kind of use of FAST-TRACK MBA constitutes a mark in commerce? The problem with registrations such as these is that they have the potential to create uncertainty for colleges and universities that seek to go about their traditional functions without provoking a distracting trademark battle.

One reality of obtaining trademark protection is that a federal trademark registration can lead to a feeling of entitlement when enforcement opportunities present themselves. Basic questions are

often forgotten, such as "What is the purpose of our registering and maintaining this mark?" or "Are consumers actually likely to be confused if more than one nonprofit educational institution uses this mark?" Instead, an easier logic slips into place: "We own a federal registration for this trademark and you don't, so stop what you're doing right now."

Even more to the point, many of the common justifications for seeking trademark protection seem suspect when the very words an institution tries to protect deal with aspects of the institution that are unlikely to lead to confusion by the public. People primarily identify institutions by their names, logos, and insignia, not by the names for individual programs, educational features, or curricular initiatives. Therefore, instead of signifying a source, marks such as ONE-COURSE-AT-A-TIME and COMPLEMENTARY CONCENTRATIONS are more likely to be viewed as features of a broader intellectual knowledge commons, owned by no single institution, and presumably free for all within higher education to use without facing enforcement threats.[89] The fact that these phrases are registered, however, means that a legal risk exists in using common or descriptive educational features by name. Do such uses constitute permissible "descriptive fair use"? At what point might employing such phrases constitute use of a trademark that could substantiate an infringement action by the mark holder? The mere recitation of these questions shows the unfortunate consequences these registrations bring to the knowledge commons.

An additional set of problematic registrations that are accumulating in higher education pertains to what could be labeled higher education "products." These types of trademarks relate to a product or service developed at a college or a university, most often with public funds. There is nothing improper about universities benefiting from the fruits of their research, as chapter 4 explains in more detail. The Bayh-Dole Act states that benefits deriving from faculty research sponsored by the federal government will be shared between universities and the faculty whose inventive work leads to commercialization.[90] What should concern all of us about university behavior

regarding trademarks, however, is precisely what should, and does, worry commentators about similar university actions regarding patents: does university ownership of this form of intellectual property frustrate the university's purpose of disseminating research results as widely and usefully as possible?[91]

For example, the University of Florida understandably receives a royalty on PepsiCo's sales of Gatorade, given that the product was invented at the university and was named after its alligator mascot, the Gator.[92] But for a university to seek trademark protection of the name of a product that results from a public-research investment, especially when the product is of fundamental importance to the public's health or safety, calls into question how an institution's assertion of private rights furthers the public good, particularly when nothing about a mark ties it to the university. If products of such historic importance as the polio vaccine—invented by Jonas Salk while he was a faculty member at Pitt—were never subject to a trademark claim, we should question the "necessity" for institutions to seek trademark protection over any given higher education product-of-the-moment.

Representative examples of higher education product trademarks, listed by their most recent year of registration, include the following:

- SWEETANGO, registered to the University of Minnesota, for "fresh apples"[93]
- PORTFOLIO, registered to the University of Maryland Medical System, for "maintaining medical records and information via an electronic interactive system to patients, practitioners, and researchers"[94]
- NEURADIAB, with ownership assigned to Duke University, for "pharmaceutical preparations for the treatment of cancer"[95]
- TICE, registered to the University of Illinois, for "BCG [bacille Calmette-Guérin] vaccine, a nonspecific immunostimulant used in the treatment of cancer in humans"[96]
- HASKIN CROSBREED, registered to Rutgers, the State University of New Jersey, for "live oysters"[97]

- BEEFCON, registered to the University and Community College System of Nevada, for "foodstuffs of animal origin, namely, beef bacon"[98]
- BON, registered to the University of Texas System, for "cancerous cells for use in scientific research, laboratory research, and medical research"[99]
- BREATHALYZER, with ownership assigned to Indiana University, for an "apparatus for measuring the alcohol content of individuals"[100]

The University of Minnesota's registration of SWEETANGO serves as a good example of the issues these types of trademarks present. Using public funds, researchers at Minnesota's College of Food, Agricultural, and Natural Resources developed a new variety of apple, which they named SweeTango.[101] Instead of releasing the apple to growers without charge, as an "open release"—as the university had done with its previous blockbuster apples, such as the Honeycrisp—the University of Minnesota decided to tightly manage who would be allowed to produce and sell the apple.[102] Obtaining federal trademark registration over the apple's name—which the university failed to do with Honeycrisp—facilitated its management strategy.[103] Without a trademark registration, the university would have faced enforcement challenges if licensed growers complained that unlicensed producers were selling the same apple under the same name. Therefore, having a trademark registration for the apple's name furthered the university's goals of identifying and protecting legitimate producers from unlicensed copycats.

Trademark law can be used appropriately to achieve this purpose, but we should be concerned about colleges and universities turning to trademarks as a vehicle for denying the public the full and unfettered benefits of higher education products. More broadly, the rising number of trademarks for such products serves as some indication of what the public is losing in exchange for the rights granted in situations like this one. The loss is not necessarily that exclusive ownership rights should lie with a company, instead of with a univer-

sity. Rather, this loss is that colleges and universities are seeking to control things they never used to control. What we, as the public, once received with no restraints, in exchange for granting considerable state and federal research dollars to institutions of higher education, we now may receive only with strings attached. Previously, new breeds of apples developed at universities using public funds were simply called "apples." They were cheaper for all of us to buy, because they were not proprietary. Now, as universities look to protect their innovations using trademarks, consumers pay twice: once to support the research that led to the product, and again in the form of inflated prices, caused by intellectual-property protection. Fewer people have access to these innovations, because of universities' decisions to assert ownership rights where they previously did not.

Some other trademark registrations rapidly accumulating in higher education cover activities or invoke concepts that go to the heart of what it means to work in the public's interest. If we believe that higher education exists to serve the public good over private interests, and that society's most pervasive problems require public attention and collective action, then registrations of this sort are the most troubling. Representative examples of trademarks in this category, listed by their most recent year of registration, include the following:

- STUDENTS WITH DIABETES, registered to the University of South Florida, for "providing information in the field of diabetes"[104]
- WORKING TOWARD A WORLD WITHOUT CANCER, registered to the University of Kansas, for "promoting the public interest and awareness in cancer research, treatment, and education"[105]
- READY TO BE HEARD, registered to Chatham University, for "educational services, namely, training and seminars for women in the fields of advocacy, politics, and public policy"[106]
- CURE VIOLENCE, with ownership assigned to the University of Illinois, for "promoting public awareness of violence as a public

health epidemic; providing an interactive and motivational website the primary mission of which is to stop the spread of violence, and to raise awareness of the issue of violence as a public health epidemic"[107]

- TOUCHED BY A NURSE, registered to the University of Colorado, for "charitable fundraising services by means of organizing, managing, and supervising fundraising events, namely, entertainment in the nature of charity balls and dinners; charitable fundraising services for the purpose of funding educational scholarships"[108]
- WE'RE CONQUERING CANCER, with ownership assigned to the University of Texas System, for "promoting public awareness of the need for cancer education and prevention practices; medical and scientific research to facilitate the discovery of the causes, prevention, treatment, and cure of cancer; medical services, namely, multi-disciplinary treatment of patients"[109]
- POWER, registered to the University of North Dakota, for "providing information relating to the generation of energy from wind; scientific research for wind energy development"[110]
- LITERACY COLLABORATIVE, registered to the Ohio State University, for "educational services for primary grade teachers, namely, conducting workshops, conferences, seminars, and leadership training programs relating to literacy and the design of literacy related curriculum"[111]
- CRUCIAL EARLY YEARS, registered to the University of Missouri, for "conducting conferences, continuing education seminars, and workshops relating to various aspects of education of young children; development and dissemination of educational materials for others relating to literacy and the design of literacy related curriculum; development of literacy assessment and testing systems"[112]
- PROJECT SAFETY, registered to the University of Texas System, for "printed educational materials, namely teacher's workbook, poster, handouts, and achievement test sold as part of a kit related to sun awareness and the prevention of skin cancer"[113]

- BREAK CLEAR, registered to the University of Texas System, for "educational services; namely, conducting seminars and classes in the field of smoking cessation"[114]
- TIMBER WOLF ALLIANCE, registered to Northland College, for "promoting the public awareness with regard to timber wolves"[115]
- WORKSAFE IOWA, registered to the University of Iowa for "consulting and providing information in the field of occupational health and safety"[116]

Each of these examples should pose critical questions for the institutions that own these trademark registrations. For instance, what educational or societal purpose is served when one university-affiliated hospital has the primary right to use WORKING TOWARD A WORLD WITHOUT CANCER as a promotional slogan? Why should but one higher education institution have a lock on CURE VIOLENCE as a public-awareness slogan?

Trademark registrations like these run counter to higher education's public-serving mission. When research and calls for concerted action by higher education involve activities for the public good—such as curing cancer or promoting an awareness of violence, diabetes, women's advocacy, literacy problems, skin cancer, and yes, even timber wolves—no college or university should look to trademark law to provide an avenue of exclusivity. We, as a public, are harmed when they do so, as asserting trademark rights over language hardly plays a beneficial role in undertakings designed for the public good. Any registration that covers such activities is only likely to stifle legitimate third-party activity in the public interest, by for-profit and nonprofit actors alike. Such trademark registrations may also lead to an inappropriate hankering to enforce them, with flimsy allegations of "confusion" bandied about whenever a similar use is identified.

The USPTO did not violate the law in granting these registrations, nor am I arguing that legislation should be enacted to prevent these types of marks from being registered. For-profit entities, as well as nonprofit entities outside of higher education, may find that seeking

registrations of this sort is critical to maintaining the integrity of their missions and the philanthropic support of their constituents. For example, consider an organization like the Livestrong Foundation. Anyone wanting to make some money selling small, yellow, rubber wristbands with "Livestrong" imprinted on them would be very successful, if not for this philanthropic organization's federal trademark registration for LIVESTRONG, used in relation to "jewelry."[117] Without that trademark registration, the foundation would be without a powerful recourse when donors mistakenly gave their money to a different entity selling yellow wristbands with LIVESTRONG printed on them. Registration of the trademark helps the foundation maintain the confidence of its donors, so contributors know that the entity providing yellow wristbands in exchange for donations is, in fact, the one dedicated to supporting people affected by cancer.[118]

But the mission of and constituency for higher education, particularly public higher education, are quite different from what exists in other nonprofits. Neither higher education's mission nor its constituency is served by parceling out intangible rights that clutter the public sphere and potentially frustrate the public's ability to benefit from the research and investment for which society has already paid.

At first glance, all of this accumulative trademark activity in higher education has a simple financial explanation, one that its defenders may be quick to proffer: the marginal cost of seeking and obtaining one federal trademark registration—a few thousand dollars, on average—is minimal, in light of one college's or university's total legal or administrative budget. Yet however rational a financial decision to seek federal registration of a trademark may be in any given instance, the cost of these decisions adds up once institutions start acquiring portfolios that need frequent tending. As trademark registrations mount up across departments and schools within an institution, additional human resources are needed to track, coordinate, monitor, and correspond with others concerning the institution's trademark activity.

The sheer volume of federal trademark registrations owned by American colleges and universities indicates that many institutions

are spending considerable sums on these undertakings. Of course, the richest of institutions probably will recoup these expenditures by licensing some of their registrations. Not all institutions are equally well suited to break even, however, let alone prosper from amassing trademarks. Particularly as institutions register more trademarks that are less amenable to licensing (for example, institutional slogans and program names) or seek duplicative or overlapping registrations, there is no guarantee that maintaining a registration on the shelf will lead to money on the books.

For example, consider the following federal trademark registrations owned by the University of Virginia, each registered in relation to "health care services":

- IMAGINATION BEYOND MEASURE
- INNOVATION BEYOND MEASURE
- PERCEPTION BEYOND MEASURE
- INGENUITY BEYOND MEASURE
- INQUISITIVENESS BEYOND MEASURE
- DEDICATION BEYOND MEASURE
- EMPATHY BEYOND MEASURE
- INTELLIGENCE BEYOND MEASURE
- SKILL BEYOND MEASURE
- INVENTIVENESS BEYOND MEASURE
- ORIGINALITY BEYOND MEASURE
- CLEVERNESS BEYOND MEASURE
- CURIOSITY BEYOND MEASURE
- EXPERIENCE BEYOND MEASURE
- FULFILLMENT BEYOND MEASURE
- PERSISTENCE BEYOND MEASURE
- DRIVE BEYOND MEASURE
- INITIATIVE BEYOND MEASURE
- ENTHUSIASM BEYOND MEASURE
- COLLABORATION BEYOND MEASURE[119]

A reasonable estimate would be that the University of Virginia spent over $50,000 to register this family of twenty BEYOND MEASURE

trademarks with the USPTO. This dollar amount assumes a total of $2,500 per mark for legal fees and other costs, which is a conservative estimate. According to a nationwide survey of intellectual-property lawyers conducted in 2012 by the American Intellectual Property Law Association, the average in total fees (excluding USPTO filing costs) to conduct a search for prior use of the desired trademark, file a federal application, and perform the legal work necessary to shepherd the application through to formal registration of the trademark were $3,644.[120] To maintain these registrations, once they are granted by the USPTO, will cost the university additional thousands of dollars over the years.[121] To what end? If an accepted precept of branding is to never confuse the consumer, registering twenty variations on the same theme would seem to create more headaches than those registrations would solve. Regardless, the haphazard accretion and registration of an inordinate number of trademarks—particularly ones unlikely to present licensing opportunities—unquestionably raises legal costs and affects the bottom lines of those programs and departments within colleges and universities that seek them.

Although the University of Virginia's trademark activity is extreme, the same behavior is occurring elsewhere. Another example is the accumulative activity Syracuse University has engaged in with respect to its WEAR ORANGE family of marks:

- REAL WOMEN WEAR ORANGE
- REAL KIDS WEAR ORANGE
- REAL MEN WEAR ORANGE
- REAL FANS WEAR ORANGE
- REAL CHAMPIONS WEAR ORANGE
- REAL DADS WEAR ORANGE
- REAL MOMS WEAR ORANGE
- REAL GRANDPARENTS WEAR ORANGE
- REAL ALUMNI WEAR ORANGE
- REAL GIRLS WEAR ORANGE
- REAL BOYS WEAR ORANGE[122]

Apparently, real Syracuse University fans like federally registered trademarks.

Finally, although reports by institutions of higher education on how much licensing revenue they have received are not commonly publicized, we must wonder at what point renewed IRS consideration will or should be given to taxing trademark-licensing monies as unrelated business income. A new focus is already being placed on patent royalties paid to institutions of higher education, with Princeton University facing a challenge based on how it distributes those royalties to its faculty.[123] Conferring tax benefits to colleges and universities that successfully license a handful of trademarks—consisting solely of institutional names, logos, and insignia—arguably furthers advantageous IRS policies toward nonprofits. In contrast, permitting colleges and universities to obtain trademark protection over every conceivable association with some aspect of their identity, without any tax consequences, seems like an abuse of the system. In short, seeking trademark upon trademark may change the character of nonprofit higher education in ways that those responsible for tax policy should care about.

Trademark-Rights Accretion and the Public Good

Some may be inclined to view higher education's piling up of trademark rights as inevitable, in light of parallel practices in industry. This argument suggests that the possibility of being sued by a third party for trademark infringement may cause a college or a university to seek federal registration in the first place, in order to obtain first-use, or superior, rights. Although untested, this argument seems inadequate to describe the full array of registration activity occurring in higher education. For example, are we to believe that the University of South Florida's attorneys thought it imperative to seek registration for STUDENTS WITH DIABETES, lest the university face a potential liability suit for "providing information in the field of diabetes," because another entity is already using the same phrase? The university could probably rest easy, knowing that no company would

risk a headline such as "Diabetes-Prevention Start-Up Sues University for Educating Students about Diabetes." But every trademark is different, and some are of more interest to industry than others.

More to the point, public institutions are unlikely to be motivated to seek federal trademark protection because an infringement lawsuit might be brought against them, as they already are immune from having to pay monetary damages if a court holds them liable for trademark infringement.[124] Although a court could order a college or a university to stop infringing on a trademark, few are likely to be scared enough of this possibility to preemptively seek trademark registration from the USPTO. Simply put, because the odds are low for public institutions to be accused of trademark infringement, there is no need to race to the USPTO to obtain a protective shield in the form of a trademark-registration certificate.[125]

No matter what the causes of trademark-rights accretion in higher education are, there is no question about the harmful effects of this activity. In trademark law, perception has a tendency to be self-fulfilling—and self-defeating. As consumers encounter more licensed uses of trademarks and fewer unlicensed uses, they become accustomed to thinking of licensing as the norm.[126] This awareness, in turn, shades how consumers view unlicensed uses of trademarks: confusing at best, and illegal at worst.[127] Either impression benefits those who wish to obtain, license, and enforce trademarks.

What is of concern for higher education is that institutions are internalizing a message that every conceivable piece of intellectual property that is trademark eligible must be claimed and registered, so an institution potentially would not lose something that is rightfully theirs. This belief results in conduct that may help an institution protect its identity in some legitimate instances, but in many other circumstances, colleges and universities are doing much more than taking appropriate action to protect their identities. Instead of standing to lose from trademark *inactivity*, the greater harm, to institutions and to the public, is likely to come from trademark *over-activity*. Hyperbranding every aspect of modern higher education leads to the unfortunate impression that such activity is necessary to protect

something, even if what is being shielded is the normal functioning of traditional scholarly and teaching activities at colleges and universities. Unfortunately, if colleges and universities already following this practice continue accumulating and asserting their rights over more and more trademarks, other institutions that are latecomers to this activity may face practical pressures to embrace it, too. The public loses when "if you can't beat 'em, join 'em" becomes the motivation for college and university trademark activity. A wholesale adoption of the trademark trappings and norms of the commercial marketplace only serves to weaken higher education's claim to serving a greater public good. No institution ever closed its doors, or experienced diminishing quality in its teaching or research, for failing to claim additional trademark protections.

There may be some room to ask who or what influences a college or a university to stockpile federal trademark registrations. Outside lawyers typically receive instructions from in-house attorneys, who, in turn, look on deans and other leaders of academic units as their clients. What the client wants, the client often gets. The same is true with donors. Private giving occasionally may hinge on what Christopher Newfield calls "trademark-building projects . . . and the other special interests of donors."[128] Nevertheless, just as institutions of higher education do not acquire physical property without inviting scrutiny, their forays into intellectual-property ownership should not be overlooked or dismissed, regardless of whose interests actually drive decisions to seek federal trademark protection.

As trademark activities increase, colleges and universities become more deeply entwined with the marketplace and market concerns. Different historical contexts help illustrate how these commercial values invariably present tensions and eventually conflict with academic values and norms. Should a university send a cease-and-desist letter to another educational institution believed to be infringing on its mark, even though that mark calls to mind a public problem or a research undertaking, not the identity of the university itself? What about sending such a letter to a private company that may employ that university's graduates, or contribute financially to the institution

in the form of sponsored research? As questions like these arise, colleges and universities expend untold financial and political capital in policing what are often questionable investments, in the hope of receiving some return.

Even if a federal trademark registration does not lead to what I call an "enforcement itch," its very existence serves to clutter the commercial market, dampen down competition, and cause well-intentioned individuals and companies to attempt to avoid any potential risk. Savvy businesses and nonprofits commonly conduct trademark-clearance searches, making sure a particular trademark is not already in use, before unveiling a new brand. Registrations owned by colleges and universities appear in these searches, casting a deterring shadow on contemplated activities and the adoption or use of trademarks that may come too close to a given college's or university's trademark registration and its claimed rights. This effect is desirable and proper when the mark in question is the name of a college or university and the searcher is a would-be competitor—society benefits when copycats cannot trade on the reputation of other higher education institutions. But it hurts the public when businesses are deterred from pursuing legitimate activities because of a college- or university-owned trademark.

One problem for higher education is that the definition of a competitor has come to include an untold number of actors. As colleges and universities seek and obtain trademark registrations in classes of goods and services other than educational services, they have identified themselves as active in many pursuits that are ancillary to their historic raison d'être. Although the institutions themselves are not entirely to blame for this behavior—after all, policy makers have been encouraging them for years to become more entrepreneurial, in part by entering different markets—we must ask just how adept colleges and universities can be at establishing and managing wide-ranging trademark portfolios with ties to nearly every aspect of the higher education enterprise, not just athletics.

At a more fundamental level, as zones of previously unregulated speech become areas of regulated, rights-laden speech, college and

university protections for their brands threaten to compete with the defense of their mission and the traditional academic values of higher education. The pursuit of truth and scientific standards risk playing a secondary role to institutional image-consciousness and the dictates of the marketplace. As Samantha King and Sheila Slaughter presciently warned in 2004, "signs and symbols, integral to the work performed by members of colleges and universities, are no longer valued only for their meanings but for their commercial potential."[129] Deven Desai has argued that brand—a community-situated, multi-stakeholder, market-responsive information device—has begun to subordinate the historical precepts of trademark law, regardless of the industry in which brands emerge.[130] The trademarks being snatched up in higher education, a growing number of which pertain to slogans and programs, stand as proof of the shifting focus of trademark activity: image is everything, and concern for any likelihood of confusion is beside the point.

The effects of this commodification of language and the very building blocks of how knowledge is produced and disseminated are incalculable—and significant. Unfortunately, as Derek Bok, the former president of Harvard University, has recognized regarding the effects of commercialization in higher education more generally: "The principal advantage to the institution—money—will usually seem immediate, tangible, and extremely useful to help meet pressing needs. In contrast, the dangers—to the conscientiousness of faculty, or to the moral education of students, or to the trust of the public—are all intangible and remote. They may never materialize, at least not for a long time, so that it is all too easy to overlook them."[131]

In short, responsibility for the public's trust in the language and behavior of higher education as an ethics-driven, public-oriented, public-serving institution too often buckles when money is on the line. Although champions or defenders of this amassing of trademark rights will insist that the activity poses no risks to higher education's essence or mission, that song has been sung for different audiences before. Many of this sector's historic forays into technology transfer,

online education, and quasi-professional athletics suggest that incongruences and tensions are inevitable and, at times, irreconcilable.[132] As institutions needlessly accumulate private rights in the form of trademark registrations, the existence of those registrations, and how institutions choose to wield them, are an affront to the public's interest in higher education.

Higher Education's Trademark-Enforcement Itch

Trademark-rights accretion is problematic, in large measure because the accumulation of rights leads to a belief by their owners that these rights must be exercised in order to realize their highest and best value. Trademark rights make their holders itch to enforce them by issuing cease-and-desist letters, demanding licensing fees, and engaging in infringement litigation.

It makes sense for institutions of higher education to pursue some of these actions if they spring from a legitimate desire to eliminate harmful confusion by the public and protect the university's engagement in established licensing markets. One example is the trademark-infringement lawsuit filed in 2012 by Regent University, a religiously affiliated institution in Virginia, against the University System of Georgia.[133] Regent University—which has used that name since 1990, when it changed its name from Christian Broadcasting Network University—was concerned that the proposed name for a new university, "Georgia Regents University," would cause confusion. The parties entered into a confidential settlement in June 2013 that led to dismissal of the case, less than a year after Regent University filed its complaint, so we will never know whether a likelihood of confusion existed between the two marks, or which institution would have prevailed in the infringement case.[134]

The propriety of using trademark law to allow universities to resolve such disputes is apparent, and it is also not without precedent. From time to time throughout history, established colleges and universities have successfully challenged new entrants to the sphere of higher education that adopt a name hewing too closely to their predecessor's. For example, in 1930, Columbia University went to court

to prevent a start-up institution, billing itself as Columbia Educational Institute, from using the word "Columbia" in its title. The university prevailed.[135] So did Washington University in St. Louis in 1998, when it sought to stop a for-profit, distance-learning institution based in Pennsylvania from using the name Washington University.[136] Similarly, an educational entity in Louisiana calling itself Colgate University quickly heard objections from representatives of the venerable, same-named institution in Hamilton, New York.[137] Even such a seemingly small matter as which institution in Ohio can call itself "Ohio" in sports contests led to an earnest, but explicable, trademark tussle.[138]

Decisions by colleges and universities to garner income from and enforce the use of their names, logos, and insignia through licensing programs, including athletic licensing, are also understandable. Athletics enjoy a unique role in American higher education. Most sports generate zero revenue for institutions and produce a net loss in operating budgets, yet their value for students—including what students who play them receive in terms of education—is significant. Without the potential of funds coming in from the so-called money sports of football and basketball, the long-term viability of smaller sports programs within a college or a university would be in jeopardy.

This is not to suggest that all is well with collegiate athletics—far from it. The ills are many and have been well documented. The exorbitant salaries paid to basketball and football coaches; the unworkable and unfair regulations by the NCAA which serve to hurt, not promote, its concept of the "student-athlete"; and coaches' contracts with athletic-equipment manufacturers that compromise the freedom and interests of student-athletes are just a few prime examples. But collegiate licensing is not among the leading problems in higher education.[139] To imagine re-creating a world where athletics play a secondary role to academics at Division I institutions certainly is a healthy exercise, but ending collegiate trademark licensing in the furtherance of that goal would be to throw the baby out with the bathwater.

For athletic licensing in higher education—and even licensing outside of athletics—perhaps the most salient point is that if colleges

and universities did not enjoy exclusive rights to their names, logos, and insignia, someone else would be making money from those valuable intangibles and not sharing the profits with institutions of higher education. Such was the norm before these institutions reclaimed their names. If anyone is to benefit, the institutions that have invested so much in burnishing their brand in the consciousness of consumers deserve to lay claim to this income source.

The story would end here if colleges and universities were only using their trademarks to protect their names and engage in licensing markets. But the evidence shows that they are moving beyond seeking trademarks to protect their institutional identity and generate revenue by licensing their names, logos, and insignia. Some use trademarks as a means of suppressing innocuous and unrelated speech that has virtually no potential to confuse anyone. Higher education's questionable pursuits in obtaining and enforcing a variety of trademark rights can harm the public good by diminishing zones of free speech and locking up elements of the linguistic market that should be left unclaimed by higher education and available for others to use.

A prime example concerning this enforcement behavior was the decision by the CLC and several universities to sue Smack Apparel in 2005.[140] Smack sold t-shirts featuring the two-tone color schemes of various collegiate football powerhouses, but it was careful not to use any registered marks of the institutions the shirts called to mind. One shirt was intended for University of Southern California fans. It read "Got eight?" on the front and "We Do! Home of the 8 Time National Champions!" on the back. The back of the shirt also included a drawing of the state of California with a star marked "SoCal" in the university's colors of cardinal and gold. Smack had no licenses from the CLC or any of the university plaintiffs, but the firm boasted that it was licensed by the First Amendment.

If only. Even though no t-shirt incorporated any registered mark belonging to the university plaintiffs, the district court ruled in favor of the plaintiffs on their Lanham Act claims, holding that an individual institution's colors, when used on merchandise that combines other identifying "indicia" referring to the university, can serve to

identify a source.[141] The court awarded the plaintiffs $10,506 in actual damages and $35,686 in lost profits. A federal appellate court upheld these rulings, in a decision that the CLC's general counsel called a "powerful precedent for collegiate institutions . . . particularly since few courts across the country have directly addressed the issue of protecting color schemes as marks."[142] Powerful indeed, as it essentially gave colleges and universities—which do not actually make t-shirts—a broadly based right they can use to control depictions and verbal references that call to mind their particular institution. Mere mental association can now imply identification of a source or an endorsement by it, and colleges and universities are using this decision to silence expressions they find offensive.

Another example is a colorful situation involving Florida A&M University (FAMU). In 2010, the university extracted an apology and hefty financial settlement from a company that produced and distributed a pornographic video that included orange and green props (orange and green are FAMU's colors), a wall clock displaying FAMU's mascot, and several "verbal allusions" to FAMU.[143] Having relied on the ruling in the *Smack* case to support FAMU's claim, the university's attorney called the settlement "a home run," because the defendant "acknowledged that the university and all other universities have a protectable interest in their university color schemes especially when combined with insignia identifying the university."[144]

Despite the unsavoriness of the scene in which FAMU's colors and mascot were depicted, combined with the video's "verbal allusions," the First Amendment unquestionably permits speakers to make degrading and even offensive allusions to specific colleges and universities without being held liable for infringing on a trademark. More troubling, from a policy perspective, is considering which types of institutions will expose our nation's youth to controversial ideas and invite considered thought—both pro and con—about them, if not our colleges and universities. Unfortunately, legal administrators at many institutions of higher education seem to view trademark registrations as vehicles for controlling marketplace references, thus

trampling any speech that might happen to be critical of their institution.[145]

Disputes such as these suggest that administrators at some colleges and universities have little understanding of or appreciation for the trademark doctrine of "nominative fair use," which permits both commercial and noncommercial actors to identify and even critique the owner of a mark, provided that the critic does not suggest any sponsorship by or endorsement of that speech by the mark's owner.[146] While many for-profit companies have touchy egos when it comes to negative references to them by competitors, colleges and universities should not be so sensitive as to react in similar fashion.

Additional examples abound of institutions of higher education asserting trademark claims in questionable circumstances. For example, Texas A&M University owns two federal trademark registrations for the phrase 12TH MAN.[147] Although "twelfth man" is a common term in football, used to refer to a given team's fans (who support their team's eleven players on the field), Texas A&M has owned the federal registration for the term since 1990. When the Seattle Seahawks used 12TH MAN in a marketing campaign before the 2006 Super Bowl, Texas A&M sued them in federal court for trademark infringement, probably emboldened by its previously successful enforcement efforts against the Buffalo Bills and the Chicago Bears.[148] The university continues to believe it has exclusive rights to the phrase and looks for opportunities to inform others of its trademark registrations. It provoked a squabble on Twitter over Florida State University's use of 12TH MAN as recently as 2014 and sued the Indianapolis Colts in 2015, contending that the team was infringing on this mark.[149]

Texas A&M is not the only university to take its football trademarks seriously. In 2010, the University of Florida sent a cease-and-desist letter to Glades Day School—a private, K–12 academy just south of Lake Okeechobee, Florida—demanding that the school stop using a particular alligator logo in connection with its athletic teams. The university felt that the day school's logo too closely resembled the university's Gator logo, even though Glades does not

compete with the University of Florida in athletics (or anything else) and had been using its alligator logo—without objection from the university—since the school's founding in 1965. In the face of the university's demand, Glades decided to change its logo, at a cost of $60,000, rather than defend a pricier lawsuit. The school's principal noted: "It just hurts; it has a sting to it. We send them our students, we send them our money, and we support them. It just flies in the face of common sense that they would come after us."[150]

In 2008, Auburn University sued an individual who was selling six-fingered, foam-hand novelty souvenirs through the Internet. Each digit bore the year and score of Auburn's six successive victories over the University of Alabama in the rivals' annual Iron Bowl. Emblazoned across the palm of each foam hand were two of Auburn's registered trademarks: AUBURN and WAR EAGLE. The defendant behind this tiny operation sold a grand total of fourteen foam hands. He also admitted under oath that his commercial ambition consisted of making "enough money to pay the cost and buy some beer."[151] You might think that with such low stakes, Auburn would have preferred to resolve this dispute out of court. Instead, the university contended that it suffered irreparable harm and successfully obtained a court order for the defendant to cease manufacturing the foam hands.

In a trend that no doubt reflects higher education's growing focus on innovation and entrepreneurialism, students themselves have emerged as potential targets of trademark enforcements by educational institutions, as well as allies in such efforts, for colleges and universities looking to create or assert intellectual-property rights.[152] For example, while still a student-athlete, former Texas A&M football player and Heisman Trophy winner Johnny Manziel decided to seek federal trademark registration for his nickname, JOHNNY FOOTBALL, in relation to various kinds of athletic apparel and entertainment services, after it was discovered that a company—believed to be affiliated with an Aggie booster—already had filed a trademark application.[153] Unable to capitalize on Manziel's name itself, due to NCAA regulations, Texas A&M indicated its support for Manziel's efforts, which soon resulted in a lawsuit by Manziel against an alleged

infringer.[154] Even though NCAA regulations prohibited Manziel from receiving one cent of any sale of Aggie football merchandise emblazoned with his team number (No. 2) on it, the NCAA said he could keep whatever damages he received through such enforcement efforts without violating its stringent policies concerning amateurism. It refined this position, however, by further stating that any effort by a Texas A&M booster to filter money to Manziel by paying him damages for infringing on his trademark would be an NCAA violation.[155]

Manziel's trademark-action success may not have come at the university's expense, but such was not the case for Robert Morris University in 2010, when news circulated about its failed efforts to acquire rights to the mark BOBBY MO from a company run by a former student.[156] For years, students, and the institution itself, used "Bobby Mo" informally as a nickname for the university and its namesake, who was a signer of the Declaration of Independence. As part of a business course taken in 2005, Nathaniel Benz came up with and promoted the notion to create an athletic apparel company called Uwear. The university liked his idea and ultimately gave Benz and other students involved with his fledgling enterprise $3,000 in seed money to help launch the business. At their professor's suggestion, they used part of the money to seek registration of BOBBY MO, which was unregistered at the time. As Benz explained, "[the university] really goofed up [in not registering it], and we picked it up under their noses."[157] Unable to successfully purchase the trademark from Uwear, Robert Morris University was forced to coin a new nickname—RoMo—for its mascot, which the university then registered as a trademark.[158] What did Benz learn from this experience? Perhaps one of the very lessons that colleges and universities nationwide have learned from their own forays into trademarks: "If you have a good idea and all your ducks are in a row, just do it. Deal with the consequences and with what everyone else thinks later."[159]

As the discussion of the *Smack* and *Moore / New Life Art* cases suggests, some colleges and universities think of their trademark portfolios in broader terms than simply institutional names, logos, and insignia, and they instead seek to control entire marketplace

references to their institution. For example, in 2012, West Virginia University—home of the Mountaineers—sued a company that was selling blue and gold shirts with the phrase "Let's Go! Drink Some Beers!" emblazoned across the front of them. WVU claimed these shirts infringed on its common-law rights in the phrase "Let's Go Mountaineers" and, in part because of the shirts' blue and gold colors, were likely to cause confusion about the university's affiliation with or approval of the products. Never mind that blue and gold are the official colors of the state of West Virginia, or that the words "Mountaineers," "WVU," or "West Virginia University" did not appear on the shirts themselves.[160] And who, exactly, would be confused into thinking that a university would condone the sale of shirts that encourage drinking?

A similar situation of negligible, if not improbable, confusion pertains to cheeky activity by a pair of undergraduates at the University of Delaware, who, in 2012, received a cease-and-desist letter from their university when the duo announced their plans to sell t-shirts at homecoming bearing the slogan "U can suck our D." Some fans at University of Delaware football games apparently use the refrain to heckle opponents and their supporters. Administrators at the University of Delaware threatened the students with "severe" disciplinary sanctions if they moved forward with their plans to merchandise the apparel, which they had sold at the university's 2011 homecoming game without incident. Notably, the capital letters *U* and *D* on the shirts—which the students already had printed, at a cost of nearly $10,000—were in a different font than the interlocking UD logo used by the university. According to the university, confusion was not the issue. They argued instead that the shirts "disparage . . . the goodwill and positive image that members of the community have regarding our trademark and the university more generally, whether or not they believe that the university produced the shirts."[161]

The students decided to beat the university to court, filing a federal lawsuit alleging infringement of their free-speech rights. Predictably, the university responded that the case had everything to do with trademark infringement and nothing to do with censorship. In a statement, University of Delaware officials noted that the university

has been aggressively protecting its logos and trademarks "as other universities do," with the assistance of the CLC.[162] Apparently this university believes that prompting someone to think bad thoughts about it or its trademarks should result in civil liability and disciplinary action by the university. No doubt somewhere George Orwell is smiling.

Thought policing, masquerading as trademark protection, is also evident in a recent action by Duke University. On February 9, 2015, Duke opposed an application filed by Benson Williams to register the mark DRANK UNIVERSITY, used in relation to athletic apparel.[163] The university claimed that registration of DRANK UNIVERSITY would be likely to create confusion with and dilute the distinctive and famous nature of the DUKE trademarks owned by Duke University. Here is the parade of horrible possibilities that Duke envisioned, should a trademark registration be granted for DRANK UNIVERSITY: "Applicant's proposed mark could presumptively be depicted on and in connection with jerseys in [Duke's] school colors, in medieval or gothic font (both of which are strongly associated with Duke), in connection with collegiate teams and athletes, and with a devil visually similar to or parts thereof reminiscent of [Duke's] mascot, and such goods could presumptively further be marketed in associated with images depicting, and themes associated with, colleges, collegiate programs, and, more specifically, [Duke] and [Duke's] athletic team along with other indicia evocative of [Duke]."[164]

Legal language aside, the real harm Duke most likely was concerned with was a third party calling to mind the university in a manner the university finds objectionable, since "drank" could be related to drinking, and any thoughts connecting drinking with Duke are impermissible. It is important here to note that although the owner of DRANK UNIVERSITY might seek to use collegiate "indicia"—for example, gothic buildings and carefully manicured lawns—merely to evoke a thought in a consumer's mind about Duke University, this does not equate to consumer confusion. Consumers are capable of seeing a mark, being reminded of a particular university because of

the mark, and yet not being confused into thinking that university sponsors, condones, approves, licenses, or is otherwise affiliated with the mark.

In its opposition to the registration of this trademark, Duke went on to describe in additional detail the harm it foresaw should the DRANK UNIVERSITY mark be registered and come into contact with Blue Devil fans everywhere:

> The application contains no distinguishing field of use or market limitations, or restrictions on channels of trade. The mark thus presumptively could be used to market sports jerseys, athletic wear, or bags designed to facilitate tailgating to the hundreds of thousands of Duke fans around the country who support [Duke] and its athletic teams. The mark sought to be registered, used in connection with goods closely related to those sold under [Duke's] DUKE Marks, presumptively would be marketed with images thematically evocative of [Duke] and would presumptively be targeted at, and marketed through channels of commerce directed to, [Duke's] athletes and fans as well as [Duke's] alumni, employees, students, potential students, and parents of students past, present, or future. The goods further could be sold on or adjacent to Duke University's campuses and at or adjacent to Duke-branded facilities in North Carolina and in other states. In short, it must be presumed that the market and the channels of trade through which Applicant's applied for goods will travel are identical to those that are currently used by [Duke] and that have been used by [Duke] since long prior to any priority date to which Applicant might be entitled.[165]

This opposition stands as yet another example of higher education's troubling turn to thought policing in the name of trademark protection.[166] The thematic evocation of Duke University—if that is what the DRANK UNIVERSITY mark does, which I doubt—is not, in itself, a reason for legal action, despite college and university efforts to claim an exclusive right to make judgments about any marketplace references to them. On this point, Drake University, in Iowa, shares more letters in common with "drank" than does Duke, yet Drake sensibly saw no reason to cry foul.

A quick visit to the websites for DRANK UNIVERSITY at the time Duke filed its opposition to trademark registration for this phrase revealed how silly any allegation of confusion between it and Duke University actually was.[167] Nothing whatsoever on the sites called to mind Duke University. Duke's attorneys would be quick to point out that, should the mark be registered, hypothetically the mark's owner could change course and decide to restyle all of its products so they "thematically evoke" a connection with Duke University in a way that confuses consumers. This essentially argues that action now prevents potential legal damage later. But the key response is that even if such a circumstance occurred, Duke University could sue for trademark infringement. When an owner of a federal trademark registration seeks to enforce its rights through litigation, the fact that it did not exercise its right to oppose the defendant's efforts to register the mark at the USPTO does not defeat the claim.

Like Duke, the Pennsylvania State University (Penn State) is another institution famous for its athletic programs that has attempted to use trademark law as a means of interfering with what should be viewed as innocuous marketplace behavior. The university owns a federal trademark registration for the mark PENN STATE WHITE OUT, used in relation to "promoting public awareness of the need for fan participation and involvement in collegiate athletic competitions, excluding hockey competitions, conducted within the Commonwealth of Pennsylvania."[168] Penn State claims to have used the mark since 2004 and has owned a federal registration for the mark since 2014. Penn State had to fend off a challenge brought by the Phoenix Coyotes hockey team, which uses WHITE OUT with respect to hockey, in order to enable the university to register this mark (hence the limitations concerning collegiate athletic competitions, *excluding* hockey, and only those contests conducted within Pennsylvania).

Recently, Penn State used its federal trademark registration to pick its own fight. On February 9, 2015, Penn State petitioned the TTAB, seeking cancellation of a trademark registration owned by a Norwegian company, Norrøna Sport AS, for the mark WHITEOUT, used in relation to a variety of clothing items. Penn State initiated the action

because a trademark examiner cited Norrøna's existing registration as reason to deny a second application filed by Penn State to register PENN STATE WHITE OUT, this time in relation to "shirts." Penn State claimed that Norrøna was no longer using the WHITEOUT mark in the United States, if it ever was doing so. Nonuse is grounds for cancelling a trademark registration.

Penn State's effort was misguided as a matter of policy, regardless of the legal basis it unquestionably had to pursue the action it did. PENN STATE WHITE OUT is hardly an integral feature of the university's existence or function—unlike, for example, its name, seal, or athletic team's name. The university probably had hoped to register just the words WHITE OUT but knew that such an application would be refused, due to Norrøna's prior registration of the phrase, so the university added the words PENN STATE to the mark in order to hopefully gain registration. When that effort did not work, it decided to seek cancellation of Norrøna's registration.

The university's real interest seems to lie in capitalizing on the color white, used in relation to collegiate athletic contests. There are quite a few collegiate teams across the country that use white as one of their official colors, and whose fans might wish to coordinate spectators wearing this color to athletic contests, which they might also want to descriptively call a "white out." Will Penn State seek to stop any attempts by other institutions to "white out" a stadium by asking their fans to wear white, the school color? To ask this question is to understand how Penn State's cancellation effort, while technically a concern about trademark protection, actually brings up a larger issue, involving freedom of expression, that ought to concern more than just those in Happy Valley. If Penn State is willing to take this degree of action against a commercial entity with which it does not compete, what will it do to competitors within and even outside of higher education if it obtains the trademark registration it seeks?[169]

Unfortunately, a cautionary lesson already exists, involving another university. This classic example of trademark overreach concerns Boise State University and its football field, where the turf at Albertsons Stadium has been colored blue since 1986. Trademark law

in the United States is broadly based, and nearly anything capable of distinguishing a source can serve as a trademark, provided that it is nonfunctional, that is, that no competitive need exists for someone to use it (see chapter 2).

Despite these well-established precepts, Boise State University claims trademark protection for the color blue when it is used on artificial turf in stadiums. The university has even registered the color at the federal level, claiming trademark protection for this color in connection with "entertainment services, namely the presentation of intercollegiate sporting events and sports exhibitions rendered through a stadium, and through the media of radio and television broadcasts and the global communications network."[170] Boise State has owned this trademark registration since November 10, 2009.

As Michelle Gallagher persuasively argued in a 2014 article, several reasons exist why we should doubt the validity of Boise State's claimed trademark, even though the university invokes its federal registration to demand licensing arrangements from anyone who uses any color other than green as the predominant color on a playing field.[171] This means that Boise State University takes the position that a high school in Maine, using the color red as the predominant color on its high-school lacrosse field, may do so only with Boise State's permission. From the university's perspective, its trademark registration allows it to demand licenses from *anyone*—not just fellow colleges—using a nongreen color on *any* type of playing field, not just football fields.

Boise State's behavior raises several issues regarding its trademark registration that have a bearing on the uses and abuses of intellectual property in higher education: (1) that the university's trademark registration is invalid, because the claimed trademark is functional, which "allows Boise State to control and curtail legitimate competition";[172] (2) that the university's aggressive yet unregulated licensing of its trademark to other colleges and universities has led to Boise State's effective abandonment of its rights to the mark; and (3) that the university's position concerning the breadth of its trademark rights is unfounded and injurious to the public good.

First, the color blue, when used on football fields, was not an arbitrary choice by Boise State, but instead was driven by its functional attributes. Evidence suggests that television viewers find blue to be an attractive color when watching sports broadcasts. For example, promoters responsible for the U.S. Open and Australian Open tennis tournaments chose to use blue as the primary color on those playing surfaces, because of the color's telegenic appeal. Additionally, Boise State's trademark registration effectively depletes the stock of available colors that other colleges and universities could use on their playing fields. Despite Boise State's contention that the color blue has become synonymous with Boise State, "it is probably safe to say that fans of Notre Dame, Penn State, University of Michigan, and other schools that use blue in their color schemes would disagree."[173] For these reasons, at least, the mark is functional and should never have received federal trademark protection.

Second, Boise State arguably has lost or risks losing its rights to its trademark because of its licensing practices. The university takes the unsupported and unsupportable position that any college, university, or high school wishing to use a playing field having any color other than green is only permitted to do so if it has a trademark license from Boise State, which the university issues for free. A review of Boise State's standard license shows that it has no quality-control provisions and states that users/licensees of the nongreen-colored fields should do nothing to suggest that they have an affiliation with or an endorsement by Boise State. This type of no-strings-attached license is known to trademark lawyers as an uncontrolled, or "naked," license. Naked licenses destroy the value of the brand and ultimately destroy trademark rights, as the mark owner cannot have it both ways: trademark holders cannot demand that a commercial user obtain a license from them to use the mark, while simultaneously stating that the licensee's use of the mark neither impacts nor produces any benefits for the mark owner.[174]

Third, and most problematic from a policy perspective, Boise State has taken a wide-ranging and unfounded approach to licensing its trademark. Even though the registration for it only covers

intercollegiate athletics, as of 2015, Boise State had entered into licenses with seventeen high schools and elementary schools with blue- or navy-colored fields in locations across the country, including in Barrow, Alaska. Additionally, even though Boise State's registration only covers the color blue, the university has used it to demand licenses from any college or university using a nongreen field, currently numbering over thirty and counting. Boise State has even requested that turf manufacturers tell their clients to contact the university should they consider purchasing nongreen-colored turf for a new stadium for any sport. As Gallagher forcefully argues in her article, "imbuing an exclusive proprietary interest in *all* color (besides green) on school playing fields, and denying other schools the right to use *any* color (besides green) on their sports fields without a license from Boise State is an inappropriate extension of trademark law."[175]

The silly and harmful practices by Boise State University help illustrate the problems that come with trademark-rights accretion in higher education. Trademark registrations—which colleges and universities should only obtain to protect core aspects of their identities—are powerful commercial tools that not every institution of higher education is prepared to wield in a manner consistent with the public interest. These registrations have a tendency to beget enforcement, which is often pursued in an opportunistic manner, rather than as a reluctant necessity driven by the presence of actual confusion in consumers' minds and marketplace harm.[176]

As Gallagher rightfully notes in concluding her article, "university colors should be recognized as conduits of school spirit shared by many, and the standards for protection of such colors as intellectual property must be viewed in such context."[177] I would add that exclusive rights can hurt the public when such rights are inappropriately broad, or when the public-serving entity that holds appropriately granted rights is not sure how to use them to further the public good. As argued more forcefully in chapter 7, the solution for colleges and universities wishing to avoid these pitfalls and temptations is to not seek trademark protection over every associational aspect of the in-

stitution, particularly names, devices, and colors in common use by or of common need to others in higher education.

Unfortunately, examples of problematic trademark claims and enforcement efforts by institutions of higher education are not limited to athletic concerns. Colleges and universities have been seeking and obtaining far-reaching trademarks in other areas of activity for some time. For example, in 1988, the New Jersey Institute of Technology, a public university, obtained federal registration for the term VIRTUAL CLASSROOM, as used in connection with computer programs. By the mid-1990s, as the concept of e-learning was implemented and became in vogue in higher education, this university sought to enforce its trademark rights over nonprofit and for-profit uses of VIRTUAL CLASSROOM.[178]

More recently, East Carolina University made headlines when, in 2013, it sued Cisco Systems, the computer-networking giant, for trademark infringement. What are the links between higher education and a leading purveyor of computer infrastructure? East Carolina University has federal trademark protection for the phrase TOMORROW STARTS HERE, as used in relation to "education[al] services in the nature of courses at the university level." Cisco used the same phrase in its new line of marketing (which was unrelated to courses and education), which drew the university's attention.[179] Here, too, the potential for confusion by the public was minimal—a much more speculative happenstance than the prospect of a settlement that could lead to welcome revenue flowing back to the university.

At Washington State University, the link between budgetary woes and trademark activity has been made explicit. The university recently turned to its farm operations as a trademark opportunity, selling cuts of its Wagyu beef (a high-quality—and expensive—meat from only certain breeds of cattle) marked with the identifying brand W.S.U. As justification for the unusual move, the chair of the university's Animal Science Department told a reporter for the *New York Times*: "We've all taken a [financial] hit. These programs have to be self-sustaining."[180] It seems that where there is revenue to be generated in college or university operations, trademark activity soon follows.

The Wagyu beef anecdote is not to suggest that protecting a university's agricultural output by using a trademark is a new phenomenon. Such products have frequently been the subject of trademark claims in recent years, although typically not with the name of the university. For example, for decades, the University of Minnesota took the public-serving nature of its status as a land-grant institution quite seriously. When its faculty members in the agricultural sciences developed new breeds of agricultural products, seeds for these products were freely distributed to the state's farmers, so society could obtain a maximum benefit from its investments in science and research.

But facing an impending cliff of patent-licensing revenue, officials in Minneapolis began to get restive. A feeling that their university had failed to capitalize on the potential revenue associated with branding took hold. After all, the Honeycrisp apple—developed by scientists at the university as a result of public research investments—had been wildly successful, yet officials sensed that their institution had lost out on the full amount of income that could have been generated by this apple. Because of coordination, protection, and enforcement lapses, essentially anyone could grow any variety of apple and sell it under the Honeycrisp name without paying the university a royalty.[181]

Enter a new cultivated variety of apple, branded as SWEETANGO, that had also been developed at the University of Minnesota. The university decided to release this apple as a managed variety, instead of an open release, which would have allowed anyone to grow it without payment to the university.[182] Prior to the University of Minnesota's commercialization of the new apple, no university had ever released a managed variety of apple in the United States. Under this structure, the university selected an exclusive licensee. That licensee, in turn, requires anyone wishing to grow the apple to join a consortium it has established, hubristically named Next Big Thing. Smaller growers in Minnesota who were not included in the consortium were permitted to cultivate limited numbers of the new apple, but they were told they could not sell them commercially, except directly at

farmers' markets, in local grocery stores, and at farm stands. Growers outside of Minnesota were told they could not produce the new apples at all unless they joined Next Big Thing.

Unsurprisingly, the university's decision to offer the SWEETANGO apple as a managed variety upset many small growers in Minnesota. Some viewed the university as playing favorites within the apple industry and upending its mission as a land-grant institution, historically entrusted with identifying and disseminating useful agricultural advances to all Minnesotans without an undue concern for profit. As one small grower told an author writing for the *New Yorker* in 2011, "The university has become our competitor, and they have a great advantage, because they're the only ones that have this new apple everyone is bragging on."[183] A lawsuit instigated in 2011 by various small growers against the university was settled early, out of court, but not on terms that substantively changed the university's handling of SWEETANGO's release.

Trademark Enforcement and the Public Good

These examples illustrate the perils related to colleges and universities amassing and enforcing trademarks. Despite the worrisome hazards often stemming from such activities, two rhetorical defenses of college and university trademark enforcement can arise from those inclined to think these activities have no lasting ramifications for the public: (1) such stories are not unique to higher education, and (2) the revenue to be generated from scratching the enforcement itch offsets any downsides related to that activity. Each of these arguments is without merit, and rebutting them only underscores the harm to the public that can come from trademark enforcement in higher education.

It is true that every industry has its own trademark war stories, including examples of clear overreaching or questionable enforcement tactics. Hardly a month goes by without newspaper stories or blog postings that provide illustrative examples of trademark-attorney gamesmanship that are bound to delight or disgust, depending on your view of trademark rights.[184] You could see instances of questionable

trademark accretion and enforcement by colleges and universities as being similar to these other stories. In other words, higher education did not invent the trademark system. If this sector plays within the rules of that system, then the public has no reason to complain. If the trademark system seems objectionable, then the solution is to fix the system; the problem is not with colleges and universities.

This position, however, is defenseless. It essentially amounts to a form of the childhood argument, "But everyone else is doing it!" Though colleges and universities are becoming more tied to the market, this does not mean that their behavior must resemble that of commercial actors in every respect. Nonprofit higher education, as a sector, receives tax subsidies precisely because it exists to serve the public. When institutions of higher education take adversarial stances and advance legal positions that have tenuous ties to the public good, we, as the public, should take note of these activities and question them.[185]

The other common defense of trademark enforcement in higher education is that the ends justify the means, since revenue, from whatever source, is necessary for a modern-day university to function. Trademark enforcement may seem appropriate if the focus is on the potential funds to be generated from that activity, monies that could be used to fund important institutional programs and services, including student scholarships.

Regardless of the purposes to which any of the income realized from trademark enforcement is put, that activity should not receive a free pass simply because trademark rights and revenue are involved. If the justification for enforcement activity is simply "We need the money," the appropriate retort is "Yes, but at what cost?" Detractors would not be willing to overlook the moral component of actions in other realms of higher education. For example, protesters rightly challenged college and university investments in South African companies that supported apartheid during the 1980s, leading many campus foundations to shift those funds elsewhere.[186] More recently, in the context of patents and technology transfer, several universities

have agreed not to license their patents to pharmaceutical companies that insist on charging monopoly prices to patients in developing countries. Most patients in those nations—as well as many in our own country—whose lives would be improved or prolonged by a particular drug cannot afford to pay the price typically charged for patented drugs.[187] Although the moral dimension of college and university trademark behavior pales in comparison with these two examples, the point is the same: if we believe that higher education is a moral undertaking, or at least that this sector is subject to higher standards, we must expect it to rethink instances when its behavior proves to be harming, not furthering, the public good.

The unfortunate reality is that trademark-rights enforcement often jeopardizes the public-interest aspect of higher education. Enforcement actions by colleges and universities can create ill will in the public at large, as the benefit from or necessity of engaging in these legal actions is often difficult to articulate. In patent-infringement lawsuits, universities can highlight their investments in the research that created the relevant patents, as well as the value-added component from university involvement in technology transfer. A story higher education plaintiffs like to tell, which has much rhetorical appeal, involves the seemingly fundamental unfairness of businesses stealing patented inventions that arise from costly university research investments without paying a licensing fee.

This same type of narrative resonates less strongly in the context of trademarks. Unlike patents—which expressly arise from the intellectual-property clause in the Constitution and are inextricable from their underpinnings in the public good—trademarks are purely commercial tools that the public often sees as solely benefiting private-rights holders, without any attendant contribution to the public domain. Also, trademark law is devoid of legislation that encourages colleges and universities to seek trademark protection, unlike the situation for patents, where the Bayh-Dole Act explicitly considers marketplace activity by institutions of higher education and the ownership of patents in instances where public money is

involved.[188] For these reasons, colleges and universities are not well positioned, in most cases, to argue that their trademark-enforcement efforts help further any interests other than their own financial ones.

Assessing trademark-enforcement opportunities always involves cold-hearted calculations—what do we stand to gain, what do we stand to lose?—but the most difficult questions seem lost on many institutions of higher education that choose to enforce their private rights. What motivated a decision to obtain trademark rights in the first place? What goals are furthered by obtaining trademarks and enforcing them? As long as the answers to these questions are unclear, or the questions are unasked, trademark enforcement by most colleges and universities is likely to be scattershot, or even inopportune.

Private Rights, Public Goods

We should not want or expect institutions of higher education to seek private rights in the language that describes or promotes common educational components or represents attempts to solve community concerns. These forays clutter the linguistic market and are causing a growing blizzard of marks issued to colleges and universities, leading to a whiteout of worries. Fueling the storm are the hypersensitive image-consciousness of these institutions and their mistaken belief that any pet phrase needs protection in the form of a trademark registration. A commitment to unfettered speech—long considered to be a hallmark of academe—has an overwhelming potential to be buried under drifts of intellectual-property regulations.

Little is to be gained from this growing commodification of language, despite these institutions' mostly vain hope that locking up terms describing their academic programs and research initiatives will lead to additional revenue. Yet most trademarks that go beyond the simple protection of institutional names, logos, and insignias present poor licensing opportunities, if any.

As more colleges and universities expansively construct their trademark portfolios, many feel compelled to police any marketplace reference to their institution, even when the potential for market confusion and harm are minimal. With the help of indulgent court

decisions, universities find themselves tempted to keep playing a game they think they can win. We, as a society, are the ones who risk losing.

Yes, colleges and universities have a responsibility to protect their assets, but their trademark portfolios should not be stockpiles that inhibit free speech. We should reject a world where curricular features and research goals are trademarked, like menu items at a chain restaurant. Our institutions operate in the public sphere by design, with no prospects paralleling those in the business world, where a buyout by another firm is made more attractive by possessing an arsenal of trademarks.

Dislodging the ™ from University™ will not happen overnight. But trademark rights that are claimed and awarded do not have to last forever. Their owners can relinquish them whenever they want. We should expect colleges and universities to use their trademarks to compete fiercely for students and allegiance, and to generate revenue from athletic wear and other consumable goods. But we should want them to leave the rest of higher education as unmarked space, open for the public good.

Chapter Four

University Patents under the Sun

Our Bodies, Their Genes

In the early 1990s, a high-stakes race was underway to map the human genome. The genome contains the coding instructions for human life, and identifying the exact locations of genes that corresponded to various attributes held untold potential for allowing researchers to unlock the mysteries of life, most notably, genetic predispositions for diseases. This research therefore embodied a vast potential for profit—a fact that was not lost on many researchers and the universities that employed them. (The use of "universities" in this chapter is deliberate, as most colleges do not engage in technology transfer, do not seek patents or litigate them, and are not members of higher education's professional group dedicated to technology transfer.) The popular press and the scientific community now often trumpet that more than 20 percent of the human genome has been patented since the first gene patent was issued in the early 1980s.[1] While this figure may be overstated, at the very least, if not empirically flawed, this much is certain: thousands of U.S. patents for human genes had been issued through 2013, and universities owned many of them.[2]

In 1994, a faculty researcher and his team, funded with $5 million in federal grant money from the National Institutes of Health (NIH), discovered the location of certain genes, mutations in which correlate with an increased risk of breast and ovarian cancers.[3] The genes in question are known as *BRCA1* and *BRCA2*. The researcher, Mark Skolnick, was a professor at the University of Utah's Center for

Genetic Epidemiology at the time. He and others in his laboratory "isolated" the *BRCA* genes, which essentially entailed performing a routine laboratory act of selectively breaking chemical bonds to separate these genes from the rest of the genome. Although the act of gene isolation is routine, the discovery of the location of the *BRCA* genes was anything but simple, effectively amounting to finding a proverbial needle in a haystack. The researchers soon reported their discovery to the University of Utah, which had a right to own any resulting patents, according to its standard intellectual-property policy, which was applicable to faculty members like Skolnick.

Sensing the importance of this discovery, the university elected to retain ownership of the invention and promptly sought patent protection for it, both domestically and abroad. The resulting patents claimed the two isolated genes; the methods of comparing a patient's *BRCA* sequence with the normal sequence, to identify the presence of cancer-predisposing mutations; and the methods for screening potential cancer therapeutics.

The discovery provided the university with a valuable opportunity to help mankind, which it was in a position to do as an owner of the patents. With the *BRCA1* and *BRCA2* genes identified, countless companies across the world could easily develop diagnostic tests that would potentially help patients understand their chances of developing breast or ovarian cancer. Armed with information on this likelihood, women might decide to take prophylactic measures—such as undergoing mastectomy or hysterectomy procedures—to prevent the occurrence of cancer. At the very least, they stood to know more about their genetic predispositions, information that could be quite valuable in assessing treatment options for patients with cancer, or for those living in fear of getting cancer in light of family histories of the disease.

In view of the public funding for this research discovery, and its vast importance to mankind, we might assume that the University of Utah did everything within its power to see that the discovery was disseminated far and wide. Offering any interested party a nonexclusive license to use the patents for a small fee would be an effective

way to proceed, if broad dissemination was the goal. That way, many parties could offer the test, and all would compete on its price, allowing patients different options for obtaining this valuable information about their genetic makeup.

Such an assumption, unfortunately, would prove to be incorrect. Instead of licensing the patents nonexclusively, the university chose to license the patents on an exclusive basis to one company, Myriad Genetics, based in Utah. Myriad was not selected to receive this exclusive license after an exhaustive interview process, involving all interested companies. No request for proposals was issued—far from it. Skolnick and some colleagues had formed Myriad Genetics three years earlier, in order to capitalize on potentially profitable inventions they might make.[4] Skolnick left the University of Utah shortly after his discovery, so he could become the chief science officer for the company.

The University of Utah's exclusive licensing of its patent rights to Myriad Genetics allowed the firm to enjoy a lucrative monopoly on diagnostic testing for the *BRCA* genes in the United States, leading to more than $1 billion in revenues for it and the University of Utah since Myriad first offered the test in 1999.[5] The company quickly became known for being "voraciously litigious," suing or threatening to sue anyone who offered genetic testing for the *BRCA* genes to patients in the United States, including medical doctors at the University of Pennsylvania.[6] The effect of these efforts was to solidify Myriad's role as the only purveyor of the test, which was a gold mine for the company, as it charged as much as $4,000 to administer the tests.[7] Results took days, and sometimes weeks, to obtain, as all tests had to be processed at the company's headquarters in Salt Lake City, Utah.

Myriad's enforcement efforts wrought untold consequences for academic science. Many researchers ceased all testing on the *BRCA* genes, whether for clinical or research purposes, out of a reasonable fear of being sued, or they conducted such research privately and then declined to publicly disseminate the results. This dampening effect only redounded to Myriad's benefit, as "a dearth of independent

research on the *BRCA1* and *BRCA2* genes shored up the value of Myriad's own [proprietary] database of identified mutations."[8] In short, Myriad Genetics used its exclusive patent license from the University of Utah to deter others from researching the *BRCA* genes, all the while building up a proprietary database of information gleaned from its diagnostic tests, data that it refused to make public after 2006.

There is no question that individual patients benefited from Myriad's testing—over a million patients worldwide had been tested by 2012.[9] The larger and more important question is whether more women might have avoided getting cancer if other companies could have performed commercial and noncommercial testing on the genes without fear of legal actions during the years in which the patents were valid. The answer is a resounding yes, as many news stories detailed the plight of women who could not afford the test or could not verify Myriad's test results with an independent provider before deciding to undergo an irreversible medical procedure.[10] If women had options for *BRCA* testing, cancer patients could have learned more quickly if they had the genetic mutations in question—quicker than the up to three weeks it took Myriad Genetics to conduct the tests and return the results. If substitutes existed in the marketplace, cancer patients and their insurers also would have paid less than the thousands of dollars Myriad charged to administer the test.[11] It is hard to argue that quicker and cheaper access to information about your own genetic disposition for cancer—as well as the ability to verify that information with a marketplace competitor, when the consequences of an inaccurate test result can be life altering—does not plant itself firmly in the public interest.[12]

Myriad's zealous enforcement efforts eventually led to a lawsuit initiated by some of the accused infringers, who asked a court to declare that the patents were invalid, because they claimed subject matter—isolated human genes—that was ineligible for patent protection.[13] The district court ruled that the patents were invalid, and Myriad appealed this decision with the CAFC, which zeroed in on the legal ramifications of the case. This court purported to ignore the

impact the university's patenting and licensing decisions had on the public good, or whether the decisions to seek patents on the claimed inventions or to license them exclusively to Myriad Genetics were advisable. As the CAFC stated in its opinion, upholding the patents' validity: "[The case] is not about whether individuals suspected of having an increased risk of developing breast cancer are entitled to a second opinion. Nor is it about whether the University of Utah, the owner of the instant [current] patents, or Myriad, the exclusive licensee, has acted improperly in its licensing or enforcement policies with respect to the patents. The question is also not whether is it desirable for one company to hold a patent or license covering a test that may save people's lives, or for other companies to be excluded from the market encompassed by such a patent."[14]

Like most appellate courts, the CAFC might be expected to eschew moral arguments in favor of legal ones. But the policy questions the CAFC dismissed as irrelevant in the *Myriad* case are precisely the questions that those concerned with advancing the public good through university research and commercialization should be asking—then and now.

Many prominent scientists and organizations argued at the time that seeking and awarding patents on isolated human genes jeopardized the public good instead of furthering it. They argued that the human genome is part of society's collective cultural heritage and should be available for study, to the benefit of everyone, without restrictions imposed by the potential for profits from it. James Watson, codiscoverer of the double-helix structure of DNA, called gene patenting "lunacy."[15] In a brief submitted in the *Myriad* case in support of the plaintiffs, Watson stated that patenting isolated forms of the double helix he discovered was "out of the question," even though some suggested that he seek such protection when he made this research breakthrough. In a similar vein, a CAFC judge, writing a dissenting opinion in the case, compared extracting a gene with "snapping a leaf from a tree"—if anything, a physical act of discovery and separation, and not an invention.[16] The United Nations takes a similar view of the human genome. The Universal Declaration on

the Human Genome and Human Rights cautions against genome-related activity that threatens human rights or human dignity, while also declaring that "the human genome in its natural state shall not give rise to financial gains."[17] All of these arguments against gene patenting fell within a broader area of biomedical research that many believed to be overly privatized. Instead of cultivating a robust and open cultural and knowledge commons, excessive patenting by universities and others had created an "anticommons" of restricted yet underused resources.[18]

Even when a university makes a decision to seek or obtain patents on anything related to DNA, an exclusive license, like the one Myriad Genetics received, is not a necessary vehicle for bringing diagnostic breakthroughs into useful applications to health issues. A common belief is that without the allure of an exclusive license built on a strong portfolio of patents, no company will be interested in incurring the costs necessary to bring a discovery to market, as the payoff is not substantial. This argument, as applied in the *Myriad* context, overlooked the fact that providing diagnostic DNA testing is cheap and easy. The hard part was identifying the genes—which public funding helped Skolnick and his team do—not figuring out how to market or implement the discovery. Indeed, several nonprofit research hospitals and for-profit companies were prepared to offer diagnostic testing for the *BRCA* genes, if they could do so without potentially incurring legal liability.[19] Many have noted that *BRCA* gene testing would have been widely available in the absence of Myriad's exclusive license.[20]

Fortunately, when cases involve patents, the United States Supreme Court typically takes a broader view of what constitutes the public interest and the importance of law in reflecting policy choices than does the CAFC. An appeal of the CAFC's decision that ruled in favor of the University of Utah and Myriad Genetics was submitted, and the high court invalidated crucial claims in the disputed patents. In an opinion authored by Justice Clarence Thomas, the court remarked: "Myriad did not create anything. To be sure, it found an important and useful gene, but separating that gene from

its surrounding genetic material is not an act of invention."[21] The court ruled that isolated DNA is not eligible for patent protection, as the claimed material constitutes physical phenomena, not something invented by a human. The court appropriately recognized that the disputed claims were important because of the broad-based information they conveyed, not because of the narrow and specific chemical composition of a particular molecule described in the patent application, as Myriad had suggested.[22]

Reaction to the court's opinion was swift and predictable. Public-interest groups and many within the scientific community praised the opinion and the outcome of the case as reflecting common sense and upholding the public's trust in academic science. Meanwhile, advocates of patenting, which they see as indispensable to the advancement of science, derided the high court's opinion, positing that it was undoing decades of practice and lower-court case law, which assumed that isolated DNA was generally eligible for patent protection.

Notwithstanding the importance of the Supreme Court's opinion, not all claims in the University of Utah's and Myriad's patents were at issue, and the court's opinion did support the patent eligibility of what is called cDNA, which is synthetically created DNA that omits certain gene sequences.[23] The disputed patents contained claims to *BRCA*-related cDNA as well. With an estimated 515 out of 520 patent claims still valid, Myriad and the University of Utah soon initiated new litigation, suing various companies that had announced they were entering the diagnostic-testing market for *BRCA*-related cancers after the Supreme Court's decision.[24] The monopoly the patents gave to the University of Utah and Myriad Genetics, even though the research leading to the discoveries was supported by public dollars through an NIH grant, was simply too lucrative to give up.[25] As Peter Lee noted, with understatement, as these lawsuits proceeded, "The prospect that Myriad continues to maintain considerable intellectual property over *BRCA* testing suggests that more widespread testing—and the research gains that it produces—may face some obstacles."[26]

Those obstacles were overcome when the CAFC invalidated most of the key remaining claims in a consolidated-appeal decision, handed down in late 2014. Applying the logic of the earlier Supreme Court decision, the CAFC wrote, "Allowing [these claims] could impede a great swath of research relating to the *BRCA* genes, and it is antithetical to the patent laws to allow these basic building blocks of scientific research to be monopolized."[27] Seeing the writing on the wall, Myriad Genetics settled its disputes with the competing companies in early 2015.[28] After nearly twenty years of Myriad enjoying exclusive rights that never should have been granted, the public could finally benefit from marketplace competition and access to the scientific discovery that its tax dollars helped fund.[29]

Despite the outcome of this saga, which resulted in a doctrinal refinement of patent law in the public's interest, the evidence is clear that the University of Utah's choice for how to commercialize the patents in question was not an anomaly. Other institutions would have made the same decision, which was contrary to the public's best interests, if presented with information about a lucrative invention by one of their faculty members. Some institution somewhere is bound to make a similar choice in the future when confronted with a discovery of great value to humanity, situated at the boundaries of what science makes possible and what the law permits. Unfortunately, budget woes and harrying by entrepreneurial state lawmakers and revenue-conscious administrators and business leaders are prompting universities to reimagine their research programs and their treatment of patent-eligible intellectual property, typically with a view toward claiming and owning whatever the law may permit.[30] Many feel more pressure than ever to pounce on any potential revenue-generating discovery made in their laboratories.[31]

But just because prevailing law *allows* certain forms of patent activity does not mean that universities must *engage* in it. More than anything, the Myriad Genetics saga illustrates the tensions that arise, and the poor decisions that can result, when nonprofit altruism confronts the legal and for-profit norms of commercial bioscience.[32]

With the *Myriad* case and its aftermath as an instructive lead-in, this chapter explores these tensions in more detail, looking in particular at the institutional infrastructure of university patent and licensing operations that makes exclusive licensing so attractive, and all too common. It also considers the phenomenon of university engagement in patent-infringement litigation—a rare instance when universities face marketplace incentives, and even legal mandates, to participate in the legal system in an offensive and often reputation-damaging way. The attendant policy concerns are many. The chapter concludes by considering higher education's role in recent, ongoing efforts to reform the patent system, and how some of the positions that higher education has taken with regard to these efforts work to frustrate this sector's ability to use patents to further the public good.

University Engagement in Patenting and Technology Transfer

To better understand the forces that encourage universities to seek patents and license them exclusively, as well as hold fast to an antiquated model of university technology-transfer office (TTO) structure, first requires a brief history of university engagement in patenting and technology transfer, or what some have called the "large-scale experiment in how public institutions manage public assets as private goods."[33] The importance of technology transfer to higher education's position in the public sphere cannot be understated. As David Winickoff notes, "Technology transfer—its norms, practices, and politics—has become a crucial site where the very idea of the modern university is being unsettled, reworked, and reestablished."[34]

Pre-1980 Activity

University faculty members have sought patents since at least as early as the beginning of the twentieth century. In 1925, the University of Wisconsin–Madison created what could be deemed the nation's first TTO, establishing a separately incorporated entity known as the

Wisconsin Alumni Research Foundation (WARF). WARF was created to exist outside the formal university structure, because of the faculty's misgivings about the potential to profit from academic research. The organization soon exclusively licensed a patent for vitamin D irradiation, obtained by a biochemistry professor, which had significant applications in the dairy field, eventually leading to vitamin D supplementation in milk and a subsequent decrease in the incidence of the childhood disease of rickets.

Fewer than 100 patents were issued to universities in the twenty years that followed.[35] As the federal government turned to universities to assist with defense initiatives during World War II, many universities—even ones not heavily involved in patenting—established patent policies to clarify that faculty inventors were obligated to assign their patent rights to their university, at the same time as these institutions otherwise sought to distance themselves from the activity of patenting. As part of this effort, a nonprofit intermediary organization, called the Research Corporation, managed the licensing of most university patents well into the 1970s. Only twenty-five universities had established TTOs by 1980, and patents issued to universities numbered fewer than 300 per year.[36] In contrast, by 1990, over 200 universities had TTOs and collectively received over 1,200 patents.

Many believe that universities were deterred from patenting before 1980 because of the complexities in determining who owned inventions discovered in the course of federally funded research.[37] Each federal funding agency during this era had its own policy concerning the ownership of inventions developed with the government's money. Some required that the government retain title to inventions funded with federal dollars—others, that the inventions be placed in the public domain, free for anyone to use. A few agencies negotiated institutional patent agreements (IPAs) with individual universities, allowing them to own and license patents arising from funded research. While IPAs generally resulted in increased patent ownership for universities, not all universities were offered such agreements, and each funding agency had its own policy concerning how IPAs were granted.

Post-1980 Activity

The Bayh-Dole Act of 1980, and the circumstances that led to its passage, are crucial in understanding the role of patents in higher education. Prior to the Bayh-Dole Act, American universities typically were not permitted to claim an ownership interest in faculty inventions financed with federal dollars. The federal government—as the funder for the majority of faculty research—was the default owner of any patents emanating from such research. The Bayh-Dole Act of 1980 changed this presumption. Motivated in part by growing concerns for the competitive threat posed by Japan's technological advances, policy makers in the late 1970s questioned whether the federal government's apparent inefficiency in licensing the patents it owned was undermining America's position as the world's leading innovator.

Congress responded to these concerns by passing the Bayh-Dole Act. Signed into law by President Jimmy Carter on December 12, 1980, the Bayh-Dole Act added a chapter to the nation's patent laws that permits universities to retain ownership of faculty inventions that are discovered in the course of federally funded research. Originally introduced as the University and Small Business Patent Procedures Act, the Bayh-Dole Act was named in honor of its bipartisan sponsors, former senators Birch Bayh (D-IN) and Bob Dole (R-KS). Universities and higher education groups, such as the American Council on Education, lobbied heavily in support of the bill. The promotion of "collaboration between commercial concerns and nonprofit organizations, including universities" was one of the Bayh-Dole Act's stated purposes.[38]

Recognized as a "remarkably important piece of science policy legislation," the Bayh-Dole Act effectively encouraged universities to formally and systematically participate in technology transfer, the broad term for what has become a favored method of product development and commercialization.[39] Technology transfer can be thought of as the "transfer of the results of basic and applied research to the design, development, production, and commercialization of

new or improved products, services, or processes."[40] Its benefits to society have been many: a source of revenue generation for some universities; an instigator of additional funding opportunities for faculty researchers; a driver of local and regional economic development; a reason for promoting cultures of entrepreneurship and innovation on campus; a fount for educating students; and a benefit to society, in terms of an increased quality of life through the eventual introduction of new products and services into the marketplace.[41] Examples of but a few of the path-breaking and even life-saving inventions that have been commercialized because of Bayh-Dole include the pain medication Lyrica, a combined PET/CT scanner, a vaccine for the sexually transmitted HPV disease, crop-protection technology, and facial-recognition software.

Spurred in part by the Bayh-Dole Act of 1980, over the past thirty-five years, research universities across the country have created vast institutional apparatuses—typically centered in TTOs—to help them participate in technology transfer and move ideas invented in the laboratory and classroom into commercial applications.[42] TTOs are responsible for many things: collecting invention-disclosure forms from faculty who come up with innovations; liaising with attorneys to assess the patentability of technologies developed by faculty; overseeing the filing of patent applications and the maintenance of issued patents; and working to find appropriate firms interested in licensing university patents and commercializing the technology described in them. TTOs are, in effect, the primary university doors—or "interstitial organizations," to use terminology coined by Sheila Slaughter and Gary Rhoades[43]—through which industry contacts and the commercialization of research occur.

The Bayh-Dole Act applies to research funded by any contract, grant, or cooperative agreement between a federal agency and a nonprofit organization, even if the federal agency only partly funds that research. In exchange for the funding, the agency retains a nonexclusive, fully paid-up, royalty-free license to use any resulting invention on behalf of the United States—essentially a right to use the invention, and nothing else.[44] The federal government may also restrict or

eliminate a university's right to retain the title to a federally funded invention, but only in "exceptional circumstances," and only if it elects to do so at the time of funding.[45] For patent rights already held by a university, the funding agency may "march in" and claim ownership of patented technology developed with federal funds under certain circumstances, including the university's failure to undertake reasonable commercialization efforts, or when governmental action is necessary to alleviate health or safety needs.[46] Even with these provisions in the law, in the more than thirty-five years since passage of the Bayh-Dole Act, the federal government has never exercised its march-in rights, despite situations in which it was prompted to do so, and it has only rarely invoked "exceptional circumstances" at the time of funding. In part for these reasons, the federal government's oversight of university technology-transfer activities subject to Bayh-Dole is more theoretical than real.[47]

The number of TTOs and patent applications filed by universities proliferated after the passage of the Bayh-Dole Act, while the activities of the Research Corporation decreased, to the point where it handled only 5 percent of the total share of university patents by 1985.[48] While the Bayh-Dole Act brought these and other significant changes to the participation of universities in technology transfer, the legislation was not the only policy change in the early 1980s responsible for the significant increase in university patenting. The United States Supreme Court also influenced this engagement by changing key substantive rules on patentability. For example, in 1980, the Supreme Court decision in the *Diamond v. Chakrabarty* case stated that living organisms constitute subject matter that is eligible for patent protection. One year later, the court ruled that certain kinds of software could be patented.[49] Both decisions were rulings that changed patent practices in dramatic ways, leading to an influx of applications.[50]

The *Diamond v. Chakrabarty* case, in particular, encouraged universities to pursue developments potentially having great commercial value in the emerging field of biotechnology. A number of widely publicized, multimillion-dollar research agreements between univer-

sities and industry soon followed the Supreme Court's expansion of the scope of patent-eligible subject matter.[51] Around this same time, scientists working at the University of California, San Francisco (UCSF), and Stanford University invented recombinant DNA, which essentially led to the birth of the biotechnology industry. Patent protection for recombinant DNA was awarded in 1980. Officials at UCSF and Stanford wisely chose to license the patents on a nonexclusive basis, which led to those two institutions receiving more than $255 million in licensing fees. Their high-profile success caused others within academia "to patent more aggressively throughout the 1980s and 1990s."[52]

Another likely contributor to an increase in university patenting in the early 1980s was the Federal Courts Improvement Act of 1982, which established the CAFC. The CAFC's decisions have been more supportive of patent holders than decisions rendered by regional courts of appeal in the earlier judicial system (see chapter 2), thereby making patents more valuable and infringement suits more likely to be resolved in favor of patent owners.[53]

Institutional Intellectual-Property Policies and Structures Affecting Patenting

Although the initial rights to an invention are granted to the individual inventor(s), universities generally have developed policies that require their faculty to assign to the university all rights to any patentable discoveries they make. The nature of inventions subject to this assignment varies by institution. Some claim ownership over any and all patentable discoveries their faculty make while employed by the institution. Others only claim ownership when "substantial university resources" are used in the research that leads to the invention. "Substantial resources" is a term of art that is also subject to varying interpretations. Divining that term's meaning in a given instance has formed the basis of contentious disputes. Incidental use of office equipment and secretarial support certainly does not rise to the level of being considered substantial, but the use of specialized and costly equipment probably brings this activity within the bounds

of the institution's ownership interest. Some policies even include specific measurements, setting a cost floor—for example, "use is considered substantial if the resources employed would cost the professor $15,000 if they were paid out of pocket."

Institutional intellectual-property policies traditionally did not distinguish between research supported by federal and state governments and research funded by private sources, but some institutions now treat the two differently. Institutional intellectual-property policies also state that the university will share licensing proceeds with the faculty inventors, as required under the Bayh-Dole Act for federally funded research. Inventor royalties usually range from 15 percent to 50 percent of the revenues received by the university, and often they increase inversely with the total amount of income received by the university for a patented invention.[54]

The appropriate execution, by faculty, of the documents necessary to assign their inventions to their university employers is a separate but related issue. The fluid nature of faculty research and its varied funding sources (private, governmental, and institutional) mean that disputes over patent rights are not uncommon. In the past, some universities failed to effectively enforce their intellectual-property policies, while faculty themselves sometimes took actions to frustrate those policies, deliberately or unwittingly signing conflicting assignment agreements with industry research sponsors.

This issue came to national attention in 2011, when the Supreme Court decided a case involving conflicting assignment agreements signed by the same Stanford University faculty member, Mark Holodniy. In 1988, when he began his employment with Stanford, Holodniy signed a then-standard university agreement in which he agreed to assign to the university any patentable inventions he made during the period of his employment. A year later, Holodniy's supervisor sent him to conduct research with a company called Cetus, which had developed a new technique, polymerase chain reaction (PCR), that would become relevant to his research. Cetus required Holodniy to sign what it termed a confidentiality agreement that contained present-tense language stating that he "hereby assigns"

any future inventions to Cetus. Cetus later assigned its patent rights to Roche Molecular Systems.

Years later, Stanford obtained patents to inventions made by Holodniy and others, whose research leading to the patents had been funded with federal research grants. Meanwhile, Roche Molecular Systems had begun to market and sell HIV-testing kits utilizing the PCR techniques. In 2005, Stanford initiated an infringement action against Roche when that company refused to pay a royalty for its alleged use of the patented technology. The CAFC later held that Roche could not be liable for infringing on the patents because it held ownership rights in them, based on Mark Holodniy's 1989 assignment.

In its Supreme Court appeal regarding the CAFC's ruling, Stanford argued that a faculty member could not make a unilateral assignment of a future patent right. Doing so, the university stated, could deprive the public of the intended benefits of the Bayh-Dole Act, which it interpreted as legislation that automatically conferred the ownership of faculty inventions to their university employer. The Supreme Court sided with Roche Molecular Systems, ruling that the Bayh-Dole Act does not automatically grant ownership of federally funded inventions to universities, and therefore could not be interpreted as preventing Holodniy's assignment of his invention to Roche's predecessor.[55] The court essentially admonished universities to get their language right, suggesting that present-tense wording—"I assign," rather than "I agree to assign"—was all that was necessary to prevent faculty from assigning away rights to university intellectual property, whether intentionally or unintentionally. Nevertheless, diligently obtaining valid, present-tense assignments of their inventions from faculty, in order to protect the university's ownership interest, has proven more difficult to accomplish in practice than in theory.[56]

Just as university intellectual-property policies vary, so, too, do their structures affecting university patenting. Some higher education institutions have created separately incorporated research or patent foundations to serve as their TTOs. Although they are legally separate entities, TTOs of this sort often are effectively controlled by university

personnel, in the same way that universities typically control their fundraising arms and real-estate holding companies: through oversight structures and board appointments. While the word "university" appears in the title of many of these entities (for example, the University of Utah Research Foundation, which technically was the entity that owned the patents exclusively licensed to Myriad Genetics), some obviously are affiliated with universities despite the lack of that word in their corporate name (for example, Virginia Tech Intellectual Properties). Other TTOs have corporate names that do not, on the surface, signal an affiliation with a university. For example, the patent foundation affiliated with the University of New Mexico has STC.UNM as its legal name, which stands for that entity's former name, the Science and Technology Corporation of the University of New Mexico. The research foundation linked with Arizona State University uses AzTe, which stands for Arizona Technology Enterprises. Its main website is even located at a stand-alone .COM domain name, www.azte.com, as opposed to Arizona State's .EDU domain, www.asu.edu. Chapter 6 discusses these naming conventions in more detail and shows how they are emblematic of higher education's growing embrace of brands.

These separately incorporated entities have the advantage of avoiding the scrutiny that can accompany activities at public institutions. Gary Matkin called them "buffer organizations" that create space between universities and "technology transfer activities that are less consistent with the traditional missions of the university, less in tune with the prevailing academic culture, and less consonant with the public image of the functions appropriate for a university."[57] In some states these organizations are necessary, as their laws prohibit state agencies (including public colleges and universities) from having equity in private companies. Even for private institutions, the added barrier they provide can help shield universities from certain liabilities and help protect their tax-exempt status.

University Patenting and Technology Transfer Today

By the dawn of the twenty-first century, university involvement in patenting and technology transfer had indisputably "moved from

a contested and peripheral activity among America's research universities to an accepted, indeed valued, part of core missions."[58] Substantial government funding for university research has been crucial in facilitating the technology transfer the Bayh-Dole Act envisioned. In 2013, universities received $35.5 billion in research grants from the federal government, more than double what they obtained in 1995.[59] Federal funding accounts for around 60 percent of total university support for research, compared with the 5–8 percent received by universities from industry, which gave $3.7 billion to universities in 2013.[60] The NIH and the National Science Foundation provide the largest share of research dollars—approximately 60 percent and 15 percent of the government's total largesse, respectively—while the Department of Defense, the Department of Energy, the National Aeronautics and Space Administration, and the United States Food and Drug Administration also provide significant funding.[61]

There is little question that money motivates much of the activity in university technology transfer.[62] For years, the Association of University Technology Managers (AUTM)—the technology-transfer industry's professional-membership organization—publicized the amount of licensing income that specific universities received from technology transfer. Recently, though, it decided to withhold those figures from public announcements, out of a concern that the data did not provide an adequate context for their disclosure.[63] Information available to AUTM members, however, shows that American research universities received more than $2.08 billion in licensing revenues from their patents in 2013 and helped to create more than 740 start-up companies based on faculty inventions that year.[64] Top earners—like Northwestern University, New York University, Columbia University, Princeton University, and the University of California System (UC System)—each brought in over $100 million in revenues in 2013, although most universities' returns were far more modest. The median value for all 162 universities reporting their licensing incomes was $1.57 million, and fewer than 1 percent of all licenses issued by universities generate revenues of $1 million or more.[65] The potential for windfall profits, however, tends to capture

the imaginations of technology-transfer professionals and their bosses, even though most refrain from talking publicly about revenue generation.

Bosses also might be less inclined to view exclusive licenses as risky vehicles for commercialization, particularly because of the impact they can have on a TTO's budget. In many ways, these licenses remove some of the costly responsibilities that universities face and place them on the exclusive licensee. For example, universities pay patent attorneys to file patent applications and manage the application process with the USPTO. This expense alone is commonly tens of thousands of dollars per patent—more, if applications are filed internationally. Once the patent is issued, the university, as the owner, then must pay the maintenance fees due to the USPTO at various intervals, just to keep the patent valid. The university commonly passes these costs on to an exclusive licensee, if it has one. But if the university's patent is not yet licensed or is licensed nonexclusively to various entities, then the university bears the patent-application and maintenance costs itself. For these reasons, it should come as no surprise that from 2004 through 2013, over 40 percent of the licenses universities executed were exclusive in nature, just like the license the University of Utah granted to Myriad Genetics.[66]

Although, for universities, seeking patents has become one of the costs of doing research, determining which patents will become commercially valuable continues to be a speculative undertaking for any patent owner, as "it is difficult to identify blockbusters *ex ante* [prior to the event]."[67] Commercial value often hinges on further investments in the development of products and markets, as well as on the technological field of the invention. The hit-or-miss nature of commercializing patents means that a very small percentage of a university's patents generate the lion's share of revenues, and many universities never reap significant financial returns from patent licensing.[68] This reality has led some scholars to argue that universities aspiring to "get rich quick" through patenting are likely to be disappointed, since "it is a game of almost all strike-outs and singles, but with a few home runs."[69]

To hit a home run requires quite a few at-bats. In a study of 101 universities and academic health centers over the period 1996–2005, two researchers found that twenty licenses per university per year was the optimization point for potentially having a net positive return on investments in research and development (R&D).[70] Universities granting licenses at that level still had only a 50 percent chance of a net positive return, while this possibility fell off considerably for universities with more than twenty licenses per year. Data also indicated that no university exceeded a 65 percent chance of profitability in ten years, and that 35 percent of the universities never realized any profits over a ten-year period, no matter how much they invested. Another study showed that as many as 84 percent of TTOs actually lose money each year.[71] With such dismal chances of achieving net positive returns with patents and technology transfer, the savviest universities have come to view these activities as public-service undertakings, instead of get-rich-quick schemes.

Public good certainly does come from university engagement in technology transfer, even if this activity does not turn out to be lucrative for all the universities that engage in it. Public good is generated in the form of growth for local and regional economies, added employment, the development of new firms, and regional knowledge flows that often result from university engagement in patenting and technology transfer. Students also benefit from these activities and find that universities are keen to provide instruction, infrastructural support, and even financial backing for their entrepreneurial efforts.[72] For example, when they were graduate students, Google cofounders Sergey Brin and Larry Page first came up with the idea for their now-ubiquitous search engine in a 1998 paper they coauthored with a professor at Stanford University. Stanford owned the patents that resulted from Brin and Page's invention, which it, in turn, licensed to Google in exchange for an equity stake in the company, rather than a license fee and a royalty stream, because Google was a start-up company. Stanford's early support of the project led to significant financial returns when the university eventually sold its shares of stock in the company for $336 million.[73]

The Google success story highlights the broad view that more-established universities take with respect to technology transfer. These TTOs no longer regard obtaining and licensing patents as their sole concerns. Instead, they view incubator and science park–development, start-up creation and equity-ownership investment, and venture-capital investment as being closely related to their traditional patenting and licensing activities. Some states have actively encouraged these activities, using public monies in ways they hope will foster new collaborations between universities and industry. For example, in 2007, the North Carolina legislature earmarked $64 million in state funds to create a school of nanoscience and nanoengineering, jointly operated by the University of North Carolina at Greensboro and North Carolina A&T State University. In addition to educating students, one of the chief aims of the new school was to help create jobs and businesses that could replace North Carolina's decaying textile, furniture, and tobacco industries. The school's founding dean told state lawmakers to expect a fourfold return on investment, an estimate he called conservative, however unrealistic that might seem to others.[74]

In California, the UC System has created a venture-capital fund, in order to directly invest in UC System–based start-ups. The initial $250 million needed to finance this operation came, in part, from the system's pension fund for employees. One of the goals of the fund—named UC Ventures—is to look and act like a traditional venture-capital fund, which the UC System hopes will convey to industry its seriousness and sophistication regarding commercialization. At least one observer, though, has questioned "whether a university system can both support its mission of furthering its research efforts and still maintain a sound investment strategy."[75]

Unfortunately, the broad view that many institutions now take with respect to their patenting and licensing activities can come at the expense of institutional control over the technology-transfer process. A prime example is in the realm of university research sponsored by industry, which is not subject to Bayh-Dole restrictions. The traditional approach to sponsored research was that universities owned

any inventions and patents that grew out of the research sponsor's funding. In exchange, the research sponsor received an option to be the first to negotiate for rights to the resulting patents. Perhaps the negotiations led to a favorable license for the company, or perhaps the parties could not come to terms and the license went to a competitor. This uncertainty became a sticking point for some companies, which wanted to know that they had exclusive control over whatever benefits came from their sponsorship.

As universities work harder to encourage relationships between their faculty and research sponsors, some are showing flexibility in how they structure sponsorship agreements with these funders. For example, the University of Minnesota now gives industry sponsors a choice: (1) play by the old rules, where companies have an option to negotiate a license, but receive no guarantee that they will obtain it, or (2) pay an additional upfront fee, above and beyond the research award, in exchange for a guaranteed worldwide exclusive license to any resulting technology, no matter what its nature or importance.[76] Other institutions are even offering outright ownership for the sponsor of any patent-eligible invention created by faculty working on the project. Iowa State University offers this choice, as does the Pennsylvania State University, at least for research outside the areas of life science and health science.[77] If these arrangements sound like the use of nonprofit assets (faculty, research labs) for private gain, instead of the charitable purposes for which they were intended (students, society), you are not alone in this perception. Although the universities involved think these practices are sound, legal challenges may lie in their future, based on the tax-law concept of private inurement (the transfer of benefits from tax-exempt purposes and uses to those that are not tax exempt).

Myriad Choices

With the above background in mind, it is easier to grasp why decision makers at the University of Utah handled the valuable *BRCA* patents as they did. The logic often goes something like this: "Bayh-Dole permits university ownership of patents, therefore universities

must own patents to comply with Bayh-Dole. Each institution must have a fully staffed TTO in order to implement the Bayh-Dole 'mandate.' With more patents in hand, more licensees will be interested in obtaining licenses, which those licensees will want as exclusive licenses, so they stand to make immense profits that will more than offset their significant capital investments. The more exclusive licenses we, as an institution, issue, the greater our chances of hitting a home run. If I, as a technology-transfer professional, help my institution hit a home run, I will be recognized for my efforts and may then soon have opportunities to work for the successful licensee or a more-elite institution."[78]

Unfortunately, this mindset is rooted in premises that are out of balance with and challenge the public good. Bayh-Dole does not require universities to retain ownership over their faculty's inventions. In fact, Bayh-Dole permits universities to decline to exercise ownership over a faculty member's invention, in which case the federal government has the rights to it, unless the government releases those rights back to the faculty member.[79] Even if the university elects to retain ownership, the only action the university must take is to seek patent protection for the invention.[80] Bayh-Dole says nothing about what types of licensing arrangements universities must pursue or enter into with their patents.

Universities—through their TTOs and research administrators—therefore face important choices concerning which patents to seek and how to license those patents their institution eventually obtains. Patents may be licensed on a nonexclusive basis to any company interested in developing a product covered by the patent. Or they may be licensed exclusively to only one company, or on an exclusive basis to multiple companies in discrete geographic regions or fields of use.[81] Or patent rights may not be sought or claimed at all in cases where the invention is insubstantial or would more immediately help the public good if it were donated to the public. Notwithstanding the popular TTO interpretation, Bayh-Dole recognizes that not every faculty invention with widespread, life-saving potential that is re-

ported to a university needs to be patented, even if its subject matter is eligible for patent protection.[82]

Critical decisions that impact the public good are inherent in these options. As the *Myriad* case shows, exclusive licenses—where only one company is permitted to exploit the patent—can generate windfall profits to licensees and universities alike, but this happens at the cost of diminished dissemination and a reduction in follow-on R&D efforts by others that could add new elements onto the original.[83] While nonexclusive licenses can lead to widespread dissemination and enhanced follow-on R&D, these typically come with more-modest profits and increased administrative costs for university patent owners.[84] While industry-insider conversations about technology transfer tends to center around the numbers of patents owned and the amount of revenue obtained, the public would be better served by a heightened focus on a qualitative, not a quantitative, measurement: how the public stands to benefit from the patenting and licensing choices that universities make.

Faculty themselves have crucial roles to play in changing the nature of this dialogue. They can help determine what happens with their inventions. Although faculty are bound by the increasingly rigid intellectual-property policies imposed by universities, no federal law mandates that they assign their inventions to their employer, as *Stanford v. Roche* made clear.[85] Although Jonas Salk's heralded discovery of the polio vaccine in 1955 predates the passage of the Bayh-Dole Act, it provides a fitting example of the power faculty independence and decision making has to serve the public good. Edward R. Murrow asked Salk, who was a professor at the University of Pittsburgh when he invented the vaccine, who owned the patent on his invention. Salk famously replied: "Well, the people, I would say. There is no patent. Could you patent the sun?"[86]

More recently, some faculty who are dissatisfied with their institutions' patent-focused approaches to research dissemination are giving up patent protection altogether in favor of other methods of sharing promising research results. Jay Bradner, a cancer researcher at Harvard

Medical School, is a prominent example. When he discovered a molecule that, in mice, appeared to cause certain cancer cells to become healthy, he published the structure of the compound—an act that can negate the possibility of obtaining patent rights, particularly internationally—and mailed samples of it to labs around the world. He called it "the more efficient way to do science—and maybe the more honorable way."[87] Bradner's actions recognize that faculty can make important choices in how and when they publicize their discoveries, without violating disclosure obligations to their university or requiring TTO involvement.

In 2013, Brian Love interviewed a sample of close to 300 faculty members nationwide whose research focuses on computer science and electrical engineering. He found that many were deeply skeptical of their university's ability to efficiently commercialize inventions. Said one interviewee: "Most of the patent efforts at my university are motivated by the bizarre fantasies of out-of-touch administrators. These people seem exceptionally unqualified to pick between winning and losing ideas."[88] Another added, "My institution appears to be overly optimistic in its long-term estimate of the financial benefits attainable from patents."[89] Changes in institutional culture that impacted scientific progress and collaboration were also frequently noted. Very few of the faculty Love interviewed, all of whom were engaged in high-tech research, expressed enthusiasm for their university's pursuit and licensing of patents.

Fantasies about potential riches may have led to a surfeit of patents at many institutions. One estimate puts the percentage of unused (unlicensed) patents held by TTOs at 95 percent of their cumulative portfolios.[90] The Pennsylvania State University is one institution that confronted this problem. In 2014, in two separate windows of time, Penn State placed a total of 183 patents in its portfolio up for public auction.[91] Although the online auctions generated considerable interest from industry, neither auction could exactly be described as a resounding success. The first auction resulted in one license for two patents, and the second netted two licenses. Regardless, the institution should be commended for recognizing the problem of owning

too many unused patents and then approaching it head on, in a transparent manner.[92]

What the Penn State auctions revealed, in public fashion, is that higher education, as a whole, holds and maintains too many patents of questionable value. This problem stems from a further misunderstanding of Bayh-Dole, which is a belief that this law requires every university to participate in technology transfer by establishing a TTO, fully staffed with licensing associates, attorneys, and other administrators. In 2013, the median staff size for all TTOs at American universities was seven full-time employees, and the average staff size was over twelve.[93] In light of these numbers, zealous pursuit of patents by TTOs should come as no surprise. In many ways, patents are the intangible products that TTOs use to help justify their staff sizes. Patents mean job security, and only a rare TTO does not stake its future, to some degree, on the growth of its patent portfolio. Certainly Bayh-Dole provides universities with an incentive to participate in technology transfer, and society is better off because of it. But nothing in this act requires every research university in the United States to have its own TTO. All of them are costly, and most do not break even.[94]

One sensible alternative would be for university TTOs to "join forces, either in full-scale mergers or in less-than-full-scale joint ventures . . . along regional lines, within specific technological fields, or both."[95] The Ewing Marion Kauffman Foundation, which focuses its grant making and policy work on entrepreneurship and higher education, believes that such a reorganization of TTO activities could bring economies of scale to technology transfer in higher education and also encourage universities—particularly smaller ones with less research activity—to be more realistic in assessing their capabilities and limitations in this area. Additional ideas institutions of higher education could explore include establishing consortia, or clearinghouses, to commercialize faculty inventions.[96] A few institutions have put these proposals into practice. For example, WARF has an affiliate organization, called the WiSys Technology Foundation, that serves as the TTO for other public universities in the Wisconsin system located outside of Madison, and Northern Iowa University sends its

inventions to Iowa State University.[97] But so far, no major research university has been willing to join TTO forces with others of equal prominence, whether based on geographic or technological lines.

Any of these proposals, if enacted, would alleviate the pressure felt by many TTOs to focus on patent filings and income generation above all else. Exclusive licenses to innovations from publicly funded research that jeopardize the public interest but embody the hope of generating a financial windfall would probably look less attractive if universities instead could share the risks of making hard decisions that may bring less financial payoff, yet further the public good in the long run. Standing in the way of implementing any of these ideas is an entrenched TTO industry, with long-held and often narrow assumptions about what Bayh-Dole requires and aims to accomplish.

Even if every university continues to interpret Bayh-Dole as an invitation to play in a costly lottery, TTO operations could be revised to give individual faculty inventors greater voice and authority in the commercialization process. Admittedly, enhanced faculty input in this arena is no panacea, and it may lead to the same outcomes in many situations, such as an exclusive license granted to a start-up founded by the faculty member. But some evidence does suggest that TTOs stifle innovation merely by the bureaucratic procedures they set in place.

The Kauffman Foundation, the American Association of University Professors (AAUP), and the President's Council on Jobs and Competitiveness have each called for the development of a system geared toward greater efficiency and service in the public interest, and all of them support untethering institutional commercialization decisions from faculty-research discoveries.[98] These organizations argue that faculty inventors should have more freedom to decide how their university will act when these choices involve their own discoveries and those of colleagues, regardless of their societal utility or coffer-expanding potential.[99] Instead of being forced to hand inventions over to TTO administrators for key decisions, individual faculty members could be empowered to seek the best deals for licensing

their inventions and pursue funding for patent filings and the creation of start-ups. Faculty members could decide to use their own university's TTO to assist with commercialization, another university's TTO, or a for-profit service provider. Those faculty not interested in playing a greater role in the process would not have to do so, but at least the new model would recognize the individual and moral dimensions of institutional decisions involving faculty inventions. Such a system—which many call "open source" or "faculty free agency"—might actually encourage greater faculty entrepreneurship and spark commercialization, with TTOs serving in a mostly advisory capacity. Royalties would continue to flow to universities, based on their ownership of the licensed patents, but their costs and TTO involvement would be less.

The Kauffman Foundation, the AAUP, and some academic commentators have also suggested, to varying degrees, that universities should not be in the business of owning patents at all, instead leaving the ownership of patentable inventions and decisions regarding whether and how to pursue commercialization of such inventions entirely in the hands of the faculty who make the inventions.[100] Such a change would require redrafting Bayh-Dole, although these practices could be implemented more quickly with respect to inventions not funded with public money. The Kauffman Foundation argues that a system of faculty ownership would provide the best market incentives for researchers to produce work that has useful commercial applications. Instead of eliminating universities from the revenue stream coming from lucrative inventions developed on their campuses, their employment contracts with individual faculty could require that a percentage of any licensing royalties flow to the institution. Those faculty members with a record of substantial patentable activity could ostensibly negotiate lower royalty rates going to their university employer. The Kauffman Foundation sees a financial benefit to higher education institutions in such a system, which would allow them to enjoy the upside of patent licenses (namely, royalties) while experiencing fewer costs (salaries of TTO staff, related TTO overhead, and legal fees expended on patenting).[101]

The technology-transfer community has generally been unsupportive of these ideas for improvements. Its lack of enthusiasm is unsurprising, since each of these proposals, on some level, might prompt the reduction or elimination of TTOs and their staffs. Yet TTO resistance to experimentation and change provides a compelling reason to consider challenging the status quo. The Bayh-Dole Act was not passed to enrich universities or increase the size of their administrative staffs.

The point here is not to prove the absolute pluses or minuses of any of the options I have discussed, but only to announce that they exist and merit serious consideration and experimentation. Universities are hidebound in their interpretation of Bayh-Dole, mostly viewing it as a university jobs act and an invitation to engage in a lottery system. Many regard the general public as being too indifferent to and uninformed about TTO activities to lead to any real demands for accountability. Accountability starts with recognizing that using patents for the public good means engaging in a robust debate about the strategies and choices actually available to the institutions trusted to work in this sphere.

Sue U.

Patent owners are, for the most part, required to participate as named parties in any lawsuit involving an infringement on their patent. If a university has been unable to license a patent or has licensed it nonexclusively, it alone can initiate a patent-infringement lawsuit.[102] If a university has licensed its patent exclusively, then both it and its exclusive licensee need to be parties in the litigation.[103] If a university has assigned all substantial rights in the patent to a third party, only then is it relieved of any obligation to participate in patent-infringement litigation.

Patents are not self-enforcing. Accordingly, companies and individuals are free to infringe on patents unless and until a court orders the infringers to stop or they agree to cease their infringement as part of a settlement agreement. Either outcome—a court order or an out-of-court settlement—first requires the patent owner to initiate

a patent-infringement lawsuit, which is expensive for all involved. The legal bills for just one party in a patent-infringement lawsuit are typically on the order of hundreds of thousands of dollars, if not millions, depending on the potential monetary recovery that is at stake. Survey data collected in 2012 from law firms specializing in intellectual-property law revealed that for patent-infringement lawsuits with $1–$25 million at risk, the mean cost for one party to take a case through to a trial and a potential appeal was $2.8 million. For lawsuits with over $25 million at risk, the mean cost was $5.9 million.[104] With expenditures being so high, and the stakes so big, some refer to patent-infringement litigation as "the sport of kings."[105]

Pursuing litigation on a contingency-fee basis with an outside law firm is a potential cost-saving measure for plaintiffs, including universities. If a law firm takes a case on this basis, it typically receives 15–50 percent of the amount collected—but it gets those funds only if the plaintiff wins a monetary judgment from the court or receives money as part of a settlement agreement.[106] Contingency fees, long associated with personal-injury cases, are now also prevalent in patent-infringement litigation, particularly in lawsuits brought by patent trolls.[107] The notion that only patent trolls initiate patent-infringement lawsuits on a contingency basis makes some higher education institutions more cautious about pursuing these arrangements, as the manner in which a college or a university engages in litigation regarding its patents can have an impact on how others view its commercialization activities.[108]

A patent's value is inescapably tied to its litigation value.[109] Failure to enforce a patent could mean the loss of the benefits a university receives in seeking and obtaining a patent, as "the efficacy of a patent depends on its owners' ability to police their property."[110] The need to protect their investment leads university patent owners looking to generate more net revenue from research to consider patent enforcement as one option, maybe even as an obligatory one. As a director of a prominent TTO told me in 2012, reflecting on the tie between a university's assertive involvement in litigation and its pursuit of mission: "Is the act of litigation itself furthering a mission? No. I mean

litigation never furthers a mission in terms of it being something you ever aspire to do, or a real objective of the university. . . . Litigation is not one of them. But if you think about it in terms of whether it is a necessary part of protecting and advancing our research, then you come up with a different answer. . . . To me it's a necessary evil—I'll go ahead and use that word. If you're going to go forward and protect patents, the necessary follow-on to that is that you have to be willing to enforce them."[111]

Other TTO directors I have spoken with on this issue are in agreement.[112] Said one: "That's why you file patents, is to support them and enforce them. You know, big places, when you file a patent, there's gonna be infringement. It's just the nature of the beast, and there's real advantages to stepping up to the plate and enforcing it." Another concurred, stating that "the reason to get patents in the first place is to control their use in the market. . . . A patent without enforcement is a piece of paper with [former director of the USPTO] Dave Kappos's signature on it. That's all it is, you know. It's a very expensive piece of paper. I can get Dave Kappos's signature for a lot less than $30,000 [i.e., the average cost of obtaining a patent]. . . . If you're not willing to enforce it, that's all you've got."

Although many TTO directors view infringement litigation as an essentially inevitable consequence of engaging in technology transfer, several acknowledge that their university's leadership is not always receptive to pursuing infringement litigation. On the one hand, academic administrators expect their TTOs to generate revenue. On the other hand, those same individuals are not always comfortable admitting to various constituencies that they think income or commercial goals drive or should drive most aspects of their TTO's mission. One TTO director described this tension to me in 2012:

> If our mission is to get technology out there to benefit the public, one way we do that is we engage the patent system to protect it so that others will invest money. Because of that, we have the ability to exclude competitors for a limited time. You've got to buy into the notion that the way you get that monopoly is by enforcing those patents. If you don't under-

> stand that, you've missed the principle of this element of our mission. That's just the rules of the game. "You like that royalty income. We don't talk about the money. It's not about the money. But trust me, you'd like me to bring several million dollars a year more into the university." You've got to understand it comes with that price. If you're not willing to play that game, then that money isn't coming, and you won't be able to serve that part of the mission effectively. At some point, it's part of it, in my mind.[113]

While the complex union between mission and money may not be publicly declared at many universities engaged in patenting and technology transfer, an uncomfortable truth lurks in the background of many discussions about the virtues of commercialization: when revenue generation is part of a university's research mission, patent-infringement litigation is an activity that can further that mission. It may also reveal this focus on finances to others.

Enforcing patents through litigation presents complex risks and costs, apart from the capital outlays that are typically required. One risk is that a university will lose its patent rights by picking a fight in court. Defendants commonly challenge the validity of claims in patents they allegedly infringe on, and a ruling of invalidity is the death knell for claims in any patent.[114] A 2007 study showed that a more-unique risk for universities was that their involvement as plaintiffs in patent litigation led to a reduction in the amount of technology licensed by them to the private sector. In other words, patent litigation was a statistically significant distraction from filing new patent applications, executing new patent licenses, and obtaining information from faculty about new inventions.[115]

An important indirect cost of college and university university participation in patent-infringement litigation is the perception that this activity undermines their fundamental values in serving the public.[116] In a controversial 2008 article, Mark Lemley explored the provocative suggestion—proffered to him by some firms—that universities initiating patent-infringement lawsuits should be considered patent trolls.[117] Although Lemley concluded that universities are not

patent trolls when they support their own inventors and engage in socially beneficial technology transfer, his article squarely raised the concern that the frequency and manner in which universities engage in legal actions regarding their patents can have an effect on how others view their commercialization activities.

Additional indirect costs from a university's involvement in patent-infringement lawsuits come in the form of changes to its institutional culture and its approaches to technology transfer, even if these may only happen over time. For example, the University of Minnesota's involvement in a lawsuit over its patents for Ziagen, an antiretroviral drug that slows the spread of HIV, affected commercialization decisions at that institution for years to come. The predecessor to GlaxoSmithKline—the pharmaceutical company that makes Ziagen—initially refused to license the University of Minnesota's patents when it marketed the drug, which led the university to file an infringement lawsuit in 1998. The parties settled the lawsuit a year later. In subsequent years, the university received more than $350 million in royalties from the settlement, accounting for more than 90 percent of its revenue from technology transfer during that period. But with the drug's patents set to expire in 2013, the university faced what its technology-transfer professionals recognized as a "patent cliff," which had them searching for inventions and commercial deals that might soften an otherwise inevitable drop in income.[118] Habituation to a revenue stream can be difficult to break.

Enter a new variety of apple developed at the university, branded as SWEETANGO (see chapter 3). Rather than offering this apple as an open release, which would have allowed anyone to grow it without payment to the university, the university decided to release it as a managed variety, the first time that an American university had done so. The University of Minnesota's experiences with the lawsuit over Ziagen, its munificent settlement, and the subsequent patent cliff played a substantial role in its decision making regarding SWEETANGO. After all, the name of the licensing consortium the university created to manage growing rights to the apple is Next Big Thing.

Apparently mindful of some of the many consequences that can accompany university participation in patent-infringement litigation, leading institutions of higher education issued a white paper in 2007 that warned against participation in "enforcement action"—a euphemism for patent-infringement litigation—noting that any such activity "should be carefully considered."[119] The white paper—which functioned as "an act of public accountability," as David Winickoff rightfully argues—stressed that universities should bear in mind that their primary mission is to use patents to promote the development of technologies for the benefit of society.[120] The white paper's authors wrote that litigation is "seldom the preferred option for resolving disputes" and should be initiated by a university only if there is a "mission-oriented rationale for doing so" that can be clearly articulated by the university to the public.[121] They also maintained that "nuisance litigation" should be avoided in all circumstances, and that a university's involvement with companies that "rely primarily on threats of infringement litigation to generate revenue"—in other words, patent trolls—does not serve the public interest.[122] AUTM endorsed the white paper, placed it on its website, and encouraged higher education institutions to support the paper's principles by becoming signatories to the document.[123]

Four years later, a committee of the National Research Council (the operating arm of the National Academy of Sciences), after examining university intellectual-property practices, endorsed the white paper in a report it released. The committee advised that "enforcement of IP [intellectual property] rights against suspected infringers should be approached carefully to protect the institution's resources and reputation."[124] The report listed acceptable instances when involvement in litigation may be necessary—for example, "to protect the rights of existing licensees to enjoy the benefits conferred by the licenses"—but, notably, revenue generation was not among them. The committee concluded that while initiating infringement litigation is rarely the preferred method for resolving patent disputes, "it is an option important for universities to retain."[125]

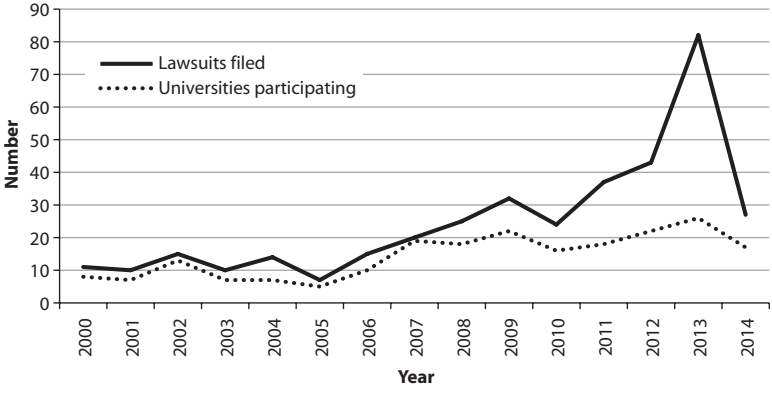

Figure 4.1. Patent-infringement lawsuits involving American universities, 2000–2014

In light of these risks, downsides, and repeated words of caution from leading sources, you might think that university patent owners seldom, if ever, choose to participate in infringement litigation. This activity is not all that uncommon, however, and it has grown significantly in recent years (figure 4.1), leading some to conclude that "there is good reason to believe that aggressive university patent assertion is here to stay."[126]

University involvement in patent-infringement lawsuits grew from just over ten cases a year in 2000 to over eighty in 2013. The decline in filings in 2014 mirrors the general declines in patent lawsuits that occurred around the same time, and it may reflect the fact that universities are experimenting with transferring their patents to third-party entities that litigate for them. These numbers do not portray the wide array of companies that universities are suing, many of which are household names. For example, the twenty-seven lawsuits filed by seventeen universities in 2014 involved forty-six different defendants, including Apple, Sprint, Samsung, Medtronic, and GE.

Some of these cases are noteworthy in their reflection of the constraints and opportunities universities face in attempting to com-

mercialize their patents. The University of California System, for example, has participated as a plaintiff in nearly twenty patent-infringement lawsuits. It made headlines in 2007 when it received $30.4 million in an out-of-court settlement to a lawsuit it and its exclusive licensee, Eolas Technologies, had initiated against the software giant Microsoft. The UC System claimed its patent, developed by a faculty member at University of California, San Francisco, provided it with ownership over the "interactive Web"—essentially the Internet as we know it. Microsoft decided to settle the case rather than continue to fight to overturn the $521 million jury verdict the UC System and Eolas had received. Eolas, a spinoff company founded by the patent's faculty inventor, was not actually in the business of making anything, which, from an image standpoint, complicated the matter for the UC System. This led detractors to label the company as a patent troll.[127] Regardless, Eolas went on to collect millions of additional dollars in licenses with other companies, using the initial court judgment and later settlement with Microsoft as leverage. The UC System received a portion of every deal.

In 2012, a jury in Texas invalidated the UC System's "interactive Web" patent in a subsequent infringement lawsuit the university and Eolas instituted against prominent technology companies Google, Apple, Amazon.com, Yahoo, and Sun Microsystems, among eighteen other household names, including Playboy Enterprises, the company that publishes the eponymous magazine. Many in the technology community lauded the outcome as a comeuppance for what they saw as the UC System's overreaching and its relationship with a patent troll.[128] World Wide Web inventor Tim Berners-Lee, who testified at the trial in favor of the many defendants, tweeted that the verdict was a "good thing."[129] I wonder how many people within the UC System were disappointed over the loss of an opportunity to continue to reap handsome financial returns on the patent through its license with Eolas, even though respected industry experts were deeply skeptical of the patent's quality and validity. A UC System representative, when asked to describe its support of Eolas, said only that the university "stands by its licensees."[130]

Another high-profile loss of patent rights for a university occurred a year earlier, when the CAFC invalidated a patent co-owned by New York University (NYU) and Centocor Ortho Biotech. NYU and the biotech firm had alleged that the blockbuster arthritis drug Humira, manufactured by Abbott Laboratories, infringed on their patent. While the jury agreed with them, the CAFC reversed the initial court finding by invalidating the patent. The outcome was notable, because the jury had awarded $1.67 billion to the plaintiffs—at that time, the highest amount in damages allotted by a jury in a patent-infringement case.

Another billion-dollar judgment was awarded in 2012, on the day after Christmas, to Pittsburgh-based Carnegie Mellon University (CMU) in its lawsuit against the California-based Marvell Technology Group. CMU had alleged that Marvell willfully infringed on a patent owned by the university, which was directed toward increasing the ability of hard-disk-drive circuits to read data from high-speed magnetic disks. The local jury agreed with this hometown institution and awarded CMU $1.17 billion, a verdict that the trial judge declined to overturn or amend in post-trial motions, noting "that there is a strong public interest in enforcing CMU's patent rights because this technology was sponsored, in part, by public funding."[131] Although the CAFC reduced the damages award to $278 million on appeal in 2015, the outcome, by almost any measure, was still a resounding success for CMU.[132]

Not every successful case results in billion-plus-dollar damages awards, although meritorious cases can still lead to significant sums. In 2008, a jury awarded Cornell University $184 million in damages in a patent-infringement lawsuit it initiated against Hewlett-Packard. The trial judge later reduced that figure to $71.3 million, and the parties subsequently settled the case, on confidential terms, while appeals were still pending.[133] In 2012, University of Pittsburgh received a $110 million judgment in its case against Varian Medical Systems, where Pitt's patent involved radiation therapy. Although the CAFC partially upheld the award on appeal, the parties ended up settling in 2014, with Varian paying Pitt $35 million.[134]

In 2013, Boston University (BU) filed thirty separate lawsuits against companies it claimed were infringing on a patent it owns for "Highly Insulating Monocrystalline Gallium Nitride Thin Films," a technology BU alleged the various defendants had used in products containing blue LEDs, such as handheld phones and tablet devices.[135] The list of over fifty corporate defendants was a veritable *Who's Who* of the high-tech world, including Acer, Blackberry, Canon, Dell, Eastman Kodak, Fujifilm, Microsoft, Motorola, NEC, Nikon, Nokia, Olympus, Panasonic, Sharp, Sony, Toshiba, and Vizio. This lawsuit came after earlier filings that same year by BU against Apple, Amazon.com, Hewlett-Packard, LG, and Samsung over the same patent.[136] Although many of these companies reached a settlement with BU instead of entering into litigation, in December 2015, a Boston jury awarded the university over $13 million in recognition of the infringements committed by three of the firms.[137]

Public reaction to BU's lawsuits touched on many of the concerns that members of the higher education community have when universities sue for patent infringement. One commenter, in response to a BU article about the cases, wrote: "I wonder if any of the sued high tech companies will be recruiting on the BU campus this year? Doubtful."[138] Another questioned how much BU spent to retain the law firm that handled the lawsuits, adding, "Couldn't this money have been used to promote the research of the faculty more effectively . . . or for scholarships?"[139]

Concerns of this nature are not completely unfounded. Companies that are sued for patent infringement have been known to stop sponsoring research at the university that sues them or, even worse, discontinue on-campus interviews of students at that university who are looking for jobs. The University of Illinois, Urbana–Champaign (UIUC), faced these ramifications in 2013, after suing Micron Technology for patent infringement. While the case was pending, Micron's manager of academic programs sent the following email to UIUC's engineering professors: "Because Micron remains a defendant in a patent infringement lawsuit that UIUC filed against Micron in Federal court in Illinois on December 5, 2011, effective immediately, Micron

will no longer recruit UIUC students for open positions at any of Micron's world-wide facilities. . . . The Micron Foundation has endowed chairs at the College of Engineering and has sponsored student scholarship and professor research. However, because UIUC's suit imposes costs and risks on Micron that are inconsistent with collaborative relationships among Micron, UIUC, and its students, Micron must regrettably indefinitely suspend its recruitment of UIUC students and likewise suspend participation in other joint activities."[140]

Because some universities—particularly public ones—are leery of asserting their patent rights, precisely because of the potential consequences if the public knows they are aggressively involved in litigation, certain ones among them are experimenting with having other entities litigate for them.[141] In such arrangements, a litigation-management company creates a special "nonpracticing entity" (NPE)—which, to some, is the same as a patent troll—in order to receive an exclusive license from the university for a previously unlicensed patent. This arrangement is not structured in the typical way, where the licensee intends to produce (or is already producing) a product covered by the patent and, in turn, generates royalties for the university from sales of that product. Instead, an NPE exists solely for the purpose of acquiring all substantial rights to the university's unlicensed patent and instigating a legal action for infringement, based on that patent. This arrangement effectively transfers university ownership of the patent to the NPE in exchange for a contractual right to a portion of any proceeds arising from litigation initiated by the NPE.

One attribute of this type of arrangement is that it removes the need for universities to participate as named plaintiffs in the ensuing patent-infringement actions. Another selling point is that it typically requires no out-of-pocket expenditures from universities, as the entire enforcement activity is either structured on a contingency-fee basis or funded by investors. Should any money result from the NPE's actions, the university receives a portion of it.

Rembrandt IP Management is one company that offers this service to universities. An advertisement Rembrandt circulated to AUTM members in July 2015 stated:

> Rembrandt University Solutions was created to help universities to unlock the value that may be hidden in patent portfolios. Rembrandt understands that the human and financial resources required for portfolio monetization are sometimes scarce at universities. Whether engaging in a review of a university's entire portfolio or investigating a single instance of potential patent infringement, Rembrandt invests its own time and capital to evaluate and diligence [*sic*] monetization options.
>
> Rembrandt partners with universities to structure deals whereby the university benefits from patent licensing and/or enforcement and can recover its significant research and development investments while freeing up the university's time to remain focused on its academic and research objectives. Once the university and Rembrandt agreed on a monetization path, Rembrandt works to recover fair value for the university's intellectual property.
>
> Rembrandt is only compensated if value is recovered. Rembrandt recognizes that each university has its own unique style and culture and works hard to align interests and to structure an enforcement and/or licensing strategy that takes into account any existing complex relationship that universities may have.[142]

You might reasonably wonder how a patent that stems from research funded with public dollars could be transferred from a university to an NPE for purposes of litigation. This concern is legitimate, and it invites a careful reading of the Bayh-Dole Act. One provision of the act places limitations on the assignment of university-owned patents. It states that universities may not assign patents developed with federal funds without the approval of the federal agency that provided those funds, unless the "assignment is made to an organization which has as one of its primary functions the management of inventions."[143] While the exception probably was drafted with transfers to established, university-affiliated research foundations like

WARF in mind, the wording of this provision in the act does not seem to preclude its application to NPEs created for the express purpose of managing inventions by instigating patent-infringement lawsuits. Because many of the largest NPEs tout that they are in the business of managing inventions, universities have relied on this ambiguity in the law to justify their involvement with companies like Rembrandt IP.

The 2007 white paper urged universities to be cautious in dealing with patent aggregators, stating that institutions of higher education "would better serve the public interest . . . by requiring their licensees to operate under a business model that encourages commercialization and does not rely primarily on threats of infringement litigation to generate revenue."[144] Yet various sources report that many universities are turning to threats of enforcement that are initiated by proxies, becoming "less choosy about their partners" as they attempt to "get academic research out of the ivory tower—and to make money."[145] For example, in a study of the patent holdings of Intellectual Ventures—the largest patent aggregator in the business, with rights to at least 30,000 patents—Tom Ewing and Robin Feldman found that 5.3 percent of the company's patents came from nearly fifty different universities, including the University of Texas System, the University of Rochester, the University of New Mexico, the University of Florida, Duke University, the University of California System, the California Institute of Technology, Brigham Young University, and the University of Alabama.[146]

Intellectual Ventures later confirmed that it handles patent licensing—brought about through threatened and actual litigation—for sixty American universities in twenty-six states. Around the time of this revelation, news leaked out that AUTM, as an organization, would be revisiting with its membership the principle from the 2007 white paper that urged universities not to traffic with patent aggregators. By way of an explanation for this about-face, the director of the association told the press that "there's been a lot of change in the tech-transfer offices—a lot more scrutiny, a lot more expectations; the financial meltdown resulted in a lot of the offices being smaller

and having shifting priorities."[147] Others who had a role in drafting the white paper failed to express any concern, noting only that the white paper's principles were suggestions, not requirements. Times change and, apparently, so do values.

As these stories help illustrate, university involvement in patent-infringement litigation raises important questions for the public. From a university's perspective, initiating legal actions regarding the patents it owns may advance its research interests and result in substantial revenues that can be used for various noble purposes. But what about other perspectives, of the taxpayer who helped fund the research, or students and faculty at the university that resorted to litigation? Does a university that sues companies for having allegedly eroded its private rights jeopardize its graduates' job prospects at those companies? What about the ability of its faculty to receive sponsored-research funding from the defendant companies, or of the institution itself to successfully solicit donations from the employees and executives of those firms? What effect does university patent enforcement have on lawmakers who are already inclined to second-guess an institution's request for increased appropriations in the face of state budget deficits? More fundamentally, what message does such an activity send to society about the nature of higher education, which is supposed to work in the public's interest?

It is no secret that universities have progressively embraced the pursuit of revenue-generating activities, particularly ones that involve their faculty's intellectual output. This focus is perhaps inevitable in light of growing resource constraints. Universities, after all, are the wellspring of many groundbreaking and patentable ideas, and institutional decision makers have long since set in motion the necessary internal levers and policies to capitalize on them. In one sense, lawsuits over the ownership and authorized dissemination of these ideas are foreseeable. But comfort with the increasing prevalence of assertive university litigation over patents should not eclipse the consequences of this activity.

None of this is to suggest that universities should never initiate legal actions over patents. The bleaker point is that occasionally they

may have to, if they prize innovation above all else and work to become what Arizona State University president Michael Crow calls "comprehensive knowledge enterprises," looked to as a means of spurring regional economies and creating jobs.[148] Their Cold War approach of stockpiling patents, in hopes that licensees will come calling while would-be infringers retreat, is rightfully on the decline. But as policy makers aim to align university research agendas more closely with those of for-profit actors, what once could be described as university-centered "technology push" is being transformed into industry-driven "market pull."[149]

As part of this transformation, administrators and policy makers need to consider that at some point, furthering the much-celebrated concepts of commercialization, entrepreneurialism, and innovation may require unabashed and unapologetic patent enforcement, and that a decision to litigate can bring irreversible consequences. Nonetheless, patents do not come with their own police forces, and institutions of higher education too hesitant to enforce their rights may find that inactivity only invites further infringement, undermining the very commercialization partnerships and investments they seek. Yet hoped-for income must be counterbalanced against the immediate costs of litigation, as well as the harder-to-quantify, more-invidious changes it can bring to a university's internal culture and the public's external trust.

Research shows, however, that universities are not as well equipped to engage in patent enforcement as you might expect, given these past involvements.[150] Despite the growth of and support from organizations like AUTM, which are devoted to professionalizing the university technology-transfer sphere, a uniform strategy, approach, or conceptualization of patent enforcement has failed to emerge among those institutions that participate in these actions. Many decision makers at universities that have participated in patent-infringement litigation in the past are deeply ambivalent about its tie to their institution's mission, yet they strongly believe that their particular universities are likely to instigate lawsuits again. Despite this near-certainty of future participation in an activity that is costly, time consuming,

and often controversial, essentially no university professes to have developed frameworks, policies, or sufficient budgetary reserves that would reflect a mature preparation for deciding when and on what terms to engage in patent enforcement. Even more regrettably, most turn outward to industry instead of upward to academic, presidential, or board leadership for guidance on an activity of clear policy importance.[151]

More than thirty-five years after the passage of the Bayh-Dole Act, most universities, instead of being seasoned players, are still learning to litigate. They may be poorly equipped to pursue such legal actions and might have mixed feelings about it. Yet for universities, participating in a global knowledge economy and driven by intellectual-property concerns, litigation may be evolving into something of a mandate. Nonetheless, their success with licensing their patents already has proven to be dubious, while higher education's facility at using patents as swords in the expanding frontier of patent enforcement is still embryonic.

The pressures and uncertainties universities face in obtaining and enforcing patents are consistent with those of global entrepreneurial capitalism in general, an arena increasingly dominated by exceptionally powerful firms whose success in legal actions is often predicated on vast resources and resolute commitment. The importance of patent litigation in the global political economy is such that it is not unreasonable to think of patents as constructs, where the ideas for them come from faculty inspiration and perspiration, but which are too often made real only by costly and prolonged litigation. Patent enforcement is a particularly perilous space for organizations that are small, nonprofit, or dedicated to the public interest. Yet, in greater numbers nearly every year over the past fifteen years, universities throughout the country aspire to capitalize on their patents through litigation.

The appropriate follow-up question is, should they be doing so? This, for the most part, is uncharted territory for the leadership of research institutions. Involvement in assertive litigation is qualitatively different from the risk-minimizing prevention of and defense

against lawsuits that university attorneys have practiced for decades in realms outside of intellectual property. When litigation shifts from being a cost of doing business to a part of doing business—and, conceivably, to *the* business of patent ownership—the frail concept of a university as a disinterested agent for the public good arguably suffers yet another, perhaps irreversible, alteration. Even for institutions that can effectively compete for revenue under such intense market conditions—and not all can—the costs are high, including dollars spent on legal actions; challenges to their mission, their public image, and society's trust in them; and political and other capital lost amid the backlash from companies sued by higher education institutions.

The uncertain and mixed prospect for success through lawsuits should motivate university leaders to assess how serious their institutions can be in chasing infringers. The risks are severe. Few institutions have millions of dollars to spend on one case, or sufficient income to support the projects of faculty members stripped of outside funding when their university sues a research sponsor for patent infringement. In short, it becomes difficult to enforce patent rights on principle, unless their enforcement is considered a central factor in the university's overall mission. Fortunately, not all universities take such an approach, nor should they. Yet in the status hierarchy of global higher education, rank-and-file institutions will struggle to be realistic about their capacity to enforce patents, given the allure of financial rewards and the establishment of enforcement norms by elites in the field. For those few institutions that have the financial and other resources to enforce their patents effectively, dispassionate pursuit and participation—similar to the litigation norms of for-profit actors—appear to be the inevitable approach, in light of what a patent is: a government-granted right to exclude.

But patent enforcement reconciles awkwardly with higher education's historical role: the production and use of knowledge in the public interest, locally, nationally, and globally. While the research mission in contemporary world-class universities may encompass significant patent litigation, the public that supports higher education

might soon come to expect full disclosure and transparency concerning such actions. Market models for generating assets and protecting their value inevitably run counter to traditional conceptions of higher education, as Rembrandt IP's advertisement helps demonstrate. Similarly, the historical approach to university decision making—plodding, shared, and collaborative—is in marked contrast with the fast-paced, high-stakes norms of litigation itself.

Reconciling these competing interests is difficult to do under existing legal structures, as it should be. On the most fundamental of levels, there is no denying that colleges and universities help make the world a better place—although probably not by ardently or slyly suing alleged patent infringers.

Universities and Patent Reform

The patent system in the United States has been the subject of major attention in recent years. Starting in the early 2000s, the U.S. Congress considered various reform proposals. Concerns for the rise of patent trolls, the issuance of "business-method patents," and the patent application backlog at the USPTO motivated these efforts. After several years of debate over whether and how to reform the patent system, Congress passed the Leahy-Smith America Invents Act (AIA) in September 2011, marking the first major overhaul of the U.S. patent system in over sixty years. One of the goals of this legislation was to strengthen confidence in American innovation.

The bill that eventually became law attracted both vocal supporters and detractors within the higher education community. AUTM lobbied in favor of the bill, along with the Association of American Universities (AAU), the American Council on Education (ACE), the Association of American Medical Colleges (AAMC), and the Association of Public and Land-Grant Universities (APLU). These organizations argued that patent quality would improve under the new law, thereby increasing industry confidence in the patent system and fostering commercial development and job creation.

A handful of universities and their TTOs openly opposed the bill, however, arguing that it favored large companies at the expense of

higher education institutions and individual inventors, whose efforts to cost-effectively obtain, maintain, and enforce patents would, they believed, be jeopardized by the bill if it became law. WARF—the oldest and perhaps most venerable TTO in the nation—led this opposition, joined by the University of Utah, the University of New Mexico, and nine other universities.[152]

Despite these critics, whom I believe were largely correct in their assessment, the bill ultimately passed into law with little Congressional opposition. President Barack Obama hailed it as a set of productive measures that "cuts away the red tape that slows down our inventors and entrepreneurs."[153] While the new law contains many important, substantive changes, three are of particular relevance to university patenting and licensing efforts, and they provide a reason to question whether higher education's support of the AIA was really in that sector's best interests.

One, the AIA makes the United States a "first inventor to file" country. Prior to this change, patent rights were awarded to the initial person to invent the subject matter described in a patent application, meaning that a first inventor ultimately could obtain a patent even if a second-in-time, independent inventor filed a patent application for the same invention before the initial inventor submitted an application. This feature of the domestic patent system differed from foreign patent systems, which typically award patents to the first inventor to file.

While the new law brings the United States into conformity with foreign systems, the race to the patent office that the new system created is at odds with the traditional priorities of faculty, who typically face pressures to publish, not patent. Under the new system, waiting to file a patent application until after a publication about the invention comes out carries the risk of someone else winning the race to file an application with the USPTO. Also, publication, or even mere public disclosure of research results, will eliminate a university's ability to obtain a patent if the publication or disclosure is not followed by a patent application within one year. While firms have the ability to monitor laboratory notebooks and prod their employees, uni-

versities are not as competitively positioned to ensure that all potentially lucrative intellectual property is treated as such and claimed, due to academic freedom, publishing expectations for faculty, and higher education norms.[154] All of these realities impose greater burdens on universities and most likely will change academic culture to more closely follow the patenting behavior of for-profit companies.

Two, the new law establishes additional processes through which parties can challenge the validity of issued patents apart from costly and time-consuming litigation in federal court. One such process is known as post-grant review and can be used to contest claims in patents that were granted from applications filed on or after March 16, 2013.[155] The other process is called inter partes review (IPR), which became available for use on September 16, 2012. Prior to the AIA, parties that wished to challenge the validity of an issued patent could do so only by initiating a costly lawsuit in federal court and/or an expensive and protracted reexamination procedure at the USPTO. Under the new law, third parties gain these new, cheaper weapons to invalidate patents. While a post-grant review must be started at the USPTO within nine months of when a patent is issued, an IPR may be begun at any time after that, as long as it happens during the life of the patent. In a post-grant review proceeding, the USPTO will cancel any patent claim found to be invalid for failure to meet any condition of patentability. The standard of review is more limited for IPRs, where the USPTO only considers issues of novelty and nonobviousness. For either process, the time period from initiation to decision is twelve months, which is generally much faster than resolving patent-validity questions in federal court.

Time will tell how these new features of the patent system are used. Early data provide some reasons for concern, however.[156] As of June 2015, USTPO records show that fifty-two IPRs had been initiated against university-owned patents, involving at least sixteen American institutions.[157] Defense against these actions creates a burden for universities, and the very industries that frequently license university patents—such as pharmaceutical companies—are

the ones most likely to challenge the validity of those patents. By doing so, companies may delay or prevent the licensure of those patents, thereby injecting greater costs and uncertainty into the university technology-transfer process. As a result, prospective licensees may refuse to license university-owned patents either until nine months and one day after their issuance, regarding them as "presumptively invalid" before that period (that is, open to being invalidated during those first nine months, although this is not certain to occur), or until the patents are actually challenged in an IPR. This added delay could wreak considerable havoc on universities, which typically lack the capital (or access to capital) available to other patentees.[158]

The additional financial pressure of possibly having to defend newly issued patents at the USPTO is likely to reduce the instances where a university does not license a technology until a patent has been granted, or at least it may prolong the time between when a patent is issued and when that technology is licensed. Prospective licensees, acting from a rational economic perspective, may prefer to gamble that the patent will be invalidated in a post-grant review or IPR proceeding, rather than willingly enter into a license without first challenging the patent through one of these two means. Royalty rates are likely to be driven down because of this bargaining leverage.

A related possibility—and one that AUTM and many TTOs seem to think is a positive feature—is that the expense and uncertainty post-grant reviews and IPR proceedings create for universities will cause them, when developing a technology, to identify and partner with prospective licensees much earlier in the life cycle of the technology than they have previously done. Yet this change, to the extent that it materializes, could endanger the public good. Exclusive licenses—which TTOs should not favor, in part because they can hamstring a university's ability to disseminate new technology as widely and cost-effectively as possible—may soon become more prevalent than nonexclusive arrangements, which require institutions to take a more active role in protecting and enforcing a patent.

By engaging in exclusive licenses before patents are issued, universities effectively acquire a funded ally to share the risk of possible

patent-invalidation challenges. Even though licensees, under prevailing law, can challenge the validity of a licensed patent at any time, the prospect of them taking such an action diminishes if universities (as many are doing) seek to build lasting, long-term relationships with industry sponsors by entering into early-stage deals that convey tacit knowledge and know-how beyond what may be described in the patent itself.[159]

Three, the AIA greatly expands the ability of third parties to submit documents for the USPTO's consideration while a patent application is pending. This provision is aimed at improving the quality of issued patents. Under the old system, the USPTO typically did not accept third-party submissions during its review of patent applications. Accordingly, little opportunity existed for the USPTO to review documentation shared with it by concerned parties that potentially could have rendered an application ineligible for patent protection. This provision of the new law, expanding the opportunity for third-party submissions, is likely to lead to an increase in the legal fees required to obtain a patent, as attorneys for applicants will have to respond to third-party challenges. These challenges could prove problematic for universities and other small entities whose budgets for legal fees related to patent filings are already constrained.

Years will elapse before we fully understand the AIA's impact on universities. At first glance, however, the changes I have identified provide ample reason for concern. Universities are likely to spend more money chasing and defending patents in the costlier new system, and they will face pressures to turn to exclusive deals with industry in order to help foot the bills. In addition, the new rules create an environment that rewards speed, which has never been higher education's forte—nor should it be. Yet for institutions that wish to be competitive in the new legal landscape, long-standing academic norms that prized scholarly deliberation and publications over patents risk being jettisoned, out of a perceived necessity.

Given these potentially deleterious consequences, why did the higher education lobby support the AIA?[160] To answer that question, I first need to delve further into the macroscopic effects that the AIA

will have on higher education. One reasonable and positive assumption is that the AIA may lead to a decrease in university involvement as plaintiffs in patent-infringement lawsuits. Procedures such as third-party submissions being allowed while patent applications are examined, post-grant reviews, and IPRs now provide more opportunities to prevent patents of dubious quality from being approved, and for the public to challenge already-issued patents. Patent claims that emerge from these processes intact should represent strong patents. Thus, while the AIA may impose new burdens and delays on universities as they seek patents, those they succeed in obtaining and defending may be perceived as more legitimate, and therefore less likely to invite others to make use of a patented invention without paying a license fee.

But if university leaders believe that their institutions are less likely to become involved in costly and mission-diverting patent litigation under the new system, they have not expressed that belief. Just the opposite has occurred, as they are very concerned with maintaining their ability to participate in patent-infringement lawsuits. Recent efforts by AUTM and the higher education lobby to oppose legislation intended to curb the practices of patent trolls demonstrates this thinking—or lack of it.

Shortly after Congress enacted the AIA, scholarly and other commentators complained that the new law actually does very little to deter the abuses of trolls, which, unfortunately, are all too common in the patent system. Some studies showed that for the first time in America's history, the majority of lawsuits filed by patent holders were filed by trolls, not legitimate operating companies.[161] Another study claimed that patent trolls cost the U.S. economy more than $500 billion over a twenty-year period.[162] News outlets could hardly keep pace with the stories of mom-and-pop shops and other honest enterprises being forced out of business, due to the onerous licensing demands of patent trolls made in the context of actual or threatened litigation.

Congress set about fact finding and holding hearings in 2013, intending to enact additional changes in the patent law that would erect

litigation burdens for trolls. Major businesses like Google, Oracle, and Verizon all came out in support of proposed legislation aimed at curbing trolls. Yet, instead of joining these companies in supporting the proposed legislation, several prominent universities and higher education organizations collectively spent over $10 million to lobby *against* such bills.[163]

This seems improbable, at first. Why would universities, whose main functions involve teaching and research, not assertive litigation, be opposed to legislation intended to deter the harmful practices of patent trolls? The draft legislation would essentially raise the stakes for those who initiate frivolous litigation. Under one proposal, if a plaintiff loses its case, the judge would have the discretion to make the plaintiff pay for the defendant's legal costs and other expenses related to the lawsuit if the court determined that the plaintiff engaged in troll-like behavior by bringing the case to court. This proposal, which would be unique to patent law, goes against the "American rule" of litigation, which dictates that every party pays for its own day in court, win or lose, except in extraordinary circumstances. The proposed legislation would recognize a patent-troll lawsuit as an extraordinary circumstance, meriting judicial discretion.

When weighing their options, this legislation might dissuade all patent holders—including universities—from filing infringement lawsuits. But because industry often views universities as "toothless tigers" with respect to enforcing their patents, any law that causes these institutions to second-guess a decision to engage in legal action is a law that the higher education lobby incorrectly thinks hurts its constituents. As a writer for the *Washington Post* put it: "Any legislation that reins in patent trolls is also going to reduce the licensing revenue that universities can generate from their patents. But that's not a sign that patent reform is a bad idea. Rather, it's a hint that some universities' aggressive patent licensing efforts are inconsistent with a university's broader mission to promote the public interest."[164]

Perhaps the leading explanation for higher education's perplexing and even Pyrrhic positions on matters of patent reform involves the practical politics between the players involved. Patent law is notoriously

complex, and entities like the AAU, ACE, the AAMC, and the APLU—the cadre of higher education lobbying organizations whose offices are near each other on Dupont Circle in Washington, DC—are not primarily concerned with its inner workings. These organizations have other areas of policy interest and expertise, including governmental funding for higher education, access to higher education, and diversity in higher education. These groups therefore defer to AUTM, a national organization that acts in favor of TTOs, for policy guidance regarding patent reform. Unlike the other higher education lobbies, AUTM's members are in the trenches, so to speak, where patent law meets practice in higher education.

AUTM, though, is not primarily comprised of faculty inventors, or even vice presidents of research who come from academic backgrounds. Instead, the overwhelming majority of the organization's members are midlevel business professionals within a university's administrative hierarchy. Most do not have academic appointments or standing. They typically do not teach classes, and they are not subject to faculty research or writing requirements. Many come from industry and intend to return to industry. Therefore, many of them approach patent reform from the mindset that what is best for industry is best for higher education. For these reasons, AUTM is more accustomed to looking toward industry for policy guidance on matters of patent reform—in particular to the Biotechnology Industry Organization (BIO), which is a frequent ally of AUTM on related issues. BIO promotes its own industry-focused lobbying agenda, however, not universities' best interests. Some insiders have suggested to me that BIO's upper hand permitted the organization to express the following ultimatum to AUTM leadership at the outset of the patent-reform efforts: walk in lockstep with us in the halls of Congress, or we will walk all over your patent rights.[165]

Whatever the nature of the quid pro quo between AUTM, BIO, and the higher education lobbies, politics, like misery, makes strange bedfellows—and, in this instance, resulted in legal and policy positions that compromise the performance and integrity of higher education's research mission.

Private Rights, Public Goods

Technology transfer is an active area of contestation and reconstruction in higher education. For more than thirty-five years, the Bayh-Dole Act has been interpreted as a mandate for universities to engage in a process that organizations like AUTM have an interest in portraying as formal and set, with a fully staffed TTO office on every campus taking center stage.

Nonetheless, universities have more options than many of them historically thought regarding how best to harness the power of faculty inventions in the public's interest. The Bayh-Dole Act does not require exclusive licensing—which primarily leads to the creation of private benefits over public goods—nor does it mandate that faculty assign the rights to their inventions to the institution that employs them, as Supreme Court precedent makes clear. It does not even demand that universities seek patent protection on faculty inventions, only requiring these institutions to do so if they choose to retain ownership of a faculty invention funded with federal dollars. Nor does Bayh-Dole address how universities handle research discoveries that are not funded with federal dollars.

Despite these realities, AUTM has dismissed certain ideas as being inconsistent with the Bayh-Dole Act, such as permitting faculty to turn to TTOs outside their own university for assistance in commercializing their inventions, or having universities achieve economies of scale by forming licensing consortia around specific technological skills or geographic areas. Bayh-Dole does not prohibit any of these arrangements, yet the misconception persists that it does.

Regarding patent litigation and patent reform, what is good for BIO and its industry partners is not necessarily good for higher education. History has shown that assertive patent litigation is not a game that this sector is well suited to play. Such actions also tend to place universities in awkward positions with respect to the public trust, and conscientious TTOs feel ambivalent about this activity, because of its incongruence with the academic values of openness and detachment from the marketplace. For these reasons, we should question

higher education's decision to oppose efforts that might dampen institutions' desires to initiate legal actions. Patent litigation is costly, time consuming, and comes with risks that are unique to higher education. Instead of becoming more zealous in their support of BIO, the higher education lobby should be urging legislators to recognize that higher education is, by design, different from industry, and patent laws should be rewritten to be more sensitive to those differences. The focus of university research should be on innovation, not litigation.

In short, we should expect more from our public-serving institutions of higher education, always questioning whether a licensing deal that is lucrative for a university is concomitantly rewarding for the public. As part of this scrutiny, decisions to retain ownership over and subsequently patent any faculty member's discovery that has implications for public health, welfare, and safety should be carefully considered, as should any litigation. In the realm of patenting and commercialization, universities face more choices than many want the public to think they have. With higher education placing an increased emphasis on commercialization, its leaders should be forthcoming about how patenting and licensing decisions further, and do not frustrate, the public's interest. They should be willing to abandon patent efforts and relinquish rights when no public good can come from them.[166] More than anything, university leaders must resist the temptation to adopt narrow and inflexible views on the role of patents in advancing higher education's goals of fostering knowledge production and dissemination, in their many forms.

Amid these challenges and conflicting forces, the overriding dilemma for universities lies in maintaining their historic allegiance to the public good through research and technology transfer, while they also become more deeply entwined with the marketplace and explore market-influenced approaches to patent protection, licensing, and enforcement. As negotiation continues over the boundaries of public and private in university technology transfer, all those committed to higher education as a sector serving the greater public good must ask where these changes and developments will lead. Successful

negotiations typically result in a compromise—all parties give in a little. For proponents of conserving the public interest within university patents, perhaps the most salient questions are what do we hope to maintain, and what are we willing to lose? On that note, a warning issued by the editor of the *Journal of the American Medical Association* in the 1940s still serves as a haunting challenge: "The monopoly of a patent carries with it grave public responsibilities. In the scramble for patent rights, it is no profit to a university to gain the whole world and lose its own soul."[167]

Chapter Five

Copyright on Campus

Designs on Your Design

Mitch Harris was an undergraduate student at Virginia Tech University in 2014, majoring in industrial design.[1] Like many students drawn to this major, Harris is handy, and a tinkerer. Luckily for Harris, Virginia Tech is noted for its architecture and engineering programs. The 3D printer that the school had in one of its industrial-design laboratories provided Harris with ample opportunity to put his creative mind to work.

Harris's handiwork bore fruit in the form of a new design for an iPhone case, meant to enhance the quality of "selfies," or self-portraits taken on the phone's camera. Prospective purchasers took notice of the product at a social-media conference Harris attended, where he displayed a prototype and began taking preorders for sales. Encouraged by the market potential for this new case design, Harris soon had plans to form a company that would manufacture and sell it.

Then Harris heard from Virginia Tech Intellectual Properties (VTIP), the university-affiliated entity in charge of licensing intellectual property generated at that institution. VTIP expressed concerns about Harris's purported ownership of the new iPhone case. VTIP mentioned that Harris's use of the school's industrial-design laboratory—specifically, its specialized equipment, like the 3D printer—brought the product design within the university's permissible claims to ownership under existing intellectual-property policies applicable to all students. Whether the product was eligible for patent protection was beside the point; any original, nonfunctional

aspect of the design is copyrightable, as is the corresponding software file that tells 3D printers how to create the object.

Harris did not dispute using Virginia Tech's laboratory—after all, he was an industrial-design student at the university, the very type of person Virginia Tech presumably wants to encourage to use such equipment. Nor did he dispute that Virginia Tech's intellectual-property policy applied to him as a student, even though he had never read it or been made aware of it. But these facts did not change the reality: Harris was caught off guard by VTIP's position and the university's ownership stake in student works. Before long, Harris shelved his dreams of commercializing the product. As he put it, "If you get all tangled up in all that stuff, it's easy to get distracted and then you lose that momentum, and sometimes it can just downright kill your project."[2] He cited the university's intellectual-property policies as going against the institution's call for more innovation.

Fortunately for future designers and entrepreneurs like Harris, Virginia Tech's new president oversaw a change in the institution's intellectual-property policy shortly after this incident.[3] The policy now specifies that products built using Virginia Tech equipment presumably belong to students, provided that whatever they create was not done as part of paid work for the university. A news report stated that this change came "during a surge in student businesses based from products that have ranged from apps to items such as watch straps, flavor dispensers, greeting cards, and a smartphone case invented to improve selfies."[4]

Students at other colleges and universities may not be as fortunate. Intellectual-property policies at many institutions are far from clear or consistent in their application to works created by students, leaving them to wonder whether their institution—to which they pay tuition dollars—may be able to lay claim to their next great idea, including ones generated in the classroom.

These seeds of doubt have been planted, even as students on modern campuses become increasingly entrepreneurial.[5] The reasons for this intensified, business-oriented activity are diverse: low barriers to market entry; cheap Internet access; wide availability of data

storage and publishing software; awareness of high-profile, student-turned-entrepreneur success stories; and, for better or worse, a growing societal focus on entrepreneurship as an important skill, one worth cultivating.[6] Many colleges and universities have responded to these developments by actively encouraging student entrepreneurship: entrepreneurship classes and requirements within many schools (such as schools of business or engineering) and majors; business-plan and idea-promotion competitions that provide funding to winners; the creation of business incubators for student enterprises; and, generally, a heightened awareness of the value and potential of student-generated intellectual property, nearly all of which—to the extent that it is original and fixed in a tangible medium of expression—is subject to copyright protection.[7]

Amid these trends, 3D-printer technology—which enables users to envision and then actually create products of all kinds, from paper clips to car engines—has emerged as a source of creative confusion for some institutions. Colleges and universities are recognizing the ability of 3D printers to enhance the educational experience of undergraduates. Many are creating and investing significant resources in what are called "MakerSpaces," or facilities that contain 3D printers, laser cutters, machine tools, workbenches, and other materials that enable students to design and build prototypes and models, whether as part of classroom assignments or on their own time.[8] Even some community colleges are part of this trend.[9]

An incident in 2014 involving 3D-printer technology and Augustana College shows why student fears about intellectual-property overreach by institutions are not misplaced. This private liberal-arts college in South Dakota owns a replica of Michelangelo's statue of Moses, given to the college in 1971, that it displays on its campus. A local resident, Jerry Fisher, took photographs of the statue so he could hone his 3D-capture skills and attempt to recreate the statue using a 3D printer.[10]

This innocuous photographic activity—which may seem like a quintessential example of a college serving an educational purpose, even for nonstudents—took an unfortunate turn when Fisher began

documenting his progress on his Twitter feed and Google+ account. Augustana College contacted him, stating that it owned the copyright for (intellectual-property lawyers would say "owned copyright in") the Moses statute, even though the original was created by Michelangelo in 1515, and any faithful reproductions of it, like the one Augustana owns, are not protected by copyright. Regardless, the college demanded that Fisher destroy all CAD files associated with the 3D object and contact anyone who had downloaded the files, requesting that they delete them. Although Fisher complied with Augustana's request, the incident serves as a chilling example of what is possible when institutions misunderstand copyright law, their own policies involving copyright, and the application of copyright law and policies to new technologies.[11]

As 3D technology and the MakerSpace movement develop, more student-entrepreneurship projects risk being put on hold or shelved entirely, like Mitch Harris's was, due to intellectual-property policies that lack clarity or inappropriately purport to broadly apply to student activities.[12] Yet, despite the growing interest in student entrepreneurship, not enough concerted attention is being paid to copyright-ownership questions emerging in this new climate, where institutions often claim ownership over works that should be owned by faculty or students. Seemingly gone are the days when Bill Gates, then an undergraduate student at Harvard, made free and liberal use of specialized computer equipment in Harvard's Aiken Lab, all without the university ever staking a claim to his intellectual works.[13] Higher education is now in competition with its own students and faculty regarding their creative output, claiming ownership or fighting for royalties when the prospect of revenue is on the line.

This chapter examines university interest in copyright from the standpoint of ownership, which often receives less academic and popular attention than issues over the fair use of copyrighted materials in higher education, such as employing them in traditional face-to-face or online classrooms.[14] After providing background on the legal mechanisms that affect the ownership of copyrightable works created in institutions of higher education, the chapter examines the

recent and troubling phenomenon of corporate sponsorship of classrooms and the copyright-ownership problems these arrangements bring for students. It also explores the opportunities and challenges that come with digitization trends in higher education, focusing in particular on copyright issues in the context of digital-humanities projects and special-collection materials in campus libraries.[15]

Copyright Ownership and Use in Higher Education

Of the multiple intellectual-property principles and rules discussed in this book, copyright is the most central to the day-to-day functioning of higher education. Every course of instruction involves the use of tangible and intangible materials, many (if not most) of which are subject to copyright protection. Students, faculty, and staff—essentially all the people who are a part of higher education—produce and interact with copyrightable and copyrighted materials every day. Copyright relates directly to perhaps the two most-prominent of higher education's goals: to educate students through teaching, and to produce scholarship and research that benefit mankind. All of these acts involve creating and using original works of expression, fixed in tangible media. In short, you cannot separate the centrality of copyright from the essence of higher education.

The 1976 Copyright Act, which went into effect in 1978, fundamentally altered the copyright landscape in the United States, including in higher education. Gone were certain formalities that served to push works into the public domain if those requirements were not rigorously followed. Instead, copyright-registration particulars were relaxed under the new law, effectively widening the array of works subject to copyright and extending the duration of their protection.[16]

The 1976 Copyright Act also served to clarify certain areas of the law that had previously been unaddressed in statutes. These niches had become the subject of doctrine created by judges (rather than through legislation) prior to the new law going into effect. One of these areas concerned work made for hire, or the principle by which employers own original output created by their employees within the scope of their employment (see chapter 2). Work-made-for-hire

precepts stand in contrast to the default presumption of copyright ownership, which is that the author of a work is its owner.

Prior to the passage of the 1976 Copyright Act, scant attention was paid to the question of whether faculty, as opposed to their institutional employers, owned the copyright for their scholarly works. While the 1909 Copyright Act contained a work-made-for-hire provision, custom, tradition, and a few older cases—including from other national contexts—suggested that a "teacher's exception" to employer ownership of copyrights existed. As recently as 1969, a state court in California embraced the idea that faculty, not their college or university, retained ownership of their intellectual output.[17]

The rationale behind that decision—which proved to be rhetorically if not legally influential—was that faculty are not like the rank-and-file employees that commonly exist in the business world. Faculty members determine their own working hours (with the concept being that any time they engage in thinking, they are working), set their own research agendas, and produce written materials that may or may not further their employers' interests, although, in a broad sense, colleges and universities require their faculty to engage in written work—most notably for tenure and promotion purposes. For these reasons, corporate ownership of scholarly output struck most who considered the issue as unworkable, and even unpalatable.

Unfortunately, the common-law-based teacher's exception was not expressly codified in the 1976 Copyright Act. This omission set the stage for the emergence of what I call the "ownership question" in higher education after the act's passage: should college and university professors be presumed to own the copyright for their scholarly output, or is such work subject to institutional ownership, as work made for hire?

An initial group of academic commentators, writing in the 1980s, concluded that the teacher's exception to the work-made-for-hire doctrine did not survive passage of the 1976 Copyright Act.[18] Bolstered by a few post-1976 court cases that waffled on the issue, subsequent academic commentators challenged their colleagues' prior conclusion, and groups such as the American Association of University Professors were eager to state that faculty own the copyright

for their works.[19] By the dawn of the twenty-first century, however, no compelling legal or analytical reason had emerged to overturn the fact that full-time faculty are employees, not independent contractors.[20] As such, most legal scholars agree that the works faculty create in the course of their employment are subject to institutional ownership.

Whether institutions have any interest in owning copyrights for faculty-generated works of scholarship is a different matter. An early empirical examination into copyright policies existing at research universities across the country revealed a variety of approaches to the issue, all of which persist to this day.[21] Some institutions say nothing about copyright, allowing the legal presumption of institutional ownership to apply. Others proclaim outright their ownership of faculty copyrights. The majority of institutions, however, have policies somewhere in between these extremes. Many have formulated detailed policies that purport to cede the ownership of copyrights back to faculty yet claim copyright ownership in other instances, typically when the "substantial use" of university resources is involved, or when faculty are paid to create specific works for their institution.

Policies of this sort are problematic on multiple levels. First, if the law dictates that institutions own the copyright for works created by faculty in the course of their employment, the only method by which those copyrights can be transferred back to faculty is through individually signed transfer agreements between institutions and their faculty.[22] General policy statements that faculty possess the copyright for their own works are nonbinding legally, as they do not amount to an effective transfer of copyright. Second, "substantial use" or "substantial university resources" are terms of art that often lack precise meaning, with many policies intentionally leaving the terms ambiguously defined.[23] Third, these institutional statements about copyright typically cover faculty and some staff, but they do not always address students. When they do, the policies sometimes contain overly broad or ambiguous statements about the definition of "student" or the circumstances when a student's copyrightable work is

subject to ownership by a college or university. An individual's receipt of funds—whether through research grants, financial support for participation in competitions, or on-campus work—is one common method of claiming ownership.[24] The use of institutional equipment or facilities that results in copyrightable creations is another. Other policies go so far as to state that the college or university, by default, retains all rights to students' work, or that, as a condition of enrollment, students grant their institution a royalty-free license to use their works for noncommercial purposes. Each of these scenarios presents the possibility that a college or a university might own a work that a student creates while still a student, or at least have a license to use that work long after the student has graduated.

The reality of this complicated landscape of staking out claims to rights has proven to be confusing to some faculty and students. Faculty may find that these policies provide little clarity in situations where they seek to use digital tools in their courses and research. In those instances, the potential value of a faculty member's work, and use of institutional equipment to create it, can open the door for a college or a university to claim ownership. This confusion is compounded because some institutions are now taking unusual positions regarding copyright ownership in other, presumably clearer-cut contexts. For example, in 2012, an organization in Missouri called the National Council for Teacher Quality (NCTQ) sought to compel the University of Missouri to disclose the syllabi for all courses taught by faculty at the university, using Missouri's open-records law, or "sunshine law." You might think that if a college or university ever were to lay claim to owning copyrightable work created by a professor, it would be for items such as syllabi and final exams, which institutions require professors to create as part of their job duties as instructors. The university denied NCTQ's request, however, taking the position that individual faculty, not the university, own the copyright for their course syllabi. The university claimed that it could not be compelled to produce the requested syllabi because the sunshine law exempts material otherwise protected by law. The Missouri Court of Appeals upheld the university's position in a decision handed

down in 2014.[25] One lesson to be drawn from this case seems to be that institutional positions on copyright ownership can vary to suit competing needs, such as blocking access to information that state law otherwise permits.

Students are also often caught by surprise over how their institutions view copyright ownership. On the one hand, colleges and universities actively encourage students to be entrepreneurial. On the other hand, ambiguities can exist in institutional intellectual-property policies, so students are not entirely certain who owns the rights for their copyrightable works, even ones emanating from the classroom. Questions often exist as to whether such policies even apply to students, either as a matter of wording (that is, if the policies are silent or ambiguous on their application to students and student employees, or even on what is meant by a "student") or as a matter of contract law.[26] For students looking to secure outside funding for businesses they may wish to form around their intellectual property, such uncertainties may trouble prospective investors, leading to delays and roadblocks that can deter the very entrepreneurial spirit that institutions otherwise wish to cultivate in students.

These concerns are not hypothetical. In 2009, students at the University of Missouri at Columbia won a business-plan competition sponsored by the university's school of journalism. The winning student team developed an app called NearBuy, designed to match students looking for housing with those in the area willing to provide it.[27] This app was immediately successful and generated over 250,000 downloads on Apple's App Store. The university's attorneys initially took the position that under applicable intellectual-property policies at the institution, the university was owed a 25 percent ownership stake in the company and two-thirds of any profits. The students were dumbstruck. As the student entrepreneur behind the app told a reporter at the time: "We were incredibly surprised, and intimidated at the same time. You're facing an institution hundreds of years older than you, and with thousands more people. It was almost like there were no other options than to give in."[28]

Fortunately, the University of Missouri eventually relented and decided to revise its intellectual-property policy, as it applies to students, because of this situation,[29] but similar issues continue to arise on campuses across the country. For example, in spring 2014, students at the University of Texas at Austin expressed concerns over whether the university owns their intellectual property. The intellectual-property policy at the University of Texas System (UT) was unclear, they said, regarding its application to nonemployee students. Fortunately, administrators took notice of the issue, and a task force was convened to look into it.[30]

Nonetheless, disagreement over the policy's meaning seemed to exist at the highest levels of the UT administration. A 2014 news article quoted UT's vice president for research as saying that nowhere did the policy indicate that students' intellectual property belongs to the university. He then added: "But what it also doesn't say is intellectual property developed by nonemployee students does not belong to the board. That's what we need."[31] The University of Texas at Austin's provost took a different position in an interview with the same member of the media, stating that the policy is "that the University can claim ownership of intellectual property that is developed by students."[32] When high-level administrators within the same prominent institutional system cannot say with certainty whether the intellectual-property policy applies to their students, is it any wonder that students feel their own entrepreneurial endeavors might be discouraged?[33]

A group of concerned students in Virginia have formed an organization called Students for Intellectual Property Rights to lobby state lawmakers to take an interest in this very issue.[34] Other lobbying efforts are underway at the federal level.[35] These groups believe that the lack of clarity in institutional policies concerning student intellectual property is inhibiting some students from pursuing entrepreneurial ideas. As one student in Virginia remarked: "It's kind of a stigma for student entrepreneurs to start companies. . . . Why start a company if 40 percent of it is going to be gone?"[36] Even if

universities take the position that they are willing to bargain with students and relinquish an institutional ownership claim in whatever the students produce, the broader question is whether students should even be placed in the position of worrying whether they have less than full rights to the ideas and work they generate in the course of their own education.

Company in the Classroom

The question of student copyright ownership is particularly acute for works that students produce as part of class assignments, whether in traditional courses, integrative capstone courses, independent-study courses, or service-learning projects. In many instances, institutions and third parties allowed into the classroom may have claims to student work generated in that class. These arrangements can serve to repress the free exchange of ideas in the classroom, turning pedagogy on its head as classrooms become more like competitive, winner-take-all start-up companies than traditional environments dedicated to every student's learning.

For example, in 2015, the *New York Times* published a story about undergraduate students at Harvard enrolled in an engineering course in which they were asked to create "a technologically sophisticated barbeque smoker that could outperform the best product on the market and be sold for less than $1,500."[37] Guest visitors to the course included high-level executives from Williams-Sonoma, the kitchen- and home-goods company, who expressed interest in eventually carrying such a product in their stores. The course's professor and its teaching fellow came up with the concept for the new product, and the students were to make it viable. The students created a prototype of the barbeque smoker, as well as a smartphone app that can monitor and control its temperature. Harvard immediately sought to protect the product and its related app using patents and copyrights, and two of the students involved in the course formulated plans to start their own company to sell the product.

Industry involvement in certain courses has also become prevalent, in the form of a sponsored course. Course sponsorship entails

companies partnering with college or university faculty by providing them with actual data that students are asked to analyze in the classroom. Sponsors review the students' written and oral analyses, often acting as judges of final team projects and presentations.[38] While these arrangements occur across fields, certain disciplines, like engineering and business, use them more frequently than others. Regardless, course sponsorship by corporations occurs at both undergraduate and graduate levels.

While the faculty and sponsors for such courses tout these arrangements as bringing invaluable real-world problems inside the campus walls, many sponsors seek to own the intellectual property resulting from the projects, presenting onerous copyright-assignment and confidentiality agreements for students to sign as a condition of their enrollment in the course. For example, in the field of engineering, a recent study found that over 50 percent of sponsored courses require the transfer of at least *some* student intellectual property, either to the institution itself or to the course sponsor.[39] Colleges and universities (and/or their faculty) all too often sign off on these arrangements, placing the desires of the course sponsor above the intellectual freedom of their students.

Compromising the academic freedom of the students involved is one obvious concern that these arrangements bring. Compounding that worry is that many times, students are required to complete these courses in order to receive their degree—that is, these courses are not optional, elective offerings. As one adjunct professor familiar with these arrangements told students, "Your cost of being part of this capstone project—for which you paid tuition—is giving up your intellectual property."[40] In addition to stipulating that students do not own the copyright for original works they create involving a sponsoring company's information—copyrights that otherwise would be owned by the student authors—the onerous agreements sponsors require students to sign often contain additional provisions (such as warranties, indemnification, and confidentiality clauses) more suited to business-to-business transactions than they are the unique learning environment of higher education.

Some institutions, like the Pennsylvania State University, have developed policies, which are conveyed to students, to address what they see as the "special situations" involving company sponsorship in the classroom:

> Situations may occur in certain courses (e.g., SUBJ 296, 496, 596, 295, 395, 495, and 595) where students are presented with the opportunity to participate in projects or activities in which the ownership of any resulting intellectual property *must be assigned* either to the University or to a sponsoring entity (such as a company) *as a condition of the student's participation*. Students are never obligated to participate in projects or activities that require the assignment of the student's intellectual property to the University or to another entity. In these situations students will always be presented with two options: (1) to participate in projects or activities that do not require the student to assign their intellectual property or (2) to participate in projects or activities that require the student to assign their intellectual property.
>
> The student's grade and/or evaluation of performance in the course will not be affected by the student's decision to participate or not to participate in projects or activities requiring the assignment of the student's intellectual property.
>
> Students should understand that the assignment of intellectual property is a binding legal agreement and that they have the right to seek independent legal advice at their own expense prior to signing this agreement. Students may obtain free legal consultation through the Division of Student Affairs.[41]

A similar scenario exists at the University of Washington (UW), where students may or may not own the intellectual property that they create in courses, depending on the restrictions imposed by individual sponsors. In 2015, the vice-provost for innovation at UW touted the so-called choice available to students as a good thing, saying that students can proceed according to their own "comfort level."[42]

If student entrepreneurship is to flourish on modern campuses, students should not face the prospect of their institutions condoning

or effectively requiring them to assign copyrights to the sponsors of their coursework. When this occurs, inquiry for the sake of learning takes a secondary position to inquiry for the sake of pleasing the sponsor. In considering their constrained options regarding copyrights, students may hold back their best work, knowing that the sponsor will only capture and claim it if the student writes it down. Even policies like Penn State's and practices like UW's, which purport to offer students a choice, are misguided. The higher education classroom should not be constructed as a business unto itself, where every student must be vigilant about entering into agreements with their university or with corporate classroom sponsors—agreements that are often likely to be negotiated at less than arm's length, where the parties involved are not on an equal footing. Can faculty be trusted to be impartial in grading the work products of students who agree to sign away their intellectual property, particularly if, by *not* signing it away, the students create more work for their teacher, in terms of the professor coming up with assignments or being the sole person responsible for grading them? What about the impact of peer pressure between students? Human nature would seem to suggest that many are likely to sign away their rights without fully understanding the impact of that decision, if only to conform with perceived norms and peer expectations.

For creativity, innovation, and an entrepreneurial spirit to truly thrive in higher education, students must be free to engage with others inside the classroom and out without any concerns or doubts about the ownership of their intellectual fruits belonging to their college, university, or anyone the institution has allowed on campus or into the classroom. Similarly, their full participation in the classroom should never hinge on or be compromised by their agreement to assign copyrights to a third-party sponsor of the course.

Some have suggested that course sponsors should be offered or are fairly entitled to a full, royalty-free, nonexclusive license to any student's work or invention that results from their course sponsorship.[43] This argument is faulty, however. If course sponsors are interested in the works produced by students in the course, let them

negotiate with students independently for rights to those works, paying them appropriately. Any agreement the parties reach is likely to be cheaper for the sponsor than attempting to internalize the R&D costs without relying on student intellectual labor. Additionally, leaving this issue for individual colleges and universities to decide as a matter of institutional policy is no better solution. Student intellectual freedom is a concern likely to be discounted or forgotten when faculty and prospective course sponsors—who may also be viewed as prospective donors to a college or a university—exert pressure on that institution. Nor can faculty be trusted to police the boundaries of corporate influence in their classroom, particularly when providing corporate access is only going to make their job easier, as well as potentially leading to additional perks from the sponsor.[44] In this instance, anyway, when the academic freedom of faculty is pitted against students' academic freedom, students should win.

Of all places in society, the higher education classroom should be a safe site for student innovation. Consulting an intellectual-property attorney should not be a burden that we expect students to shoulder before enrolling in a course, entering a university-sponsored competition, using campus resources, or accepting a paycheck for campus work.

Digital Dilemmas

Higher education has always been a site of enormous dynamism and innovation. In the past ten years, the quality of digitization and related computer technologies have added to this, opening new avenues for scholarly exploration. The mass digitization of books by Google, including unique ones located only on the shelves of campus libraries or in their archival collections, has broadened our understanding of what is known and knowable. While copyright impediments initially threatened to block such developments, court decisions in 2013 and 2014 effectively resolved the issue by ruling that mass-digitization projects, even of works under copyright, can be considered fair use, depending on how portions of the digitized works are used and displayed.[45]

These technological and legal developments have paved the way for new forms of scholarship that rely on the digitization of works under copyright. Scholarship in the humanities used to entail the detailed study of selected works. A scholar might have spent a whole lifetime attempting to achieve a comprehensive understanding in a limited field or fields. Memory and time served as common impediments to achieving that goal. Now, with digitization technology and the various endeavors making use of it, scholars can glean insights from the study of several million works in the larger archive of literary history.[46] One example is a large-scale analysis of texts to determine the year in which written uses of the singular in reference to the United States ("the United States is") first outnumbered plural uses ("the United States are"). That year was 1879.[47]

The new avenues of knowledge opened up through digitization are remarkable. "Digital humanities" has become a shorthand phrase used to describe the use of software and digitization technologies to create new, Internet-based methods of and formats for teaching and learning about the humanities.[48] Drawing on technology centers, visualization labs, and computational tools, these efforts often bring science and "big data" to the humanities—for example, performing computational and statistical analyses of a text to determine if word-use patterns and frequency can link an anonymous work with a known author—thereby unlocking new avenues of research and inquiry for students and professors alike. Data mining, text and network analyses, and data visualization are common methodologies used in digital-humanities projects.[49]

Once regarded as a passing fad, or the narrow province of specialists, information technology (IT) developers, and librarians, the digital humanities is here to stay. As a 2015 article about the phenomenon put it, today "historians, philosophers, and poets not only are learning how to use tools to conduct analysis for their work; they also are building collections, developing their own tools, and constructing platforms."[50] Most creators of digital-humanities projects intend for the public at large—not just students and scholars—to use and benefit from these projects. If institutions do not already

have a digital-scholarship center to promote these activities, they may soon. As such centers are established, common concerns include everything from the practical (who will provide the content? who will fund it?), to the legal (how will rights to the content be cleared and handled?), to the technical (how will these projects be preserved and their integrity maintained for future generations?).

Vivid examples of digital-humanities projects abound. At Washington and Lee University, a research team has created a website that allows users to search for, locate, and study the graffiti of the early Roman empire, from the cities of Pompeii to Herculaneum.[51] Students actively participate with professors in the creation of the project, traveling to Italy in the summer to locate graffiti, photograph it, and enter related data into a software program created for this project.[52]

Students were similarly involved in the creation of "Valley of the Shadow," one of the first digital-humanities projects in the world, started by Edward Ayers at the University of Virginia, before he moved to the University of Richmond. The project entailed digitizing primary-source documents from two nineteenth-century American towns—one in Augusta County, Virginia, the other in Franklin County, Pennsylvania—in order to give online visitors realistic portrayals of life in those places during the Civil War and its aftermath.[53] Resources used in the project included newspaper articles, letters, diaries, church records, tax records, maps, images, and statistics, all of which allow users to see and understand the evidence that fuels this scholarly analysis.[54]

Other digital-humanities projects focus on such humanistic topics as the spread of American slavery into the borderlands between the United States and Mexico between 1820 and 1850, the lives and works of Albert Einstein and Walt Whitman, and the history of women at the Seven Sisters colleges.[55] Some digital-humanities projects are faculty initiatives that accompany their books, while others are born as digital projects.[56]

Whatever the project, the copyright fair-use question, when applied to these initiatives, raises complicated issues, as these efforts

frequently entail using copyrighted works, or works whose copyright status is unknown (for example, in the case of found objects or of "orphan works," which are under copyright, but where the copyright owner is unknown or cannot be located), in new contexts. While we would hope that the ways in which these uses are reshaped qualifies them as fair uses, resolving that question with certainty can be difficult, particularly given that these projects are, by design, widely accessible to anyone with an Internet connection. With uncertainty over the fair-use issue in mind, many digital-humanities projects intentionally involve dated materials (for example, from the Civil War, or antiquity), where any copyright protection has long since expired if it ever existed. Even if the material used for the project is more recent, often it comes from a special collection at a college or university library (for example, the Seven Sisters project), where the rights to use it for digital purposes may be defined in the deed of gift signed by the donor. Finally, even for those works that are in the public domain, new uses of them in digital-humanities projects can lead to copyright claims by the creators of the project and/or the institution sponsoring the project.[57]

The copyright-ownership question for digital-humanities projects is complicated, too. Collaboration across disciplines, institutions, and groups—as well as interactivity using "the crowd," or the general public—is considered a hallmark of digital-humanities projects.[58] The collaborative aspect of digital-humanities projects helps sustain interest in and value for these works, as faculty across the world who are involved in them incorporate these projects into their courses and research. Collaborative writing, translating, and editing, as well as sharing data and content, are what make these projects so exciting. Researchers are able to work together, unencumbered by geographic distance, to bring new insights and understandings into areas of scholarly interest.[59] Meaning and value literally are co-constructed in these digital spaces, often with faculty, librarians, and IT personnel working side by side on projects. As the head librarian at Brown University commented about digital humanities in 2015: "This is the future of libraries. As the core infrastructure for scholarship, librarians will

work side by side with faculty and students through all steps of the research process, including the selection and management of resources; the analysis, documentation and design of findings; and the dissemination and preservation of scholarly works."[60]

Part of the allure of digital-humanities projects is that they challenge the traditional notion of scholarship being "written by experts for experts."[61] Students are also frequently involved in these initiatives, whether for class credit or through their outside-of-class work with professors, as are university staff members. Boundaries between official titles like "student," "faculty," and "staff" tend to blur in digital-humanities projects, allowing students to make contributions to final products that are greater in scope than the contributions they might offer in more-traditional classroom settings. In fact, digital-humanities projects are often characterized "by faculty building collections, librarians doing research, and students wandering free between content consumption, content creation, and content management."[62] But as one recent investigation noted: "Issues related to the use and abuse of student labor creep into the classroom. Using student labor in the classroom may violate the social contract of higher education."[63] The use of student labor may also raise copyright-ownership issues, particularly if the students make original contributions to these projects—for example, through original written text or photography—and their work is not subject to a separate agreement with the project's directors.

One example of a student-driven digital-humanities project is Infinite Ulysses, which University of Maryland student Amanda Visconti created as part of her PhD program in English.[64] The site contains an electronic version of *Ulysses*, the famous work by James Joyce noted for its many allusions that may be obscure for uninitiated readers. Visconti's site allows users to highlight passages and leave interpretations and annotations that can be read and responded to by other viewers. Visconti found her university's intellectual-property policy unclear in her situation. Typically, universities do not claim ownership over student dissertations, but hers was not the typical dissertation. Would the university make any claim to it because it

was funded, in part, through a university fellowship, or because she utilized specialized campus equipment to create it? After weeks of emailing administrators trying to find out, she never received an answer, one way or another.[65]

Whether students participate in these projects alone or in collaboration with faculty, many of the same concerns can arise, as often these projects are funded, in part, by the institution or rely on special laboratory and equipment space for their construction and maintenance. With respect to faculty and staff, participation in these projects may raise questions not squarely addressed in existing intellectual-property policies. Are digital-humanities projects "courses"? Are they "traditional scholarship"? If the answer to either question is yes, then many institutions cede their copyright claim to the faculty member as a matter of policy. The answer to those questions as they pertain to most digital-humanities projects, however, is no—the project may be used in a course but is not itself a course, nor is it a book or a journal article—and that can lead to attendant worries for faculty.

To date, digital-humanities projects have largely occurred on the campuses of well-funded research universities, although private liberal-arts colleges are becoming involved in these projects as well.[66] As educational institutions (of all sizes) and funding agencies take laudable steps to support digital-humanities activities—financially, and through the dedication of campus space and equipment to enable work on these projects—they must make clear how the ownership question is to be answered in these contexts. Faculty experimentation with digital humanities should not lead to fears or worries about provoking a copyright battle with the institution. Nor should students shy away from these initiatives, not knowing if faculty or institutions will lay claim to their contributions. Instead, copyright concerns must be overcome, so that the promise of digital humanities can be realized.

An outgrowth of digital humanities, also posing its own dilemmas, is the use of valuable special-collections materials housed in campus libraries. Libraries commonly acquire and maintain special collections containing objects of great artifactual and monetary value. These items often are singular, or rare, or exist in a special physical

format.[67] Special collections can be sites of rich scholarly activity, and libraries are turning to the digitization of special-collections materials as a means of increasing access to them, while also helping to preserve these valuable objects for the use and enjoyment of future generations.[68]

Copyright issues involving special collections can be maddening, as the rights surrounding each collection, and the individual objects within the collection, may be different, based on the terms of their donation and acceptance, as well as the copyright status of the underlying works themselves. Copyright may prevent many uses of special-collections materials online, as well as prevent the creation of derivative works, such as apps that incorporate the material. Donor restrictions that exceed the limits of copyright may work to the same effect. Even institutions themselves may inappropriately lay copyright claims to unoriginal reprooductions of special-collections materials otherwise in the public domain, or seek to equate ownership of a particular object with the right to dictate how and when information gleaned from that object, including imitative digital copies, are used.[69] Despite all these issues, donations to special collections are on the rise.

Unreasonable copyright claims and related restrictions impede the ability of the higher education community to incorporate special-collections objects into digital scholarship and teaching. This rights impasse undermines the ability of students, faculty, and the public to receive the full value of these artifacts by making unrestricted use of them. Libraries—in particular, campus libraries—have traditionally been viewed as "unchanging sources of communal memory."[70] The notion that libraries are storehouses of information and important instructional artifacts goes to the heart of higher education's existence in the public sphere, as a robust site of culture and knowledge. These institutions collect and catalog all kinds of physical objects—such as books, papers, letters, journals, art, and musical recordings—much of which may be under copyright protection at the time of their acquisition. Other objects and works are donated to a college or a university by alumni, faculty, corporate benefactors,

and other friends of the institution. In accepting these items for storage and preservation, librarians make important decisions that are tightly entwined with the library's—and, by extension, the university's—existence as a site of public memory and meaning.

Because of historical problems with collections that involve undocumented accessions, many institutions of higher education now have official gifts policies that address such issues as who within a college or a university is authorized to accept gifts on behalf of the institution, as well as how institutional commitments concerning the storage, display, and use of the donated objects should be addressed.[71] The Association of Research Libraries has even created model deeds of gift for academic libraries to use in accepting donations to their special collections and archives. Yet much historical material of great value that is maintained by libraries was not acquired in such a formal fashion, meaning that many institutions have an abundance of material that was accepted with minimal formalities and inadequate documentation.[72] Disputes involving this class of material occur on a periodic basis, typically when institutions attempt to deaccession, or remove, these items from their collection, or digitize them, or otherwise do something with them that the original donor, that person's heirs, or the general public finds objectionable. The deeds of gift may be nonexistent, or key terms in them may be ambiguous. Yet some institutional staff and faculty may still reasonably believe that educationally sound justifications exist to digitize the collection or to deaccession certain works. The vexing question that college and university librarians often face in these circumstances is one identified in a 2013 *New York Times* article: "How do you adhere to a donor's wishes when they seem to interfere with the best interests of the institution?"[73] On the one hand, institutions do, or should, want to increase access to these materials. On the other hand, donors often prize control over access to the materials they have given.[74]

A common basis for donor and library-staff concerns or objections is rooted in copyright law. The 1976 Copyright Act makes clear that the transfer of a physical object containing a copyrighted work does not convey ownership of the copyright, which can only be transferred

in writing, signed by the one relinquishing the rights.[75] The object may come to be owned by the library through a deed of gift, but acquisition through donation does not mean that the institution automatically owns any copyright for the donated object. This distinction provides sufficient room for worry and contention in subsequent years, particularly if the deed of gift makes no reference to intellectual-property rights. Does an institution, as the owner of the object, have an implicit license to display the work online, or to lend it widely to patrons at other institutions?

Any doubts over questions like these tend to be resolved in a conservative fashion, with institutions declining to make the object as broadly accessible as they would otherwise be permitted to do if they were certain about the nature of any copyright the object contains. As one librarian concluded in 2012, based on interviews with relevant stakeholders, there is a "reluctance to undertake digitization projects because of uncertainty, and a tendency to select only the safest and most homogenous collections" for digitization.[76] This reluctance leads many to avoid undertaking digitization projects that would benefit the scholarly community, instead opting to pursue safe projects that bring little risk, but perhaps less value, to the knowledge commons.

Another basis for objections is that an institution's use of an object violates donor-imposed restrictions, which can serve to limit the public's access to the objects. Common restrictions of this sort include dictating who can see or touch the gift, requiring a vetting process, or even prohibiting access to the gift by anyone other than library staff for a period of years.[77] Although institutions often defend their acquiescence to such terms on the basis of respecting donors' wishes and privacy, these practices can work to the advantage of donors—who can receive tax benefits for their donations—at the expense of the public.

Library staff may also feel compelled to balk at certain uses of an object, or information contained in an object, even if the institution does not own the copyright for it. These objections may stem from a misunderstanding of copyright, a perceived need to comply with a

donor's wishes or restrictions, or simply a desire to control the uses of an object. For example, in 2014, the special-collections library at the University of Arkansas attempted to block a local newspaper from accessing the university's special collections. This action accompanied a claim by the librarian that the newspaper had violated the university's intellectual-property rights by publishing a story based on audiotapes held in the institution's archives.[78] The audiotapes in question contained interviews of Hillary Clinton, and the newspaper had used the recordings to report information about the politician that her supporters found unflattering.[79] When the newspaper challenged the university's action, the institution admitted that it actually did not hold the copyright for the audiotapes, and that the copyright holder—a veteran Arkansas news reporter—did not object to publication of the audio excerpts.

Aside from occasional misunderstandings of copyright law, or willful decisions to ignore it, institutions also face mounting obstacles from heirs and estates that seek to enforce draconian copyright provisions in the decedent's bequest, or exploit ambiguities in the relevant documentation that prevent colleges and universities from providing full and unfettered access to their special collections. Some wealthy higher education institutions, like Yale University, are willing to expend significant staff time and resources to digitize old works—such as 16 mm and 35 mm films, and audio tracks on magnetic-tape reels—even when that institution does not own the copyright for those works, and the donor's estate will not permit it to make those newly digitized materials available online.[80] Colleges and universities with fewer resources may not be able to take these steps at all, or feel that the terms of the donor's gift prevent them from doing so.[81] Despite the existence of technology that could protect special-collections materials from degradation and enable wide access to the materials online, the majority of these collections remain in print format only. Even as recently as 2015, a Yale librarian confessed that much of what Yale owns is in print form, not digital, in part because Yale has a lot of special-collections material and "it's going to take a long time to digitize everything."[82]

Having the capability to digitize aside, questions of copyright ownership often obstruct a college's or a university's efforts to make their special-collections holdings widely available. In instances where the quality and longevity of the physical object may be at risk, we would hope that the object could be digitized, preserved, and made readily accessible. But the copyright-ownership issue can work to place the onus of preservation on institutions, without providing immediate and concomitant benefits to the public. Patrons can see these collections in person, but full access to them by anyone with an Internet connection may be a long time coming, given the duration of copyright law.[83] Donor restrictions imposed by a contract can even outlast the protections provided by a copyright, potentially hamstringing an institution's ability to provide wide access to important works that otherwise should be in the public domain.

The existence and continued growth of valuable special collections in academic libraries across America challenges higher education's ability to fully serve the public. Copyright restrictions, and colleges and universities prizing commitments to donors over access by the public, all too often stand in the way. Library special collections hold vast potential to fuel the productive trends that have come from digitization, if only we can clear the way for such activity. Faculty are the very people who should be turning to special collections and helping to make them accessible and alive for new generations of students, scholars, and the public. Engaging in digital-humanities scholarship, and developing projects such as scholarly apps that incorporate these works, are leading methods for achieving those goals. Entrepreneurial students themselves could even play leading roles in these efforts.

In short, colleges and universities should view facilitating faculty and student access to special-collections materials, using the tools of digitization, as falling within their educational and research missions. If a goal of higher education is to serve as an open and robust sphere of culture and knowledge, then scholars, students, and library staff must be permitted—even encouraged—to use technology to help bring special-collections materials out of the bowels of libraries and

into the public domain online, for all of us to have access to and learn from.

Private Rights, Public Goods

Modern college and university campuses hold great potential to serve as robust cultural and knowledge commons, where students, faculty, and staff freely interact with each other and with informational resources in ways that lead to the creation of new forms of scholarship and knowledge, broadly conceived, that benefit social and economic development.[84] Society's trust in higher education is based on its making these contributions and granting more weight to the commons over institutional or private pecuniary gain. The creative capacity of this sector's human resources (students and faculty), its abundant artifactual resources (articles, books, works of art, and other objects of intellectual value, often housed in campus libraries), and higher education's historical norms of openness, sharing, and the disinterested pursuit of knowledge provide colleges and universities with a unique capacity to add to our collective storehouse of information.

Yet, despite the promise of higher education as a cultural and knowledge commons, copyright law and related campus policies all too often frustrate student and faculty innovation, serving to impede the flow and diminish the value of their cultural and knowledge outputs to society. Instead of finding higher education to be a site of unfettered intellectual vibrancy, many students have come to realize that their own college or university views their work products as being subject to institutional or third-party ownership. Faculty face similar incongruences, as a lack of clarity in college or university policies or institutional overreach both undermine what should be regarded as clear rights of ownership regarding faculty creations, whether curricular or extracurricular. Even a campus library—an essential site for higher education's cultural and knowledge commons—is all too often highly regulated, a place where copyright and related restrictions prevent students and faculty from making full use of the artifacts that should be viewed as shared resources.

Dampening the inventive and entrepreneurial impulses of students by clouding ownership claims to their intellectual output turns higher education into a competitive and closed sphere, where exposure to any campus resource becomes laden with potential claims to rights by the institution itself. This guarded atmosphere invariably invades the classroom, as we are witnessing with the corporate sponsorship of and intrusion in courses, sending the message to students that all areas within higher education are subject to contests over rights, pitting students against the very entities that they are paying, and entrusting, to provide them with an education.

In terms of digital technologies, as vital copyright-ownership questions either go unaddressed or invariably are resolved in favor of the institution, the space available for creative freedom and open exchanges in higher education becomes constrained. The awarding of a summer research grant, the creation of a project applicable to teaching and scholarship, or the use of campus equipment and resources should not provide a college or a university with a hook on which to hang a copyright-ownership claim. Faculty should be free to pursue research interests and digital commercialization opportunities wherever they may lead, without fear of inciting an ownership contest from their institution once a project becomes popular or successful. Society benefits when the intellectual talent that is the raison d'être of higher education can fully employ that talent in digital projects accessible to wide audiences, free of institutional-ownership claims.

Students and faculty, as core members of the higher education community, enjoy the freedom and the obligation to use artifactual resources for the benefit of humanity, and donors often give their valuable objects to colleges and universities so society may benefit from them. Library special collections exist as a form of in-house expertise that ought to be freely available for exploration and use by higher education's privileged members, whose job is to make knowledge come alive for the world. Wherever possible, colleges and universities should be prohibited from erecting or observing discretionary copyright barriers in artifactual resources, so scholars may bring special-collections materials out into the open. The concept of higher education serving

as a fount of knowledge, not just a warehouse for it, demands that students and faculty enjoy a near-unencumbered ability to make use of institution-owned information for society's benefit. Freedom of inquiry and innovation suffer when institutions use copyright as a means of overly controlling and restricting their human and artifactual resources. In short, if higher education is to advance the public interest as a cultural and knowledge commons, in most instances, students and faculty must be viewed as having copyright claims that take precedence over potential claims by their colleges and universities.

Fulfilling higher education's promise as a cultural and knowledge commons is possible, but this will require implementing new copyright rules and norms that champion openness, the rights of individuals, and creative freedom over institutional claims to and restrictions of rights. The difficulty of this proposition lies in instilling in colleges and universities a commitment to the qualities and practices of a cultural and knowledge commons, a concept that runs counter to current copyright activity both within and outside of higher education, where everything intangible that can be owned, tends to be owned.

Chapter Six

In Pursuit of Brand: Names, Domain Names, Images, Slogans, and Secrets

A Bear of a Brand

Baylor University in Texas is not bashful about enforcing its brand. The institution boasts over 14,000 students—making it modestly sized compared with other college campuses in Texas—but it certainly punches above its weight when it comes to brand formation. Just ask John Stipe. Stipe is an alumnus of Baylor who had a dispute with his alma mater. In 2007, he registered BAYLORBEARSSUCK.COM, along with four other domain names incorporating the Baylor mark, "with the intention of creating a social networking website akin to MySpace for Baylor University students and alumni."[1] Baylor was not happy when it learned of the existence of these registrations. The first notice Stipe received of this unhappiness was when his alma mater initiated an arbitration action against him, using the uniform domain-name dispute-resolution policy (UDRP) to challenge his rights to register the domain names. Stipe had twenty days to file a response. As he put it: "It went straight to the lawyers. They didn't offer to help me or to buy the domain names or anything. Lawyers are not cheap, so why do you pay a lawyer to present documents and file papers on someone? Their response was over 100 pages."[2]

Stipe attempted to persuade the arbitration panel that using the BAYLORBEARSSUCK.COM domain name in a manner critical of Baylor University should be considered protected noncommercial speech. The arbitration panel, however, reasoned that "there is no indication that in this case the domain name is being used or at any

time was being used for such a purpose."[3] The arbitrator ordered that ownership of the five disputed domain names be transferred from Stipe to Baylor.

Although Baylor University won its battle with John Stipe, we might ask whether, in doing so, it provoked an unnecessary and damaging war. Thirteen days after losing the arbitration action, Stipe purchased five additional domain names incorporating "sucks" and "Baylor" in various extensions. He then stated, in text displayed to visitors at those domain names, that "I purchased these domain names to expose the tactics Baylor University used in order to take the [other] domain names from me." As he later expressed to me: "I played by the rules. I lost the case, and they said the web sites were not used as a free speech thing, so I said 'Fine, I'll show you,' and I made it free speech."[4]

On the main webpage displayed at the domain names he purchased after losing the arbitration action, Stipe took aim at what he saw as Baylor's precocious brand sensitivity. He claimed that the university, in an effort to stifle criticism, owned at least seven additional domain names—not subject to the arbitration action it filed against him—each of which contained "sucks" and "Baylor" in some configuration. In addition to questioning the propriety of the university's ownership of the other domain names and speculating about the amount of legal fees Baylor University must have expended in the arbitration action it brought against him, Stipe described what he viewed as the unfairness of the university's online brand-enforcement strategy:

> I question why Baylor University chose to take my websites from me, but allow others to have theirs. BAYLORBEARS.ORG was registered on Jan. 29, 2001, and is owned by a person in New York. BAYLORBEARS.MOBI was registered on Oct. 7, 2006, and is owned by a person in South Carolina. And while Baylor University was fighting me for my names, on Feb. 29, 2008, a person in Germany purchased BAYLORBEARS.INFO. Or how about SICEMBEARS.ORG that was registered on Jul. 25, 2007, to someone in California? . . .

> I would also like to point out, which goes unanswered by Baylor University officials, why is BAYLORFANS.COM allowed to exist for the last 9 years? Baylor owns BAYLORFANS.ORG, but does *not* own BAYLORFANS.COM or BAYLORFANS.NET. Further, Baylor does not own INSIDEBAYLORSPORTS.COM, which has existed since 2003, but Baylor owns BAYLORSPORTS.COM and BAYLORSPORTS.NET.
>
> It is interesting that the Baylor lawyers were arguing trademark violations in order to take my names from me when it is quite obvious they pick and chose who they want to go after. It is going to be interesting to see what Baylor University does with the names they took from me without compensation. We already know what Baylor University will do with the BAYLORBEARSSUCK.COM, but the truth can be told in BAYLORBEARSSUCK.NET, BAYLORBEARSSUCK.ORG, BAYLORBEARSSUCK.US, BAYLORBEARSSUCK.INFO, and BAYLORBEARSSUCK.BIZ[5]

Stipe's dispute with Baylor University speaks volumes about the new era of brands in higher education. In addition to serving as a cautionary tale for institutions that wish to capture domain names with an expressive character similar to BAYLORBEARSSUCK.COM, the arbitration action against Stipe also stands as a vivid example of the consequences that can come from brand-enforcement efforts. From a reputational standpoint, the university must wonder whether its enforcement action against an alumnus was worth the negative reactions it incited.[6] More than six years after the UDRP was decided, Stipe's domain names still existed and were being used to display speech critical of Baylor, potentially drawing attention that was disproportionate to the concern that motivated university action in the first place.[7] To be sure, time heals some wounds, but not all. Stipe told me in 2014 that he probably would continue to renew the registrations for the domain names he registered after losing the BAYLORBEARSSUCK.COM arbitration, even though he no longer cared about the issue all that much.[8]

The university's dispute with Stipe also calls into question what institutions like Baylor hope to gain through a Whac-a-Mole-type

approach to online brand enforcement. This book's appendix contains the array of domain names that Baylor has sought through arbitration actions—130 and counting—which is staggering, both in number and variety. Baylor no longer owns many of these domain names, even though the university prevailed in arbitration actions that awarded their transfer to Baylor, and many that Baylor does still own are not being effectively used at all—that is, they do not display an active webpage when visited.

While defenders of Baylor's enforcement efforts might point to the appendix as evidence of the university's strong position with respect to protecting its intellectual property, these efforts should instead be viewed as silly, wasteful, and unnecessarily repressive of potentially legitimate third-party speech.[9] Assuming enforcement is a value prized by the institution, we must ask, to what extent is the intangible loss of goodwill among alumni worth the price? As Stipe reflected to me: "I just felt that Baylor has all this money and power and they do whatever they want to do. That's the way I see it. The main thing that I find that works in things like this in life is just be nice to people and talk to them. It was really not necessary to throw around the lawyers, get the lawyers involved in something like this. The money you spent on the lawyers, why not pay someone a reasonable amount for the domain name? It doesn't have to be thousands of dollars, it could be a couple hundred of dollars or something. Or free tickets to the football game."[10]

Lawyers for colleges and universities would bristle at Stipe's reasoning, and rightfully so. If word spread that Baylor provided football tickets to those whom arbitration panels are likely to view as cybersquatters, there soon would not be enough seats in Floyd Casey Stadium to accommodate all of those looking to strike a deal. Some institutions would rather pay thousands of dollars to their attorneys than pay one dollar to someone they view as using opportunistic or potentially coercive tactics.

Yet in Stipe's case, shouldn't his alumni status have resulted in better treatment? Perhaps at least a phone call, attempting to persuade him of the legal merits of the university's position? Most likely some

attempt at reaching an amicable settlement, before the university commenced the legal processes, would have allowed the institution to safeguard its reputation while also protecting its trademarks. At the very least, BAYLORBEARSSUCK.COM could have been removed from the arbitration action involving the other four domain names. That small gesture might have avoided the question of whether intellectual-property protection was more important to the university than not being seen as an overzealous monitor of any domain-name reference to the institution that might have a critical edge.[11]

While Baylor's story is an extreme case, it represents the direction in which many institutions are moving regarding the formation and enforcement of brands. This chapter describes the ascendance of branding in higher education, detailing its quiet and unheralded rise in five overlooked corners of the intangible world: the changing names of technology-transfer offices; college and university battles for cyberspace; institutional use of student-athletes' names and likenesses; the registration of institutional and programmatic slogans; and the claiming of institutional secrets. Intellectual-property rights fuel these efforts by colleges and universities—once again, often to the detriment of the public interest.

The Power of Brands

Before delving into how institutions of higher education are using intellectual property to further brand-building initiatives, I first should restate what a brand is and how it relates to intellectual property (see chapter 2).[12] Brands typically involve trademarks, although they can be tied to other intellectual-property principles and rules as well, such as the right of publicity and trade secrets. Brands and trademarks are similar, but not identical.[13] As Deven Desai has written, brands use trademarks "to provide information regarding source and quality and simultaneously to convey image components regarding power, value, and personality."[14] In short, while brands perform trademark functions, they also interact with consumers by enticing, forming, and impacting market behavior.

Brands achieve consumer recognition and loyalty by eliciting a reaction rooted in an ethereal combination of experience, meaning, and memory. Memory is important, because people bring preconceived ideas and perceptions into every experience, which ultimately influence their behavior.[15] A limited view of branding includes items like logos, color palettes, font types, flyers, direct-mail pieces, radio ads, TV commercials, and other traditional marketing outlets. Goods and sellers are differentiated by symbols and names.[16] Branding, however, can also be conceptualized as something much deeper—a moral compass, forcing institutions to make decisions based on internal and supposedly unchanging value systems. Branding, at least in higher education, is less about closing deals and making sales than it is about finding and affirming purpose. Institutional self-understanding and self-definition are central to the branding process for colleges and universities.

Memorability and meaningfulness are key elements in brands. The perception of a brand and its association with a service or product by various stakeholders are critical to understanding the power of a brand's components, whether they be a symbol, a name, or a combination of features that convey a signal. This power is subsequently transferred to value, based on the impressiveness, meaningfulness, and predictableness of the brand,[17] and value can be leveraged as either a form of capital or stored equity.

Brand equity is composed of brand values. A high-value brand is juxtaposed with a commodity, or a uniform good or service. Branding, however, moves beyond the details or benefits of a single product into the deeper emotional, psychological, and sociological territories of identity, beliefs, values, self-expression, and self-worth. Once a brand has built up some equity, that brand constitutes stored value that can be reinvested as it continues to expand. For example, a well-known brand can afford to explore new products and markets by surviving on its equity, which has created loyalty in its customers. The notion of brand equity is essential to the strategic management of well-branded institutions.[18] An increase in the equity of a brand

aids in building greater cultural identification, and vice versa. As a result, developing a culture or a brand depends on distinction, coherence, and consistency.[19] Building a brand can include acquisition, enhancements, maintenance, and strategic associations, in order to convey an actual or aspirational identity.

When equity and identity are leveraged in new ways, the aspirational aspect of brand positioning takes center stage. New markets are targeted and explored as a result of different brand positions. For example, new audiences may be drawn to McDonald's, based on how it packages and presents its various product offerings, yet the corporation's vision of itself as an innovative market leader remains unchanged. Brand positioning therefore is not so much a change in values as it is a reflection of direction and intent. Identity is intrinsically linked to institutional culture and the trajectory of its mission.[20] Exploring new markets and claiming dominance in a new territory also requires capital, which make brand equity, brand identity, and brand positioning concentrically operating principles that are mutually beneficial in building a loyal constituency.

The application of brand theory to higher education is in its early stages. Scholars tend to view the rise of branding in higher education as a response, in part, to globalization, with a brand serving as a vehicle with which institutions can forge memorable identities in progressively more-competitive markets.[21] The commonly noted instances when a brand is employed in higher education tend to revolve around admissions, athletics, and alumni relations—and some, but not all, of the trends discussed in this chapter have ties to these areas of campus activity.[22]

If a brand is related to an institution's norms, values, and beliefs, then brand equity is linked to the value embedded in its culture. Put differently, the additional significance (that is, other meanings and values) a consumer might place on a brand, as opposed to a commodity (a good or a service), is the equity held by that brand. For example, comparing a historic brand, such as Harvard University, with that of a newer institution, like the University of Phoenix, highlights how brand equity is the value that comes from having a name

or a symbol that differentiates the service provider. The Harvard University brand operates with a stored value that is more pronounced than the University Phoenix's newer brand. Harvard's equity creates a higher level of loyalty and affection in that institution's patrons. Brand equity allows a college or a university to enhance its own brand and its capital by building on a strong identification with that meaning and value. These images must correspond with a college's or a university's substance, including its mission, vision, purpose, and foundations, and they must be visible both to those inside and outside the institution.

This chapter explains how brand recognition is driving institutional efforts to conceptualize their identities in new ways, all of which use intellectual property. No longer bounded by the geographic features and limits of their campuses or traditional descriptions of them, colleges and universities are using intellectual property to build expansive presences across markets and spheres, including the realms of technology transfer, advertising, and the cyberworld. Not content to be defined merely by the intellectual output and activity of their faculty, colleges and universities are looking to derive value from their students and their donors, wielding the rights of publicity and trade-secret laws as intangible signals of their changing identities. Concerns about image and status, in pursuit of brand and its powers, weave through all of these developments.

New Names, New Meaning

The Bayh-Dole Act of 1980 created an incentive for universities to establish internal infrastructures to manage their patenting and licensing efforts (see chapter 4). They accomplished this goal by inaugurating technology-transfer offices, classic "interstitial organizations" (to use terminology coined by Sheila Slaughter and Gary Rhoades) intended to be intermediaries between a university's revenue-generation activities and industry.[23] Because dedicated attention to these activities was a new undertaking for most institutions and was controversial for some faculty, many universities chose to separately incorporate their TTOs, staffing TTO boards with university

personnel and friendly alumni.[24] Public institutions, in particular, found this separate incorporation attractive, as state law often prevents governmental entities from owning equity in private enterprises, including university spinoff companies.

The first iteration of TTOs quite commonly promoted their ties to academia, with the earliest and perhaps most prominent example being the Wisconsin Alumni Research Foundation.[25] Even for institutions that chose not to handle their technology-transfer efforts through a separate organization, the titles of these in-house entities typically were descriptive in nature, with words such as "office," "technology," "transfer," and "research" appearing in their names.

Beginning in the early 2000s, some institutions adopted new names that removed these common words from their titles, eschewing generic words in favor of terms with a richer brand value. A list of those name changes (table 6.1) suggests that the model of an arms-length TTO, which has served most institutions for twenty years or more, is undergoing recalibration to reflect new institutional priorities that are embodied in brands. These priorities include becoming entrepreneurially nimble, market-reactive, market-oriented institutions that are positioned to engage in any type of complex negotiation involving their intellectual property.[26] Gone are the days of TTOs standing as their own constructs, often physically located off campus, distant geographically and conceptually from the very faculty whose work makes their existence possible.

The original TTO names reflected their historic focus on patenting and transactions. For the twenty-first-century TTO, however, patents and licensing no longer form their sole or even primary core; instead, venture formation, commercialization, and strategic partnerships have become central. A patent-focused TTO model reflects an increasingly dated, faculty-centric, "technology push" mode of operation, where a university exists to stockpile knowledge created at the instigation of its own researchers, embodied in institution-owned patents. The new fashion in TTO operations follows a socially embedded, "technology pull" model, which lets the marketplace dictate

Table 6.1. Examples of university TTO name changes, 2002–2013

Institution	Prior TTO Name	Current TTO Name, Date of Change
Arizona State U.	Arizona Science and Technology Enterprises	AzTe, 2002
Columbia U.	Office of Science and Technology Development (1982–1994); Columbia Innovation Enterprise (1994–2001); Science and Technology Ventures (2001–2009)	Columbia Technology Ventures, 2009
Oregon State U.	Office of Technology Transfer	Office for Commercialization and Corporate Development, 2011
U. of Arkansas at Fayetteville	Technology Licensing Office	Technology Ventures, 2012
U. of Cincinnati	Intellectual Property Office	Office of Entrepreneurial Affairs and Technology Commercialization, 2010
U. of Nebraska	University Technology Development Corporation	NUtech Ventures, 2009 UNeMed, 2009
U. of New Hampshire	Office of Research Partnerships and Commercialization	UNHInnovation, 2013
U. of New Mexico	Science and Technology Corporation of the University of New Mexico	STC.UNM, 2006
U. of Rochester	Office of Technology Transfer	UR Ventures, 2013
U. of Virginia	University of Virginia Patent Foundation	U.Va. Innovation, 2011 University of Virginia Licensing & Ventures Group, 2011
U. of Washington	UW Technology Transfer Office	C4C, 2010
Virginia Commonwealth U.	VCU Tech Transfer	VCU Innovation Gateway, 2013

Note: TTO = technology-transfer office.

technological needs, often leading to the formation of interwoven business-academe relationships that can quickly react to the market's promptings. Stockpiles of patents—which may or may not correlate with the needs of the marketplace—now hold little inherent attraction. For example, a surplus of patents that were of scant interest to prospective licensees led the Pennsylvania State University to

auction off some of its holdings to the public in 2014, with mixed success.[27]

The TTO name changes listed in table 6.1 are not merely about brand positioning. Instead, most involve a recalibration of brand identity, as colleges and universities select TTO names that signal an allegiance to new goals, values, and sectors. Each of these name changes represents not simply an attempt to reposition, but rather to redefine the very functions and construction of each institution's technology-transfer efforts. As a press release concerning the University of New Hampshire's rebranding effort stated, its goals were to "take a more complete view of the university's assets, create new business relationships, and accelerate commercialization of UNH's intellectual property."[28] The rationales behind other TTO name changes are similar. For example, the University of Virginia's first "chief innovation officer" offered this description of his institution's name change for its TTO: "In recent decades, university technology-transfer offices, including the U.Va. Patent Foundation, have been focused almost entirely on faculty research patents and resulting licensing revenue. . . . The launch and branding of U.Va. Innovation in 2011 was a move away from the traditional focus on patents to emphasize a new, broader view of value, to better weave innovation into the fabric of the University."[29]

Identification with the marketplace is central to these changes. Many of the new TTO names prominently tout "ventures"—a classic market construct that connotes entrepreneurialism and risk taking—while downplaying or removing the words "science," "transfer," or "office" from the name, as these terms tend to evoke an earlier conception of academic technology transfer. In short, most of these TTO name changes do not reflect minor image tweaks, designed merely to present a university to a new audience. Instead, they indicate a conscientious effort to burnish an entirely new image of that university's mission and its function in the business world. No longer styled as disinterested purveyors of knowledge, these newly branded TTOs sport names that call to mind a university actively engaged in entrepreneurial risk taking and open to the

possibility of science and discovery as vehicles for generating private wealth.

The trademark function of these new names furthers this evident brand strategy. AzTe, STC.UNM, UNHInnovation, and C4C (which stands for Center for Commercialization) are all coined, fanciful terms, which imbue them immediately with trademark meanings. For example, C4C conveys nothing other than a distinctive trademark; the invented term does not exist in any dictionary. This type of mark receives strong protection under trademark law (see chapter 2). Even for those new TTO names that are not fanciful, at the very least each suggests, rather than merely describes, the services that these sectors within higher education offer. In other words, the words used most often in all of these TTO name changes—"technology" and "ventures"—require some mental thought in order to divine their precise meaning in relation to a university's service offerings, unlike the more-descriptive or generic phrasing of their common predecessors, "office of technology transfer" and "technology-transfer office."

This seemingly minor semantic difference signals what is actually an important shift in the history of university technology transfer. These name changes demonstrate that many university administrators no longer view TTOs as primarily performing inward-looking, faculty-service functions. Instead, the new names reflect how the TTOs have fully embraced values and practices in the commercial marketplace, right down to renaming themselves in ways that might build brand equity and lead to market differentiations.

Universities, for some time, have appended the names of donors or sponsors to certain divisions within the institution: from endowed chairs named for pharmaceutical companies, to corporate-sponsored football stadiums or classrooms, to entire schools (such as the XYZ School of Business) renamed for an individual donor. The TTO name changes identified above are different, however, in that they reflect a conscious decision to create a brand, not a decision to appease or reward a person or a firm. They are not part of a tradition of honoring philanthropy through naming rights. Instead, they represent attempts

by universities to attract those in the private sector by looking and acting like that market—right down to using trademarks to build private rights.

Expanding Domains

Chapter 2 described the functioning of the domain-name system and some basics of the history, creation, and governance of the .EDU extension. Here, I provide more information about this extension and discuss how colleges and universities are using their trademark rights to define and expand their brand interests online.

EDUCAUSE and the .EDU

In 2001, the Department of Commerce engaged EDUCAUSE to operate the .EDU registry and determine eligibility criteria for institutions seeking to register a domain name with this extension. EDUCAUSE replaced Network Solutions, which had held that contract from the federal government since the early 1990s.[30] From the beginning of its management of this extension, EDUCAUSE recognized the power of .EDU to signify authenticity and legitimacy for those operating within the sphere of higher education. As the organization's vice president wrote at the time: "The .EDU domain name of a campus is important as a way of stating that an institution is a recognized member of the higher education community and that the institution meets the community's standards of degrees and accreditation. This sign of recognition will be all the more critical as more and more teaching and learning is conducted through the Internet via 'e-learning.' "[31]

Most four-year colleges and universities had registered a .EDU domain name by the late 1990s. In fact, because of the perceived cachet of .EDU, many outside of higher education sought to register domain names using that extension, too. Facing more than 1,500 requests to register .EDU domain names in 1999, Network Solutions—the predecessor of EDUCAUSE—permitted registration of fewer than 10 percent of the requests.[32] Eligibility criteria were not applied

evenly, however, which led to some individuals registering .EDU domain names for organizations that did not meet the stated criteria.

Soon into its leadership of the registry, EDUCAUSE developed and enforced several rules that served to strengthen registrations using a .EDU extension. For example, no eligible institution can register more than one .EDU domain name, which only underscores the scarcity and importance of each individual domain-name registration.[33] Also, in 2003 the organization instituted a rule where "names in the .EDU top-level domain, regardless of when issued, may not be transferred in any way," effectively eviscerating any secondary markets for buying, trading, or selling .EDU space.[34]

Because "there's a widespread belief that .EDU means something," institutions have taken steps to capture the brand value of the .EDU extension.[35] For example, many colleges and universities offer their alumni access to their own personal .EDU email address for life. Some institutions have found that providing lifetime email addresses to alumni is "a powerful tool" for keeping their graduates engaged.[36] Those proud of their alma maters also consider the email addresses as a signaling device, or "subtle resumé."[37]

While a lifelong affiliation with one's alma mater has its price—namely, the cost of tuition—the associational value between the institution and users of its domain name has a price of its own. Some profiteers in China even sell .EDU email addresses on an eBay-like auction site for hundreds of dollars each, capitalizing on the perceived value and authenticity that accompanies emails sent from high-prestige universities, which is reflected in the .EDU space.[38]

Regardless of these practices, as online infrastructure has matured, and its users' comfort level with this medium has deepened, some within the higher education community have questioned whether "the tail end of a web address really matter[s]" all that much.[39] Web browsers now are programmed to complete common URL addresses even before the user has finished typing them, and colleges and universities themselves have bought up various .COM, .ORG, and .NET domain names to serve particular programmatic or marketing-related

needs.[40] The availability of new gTLDs approved by ICANN will require higher education institutions to continue to evaluate both how they wish their presence to be reflected online and to what extent the .EDU domain will be regarded not only as exclusive space, but also as the primary Internet space in which colleges and universities operate.

College and University Battles for Cyberspace

Given that not just anyone can register domain names with a .EDU extension, you might think that those whose registrations include this extension would have little need to accumulate registrations outside it. After all, legitimacy and authenticity—presumed by virtue of a name's inclusion in a restricted space—are desirable qualities for a brand.

Yet many institutions actually take the opposite approach, looking for opportunities to expand their online presence, even if that means engaging in private-rights contests. Higher education institutions quickly learned that the availability of the restricted .EDU extension was not sufficient to define their brands online; third parties could use these or similar domain names with other extensions, without permission, in damaging ways that invoked an affiliation with a college or a university. Institutions expanded their conception of brands to police these new territories. As Scotty Bearby and Bruce Siegal, writing in 2002, advised, "Institutions should be on guard against a wide variety of domain-name registrants, including offshore gambling entities, adult entertainment operators, ticket brokers, entrepreneurs trying to make a quick dollar, and even fans and alumni."[41] Higher education waged battles with a wide variety of these types of entities, and news of these efforts soon made their way into the headlines of popular and academic outlets.

Two primary legal vehicles exist for trademark holders to resolve claims related to the alleged improper ownership and use of domain names by third parties: arbitration action (through the uniform domain-name dispute-resolution policy), and federal-court litigation. Both provide remedies for mark holders aggrieved when a third

party—often labeled a cybersquatter by the mark holder—registers and uses a confusingly similar domain name in bad faith.[42] Because they lead to quicker and cheaper resolution of disputes, UDRP actions are more commonly used than legal actions in a federal court to contest domain-name ownership.[43]

Procedurally, a UDRP action is initiated when a trademark holder submits a formal complaint to an ICANN-approved dispute-resolution provider, also known as an arbitration provider. Complainants may choose which provider to use, a crucial option that some have said creates "an incentive for providers to favor complainants in their decisions."[44] Respondents win less than 20 percent of the UDRP proceedings that result in a ruling.

The arbitration provider's initial task is to determine if the complaint complies with applicable administrative rules. Assuming that all basic filing requirements are met, the provider then submits the complaint to the respondent, who has twenty days to respond, as John Stipe did when Baylor University challenged his ownership of five domain names incorporating the BAYLOR trademark.[45] If a timely response is submitted, the provider forwards the complaint and the response to the appointed review panel, which consists of either one arbitrator or a three-arbitrator group, at the complainant's choice.[46] Even if no response is submitted, the complaint is forwarded to the appointed panel, which need not consider UDRP precedent in reaching its decision.

In order to prevail in a UDRP action, a complainant must satisfy three requirements. First, the complainant must show that the contested domain name is identical or confusingly similar to a mark to which the complainant has rights. These rights need not be in the form of a federal trademark registration, but the more established and long-standing the trademark rights are, the better the complainant's chances of prevailing. Second, the complainant must prove that the respondent has no rights to or legitimate interests in the domain name. Third, the complainant must establish that the domain name has been registered and is being used in bad faith.[47] Evidence of registration and use in bad faith, which often is the most hotly disputed

of the three requirements, can take many forms, including circumstances suggesting that (1) the respondent registered the domain name in order to prevent the complainant from using its mark in a corresponding domain name; (2) the respondent registered the domain name primarily for the purpose of disrupting the complainant's business; or (3) in using the domain name, the respondent intentionally attempted to attract Internet users to a website by creating a likelihood of confusion, with the complainant's mark being interpreted as the source or as indicating sponsorship of, affiliation with, or endorsement of the website.[48]

ICANN created the UDRP in 1999, with an effective starting date of January 3, 2000, after months of consultation with various interest groups. ICANN then required gTLD registries to adopt the UDRP.[49] In order to do so, the registries, in turn, insisted that registrars selling domain-name space within their extension had to incorporate the UDRP into the standard registration agreement between registrars and end purchasers of domain names. Jurisdiction is therefore contractual: by purchasing a domain name, a registrant agrees that any dispute concerning the registrant's rights in the domain name is subject to UDRP arbitration.[50] Registries agree to enforce UDRP decisions by approved providers no sooner than ten days after those decisions are issued.[51]

Research into UDRP actions shows that through the end of 2013, 100 different colleges and universities had filed 233 UDRP complaints, involving 373 domain names, since implementation of the UDRP in 2000. Arbitration panels awarded transfers or cancellations of 91.7 percent of the disputed domain names and denied transfer for the remainder. Baylor University filed the most UDRP actions, sixty-two in all, although twelve additional institutions, including Harvard University, Yale University, and the University of Michigan, each filed three or more. The most UDRP filings by colleges and universities—a total of thirty-five—took place in 2008 (figure 6.1). In 2000—the year the UDRP was implemented—the fewest UDRP filings by colleges and universities occurred, with only four.

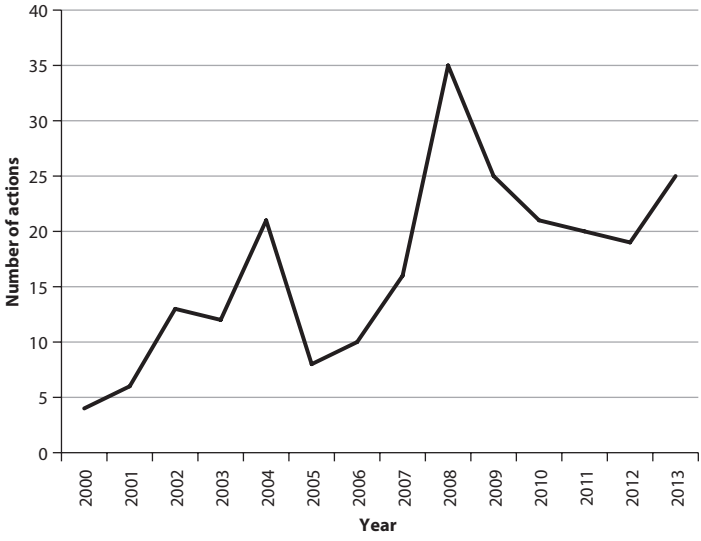

Figure 6.1. UDRP actions filed by colleges and universities, 2000–2013

Of the 373 domain names subject to UDRP actions brought by colleges and universities, the majority involved character strings that go beyond the simple pattern of an institution's name, followed by .COM, .ORG, .NET, and the like. Three-quarters of the disputes involved domain names with the .COM extension, although colleges and universities also sought ownership of domain names in other extensions: .ORG (thirty-one UDRP actions), .NET (twenty-one), .US (nine), .INFO (eight), .MOBI (seven), .ME (four), .XXX (two), .TV (one), .CO (one), .PA (one), and .NAME (one). Table 6.2 provides examples of some of the domain names obtained through UDRP actions.

While not their primary purpose, domain names undeniably serve brand functions in higher education because of their symbolic force and social resonance. For example, many at the University of Mississippi would prefer to see their institution use a more neutral-sounding, descriptive domain name, like UMISS.EDU, instead of OLEMISS.EDU, which, to some, conjures associations with slavery

Table 6.2. Examples of domain names subject to UDRP actions brought by colleges and universities

Owner	Domain Name
Arizona State U.	ASUNUDES.COM
Auburn U.	JUECOLLINSSMITHMUSEUM.COM
Baylor U.	BAYLORSUCKS.COM
Baylor U.	BELMONTLOFTSBAYLOR.COM
Baylor U.	RG3BU.COM
Boston U.	ONPOINTRADIO.NET
Carnegie Mellon U.	QCERT.ORG
Cedarville U.	CEDARVILLEALUMNI.COM
Cornell U.	CORNELLRENTALS.COM
Drexel U.	DREXEL.ORG
Excelsior College	CPNEWORKSHOP.COM
Grand Valley State U.	GRANDVALLEYHOUSING.COM
Harvard U.	HARVARDBUSINESS.NET
Harvard U.	HARVARDESSAYS.ORG
Johns Hopkins U.	HOPKINSMEDICINE.COM
Lebanon Valley College	LEBANONVALLEYCOLLEGEFLYINGDUTCHMEN.NET
Stanford U.	STANFORDEVENTS.COM
Syracuse U.	SUFACEBOOK.COM
Tufts U.	TUFTSGEEK.COM
U. of Miami	UHEALTH.ORG
U. of Michigan	UMICHREGENTS.COM
U. of San Diego	THETOREROSTORE.COM
U. of Texas	TEXASLONGHORNMERCHANDISE.COM
U. of Texas	FRANKERWINCENTER.COM
U. of Texas	UTSYSTEM.XXX
U. of Vermont	UVM.ME
U. of Wyoming	WYOMINGCOWBOYS.COM
Vanderbilt U.	VANDERBILT.MOBI
West Virginia U.	WVUSPORTS.COM
Yale U.	YALEPARENTINGCENTER.ORG

Note: UDRP = uniform domain-name dispute-resolution policy.

and segregation.[52] A simple domain name often conveys impressions to people as much as it identifies computers to users. Thus college and university battles for cyberspace should be viewed through a critical cultural lens. These efforts to claim online space can affect institutional images and reputations in important and lasting ways.

As table 6.2 illustrates, some institutions seem to have been lured into expanding their brand online, when restraint might better serve them. Over one-third of the UDRP disputes filed by colleges and

universities through 2013 involved domain names that incorporated a college's or a university's entire name. Examples include WESTERNWASHINGTONUNIVERSITY.COM, AMERICANU.COM, and LOMALINDA.ORG.[53] From the standpoint of brand protection, enforcement of trademark rights in these instances is easily justified. All institutions of higher education naturally want to see their names protected to some extent outside of the .EDU extension, if for no other reason than .COM and other extensions are highly trafficked areas in the online world, and allowing those unaffiliated with higher education to use the name of a college or a university for an unrelated commercial purpose understandably seems unfair.[54]

Nonetheless, other instances of brand protection in online space by colleges and universities seem to be at the edges of the kinds of harm these institutions should be concerned about. For example, who will go to a website with the specific domain name BAYLOROFDALLAS.COM before trying the more-general BAYLOR.EDU?[55] How many will use the lengthy name COLORADOMESAUNIVERSITY.COM before typing in the shorter COLORADOMESA.EDU, or the unlikely INDIANA-EDU.COM before trying the more likely INDIANA.EDU?[56] Regardless, seeking to reflect an institution's corporate name in online space is generally consistent with widely recognized brand- and trademark-protection strategies in both the nonprofit and the for-profit spheres. Additionally, to the extent that the original registrant of one of these domain names used it in a misleading or legally damaging way—for example, the original registrant of INDIANA-EDU.COM sent emails to third parties with the misrepresentation that Indiana University's website was switching from INDIANA.EDU to INDIANA-EDU.COM—seeking to put an end to such uses by filing a UDRP action is a reasonable and appropriate reaction.

More-questionable UDRP actions involve domain names like STANFORD-TALK.COM, TEXASLONGHORNCHECKS.COM, WVU SPORTS.COM, YALE-EXPLORE.ORG, UHEALTH.COM, KUHF.COM, VIRTUALHOSPITAL.INFO, and JULECOLLINSSMITHMUSEUM.COM. Seeking ownership of these and other domain names often seems to reflect college and university attempts to expand their brands and

online footprints beyond the typical or expected uses of brands by institutions in relation to educational services. These efforts constitute what Samantha King and Sheila Slaughter, writing in 2004, described as "the increasing commodification of cyber properties and universities' . . . growing vigilance in protecting them."[57]

Another area of domain-name contention involves use of a "parked page," that is, a webpage containing advertising listings and links. Often these links are targeted to the predicted interests of the visitor, and the domain-name registrant (or its registrar) receives payment from the advertisers for each click a visitor makes on a hyperlink on the parked page. For example, the University of Texas at Austin is not in the business of manufacturing personal or business checks, yet it viewed the registration and use of TEXASLONGHORNCHECKS.COM—as a parked page, with pay-per-click advertising—disruptive enough to its operations to seek a transfer of this domain name by means of a UDRP action.[58] We might reasonably question why it did so. Is the University of Texas at Austin prepared to pursue registrants of TEXASLONGHORNCOFFEEMUGS.COM, GIANTTEXASLONGHORNCOFFEEMUGS.COM, or DISHWASHERSAFETEXASLONGHORNCOFFEEMUGS.COM? What about typo variations of these names, or domain names incorporating even-more-obscure products licensed by that institution, such as TEXASLONGHORNCOFFINS.COM? The point is that if a university's brand is seen as being related to everything on which its logos currently are affixed, or might be affixed, through a licensing arrangement, there will be no end in sight to the enforcement of institutional trademarks incorporated into domain names.

Similarly, what does West Virginia University's decision to seek a transfer of WVUSPORTS.COM through a UDRP action say about its conception of brand?[59] Would that institution have taken the same approach against the registrant of a hypothetical WVUPHYSICS.COM (for its physics department), or WVUPARKING.COM (for its parking office)? At some point, seeking the transfer of every domain name that adds a generic word to the institution's trademark becomes unreasonable, even if current laws permit this activity and the brand owner is

likely to prevail if it pursues such actions. For example, Baylor University sought and achieved transfers through UDRP actions for BAYLORYELLOWPAGES.COM, BAYLORSALSA.COM, BAYLORFLORIST.COM, BAYLORBANKS.COM, and BAYLORSTORE.COM.[60]

Auburn University's UDRP action over JULECOLLINSSMITHMUSEUM.COM presents related questions. In the actual UDRP decision, the panelist noted that the respondent had been using the domain name to display content "designed to mimic Complainant's official website which featured links to the TICKETMAYOR.COM domain name that is owned by Respondent. The domain name currently resolves to Respondent's LAWPERISCOPE.COM site that advertises legal services."[61] These uses to which the respondent put the disputed domain name no doubt were harmful to Auburn's art museum, but would the university have pursued arbitration if the domain name had only been used to display a parked page with pay-per-click ads, as was the case when the University of Utah filed a UDRP action against the registrant of REDBUTTEGARDENS.ORG, or the University of Houston pursued the registrant of KUHF.COM?[62] What if no one else had registered JULECOLLINSSMITHMUSEUM.COM and it were available to be registered—would Auburn University have sought to register it?[63]

The problem presented by enforcement efforts like these is that once an institution decides that uses of domain names like JULECOLLINSSMITHMUSEUM.COM, REDBUTTEGARDEN.ORG, and KUHF.COM merit initiating a UDRP action, deciding on a stopping point is hard to do, given the array of activities in which colleges and universities are involved, and the multitude of programs sponsored by or units contained within any given institution. If the University of San Diego, whose sports teams are known as the Toreros (Spanish for "bullfighters"), is willing to file a UDRP action to obtain both THETOREROSTORE.COM and MY-TOREROSTORE.COM—which it did—what other domain names involving its team name would it or should it pursue?[64]

Just because colleges and universities can seek to own ancillary domain names does not mean that they should. In the case involving

the University of Houston and KUHF.COM, the university held common-law rights to KUHF when used in relation to radio station services, and it already owned domain-name registrations for both KUHF.ORG and KUHF.NET. Apparently not satisfied that its nonprofit, listener-supported radio station had two Internet domain-name registrations in extensions commonly thought of as noncommercial, the university filed a UDRP action against the registrant of KUHF.COM, who happened to be located in Riga, Latvia.[65] The registrant used the disputed domain name to display pay-per-click advertisements, or, as the panelist put it, "links to competing and non-competing commercial websites from which Respondent presumably receives referral fees." Even though (1) the University of Houston owned no federal trademark registration for KUHF, (2) domain names with four or fewer numbers or letters in them commonly sell on secondary markets for thousands of dollars, and (3) KUHF literally could stand for many different things, in various languages, the panelist decided that the respondent had acted in bad faith and concluded that there was no "other possible explanation for Respondent choosing the letters KUHF, meaningless except as Complainant's call letters."[66]

The respondent in that particular case was in the business of buying and selling domain names, many of which appear to be used only to display parked pages with pay-per-click advertising. But without any offer to sell the domain name to the complainant, or active use of it by the respondent in a way that hurt the university—neither of which the panelist found to be present—the University of Houston's interest in filing the UDRP was questionable. The university pursued a legal process to obtain the domain name simply because it could. Its efforts represent a vindication of the powerful apparatus of a public institution of higher education over an obscure foreign company whose business model few understand or find respectable.[67]

In this instance, the motivation for a brand expansion may have been sound if the University of Houston contemplated using the domain name in a stand-alone, content-rich way. Yet even that expla-

nation falls short. As of December 2015, a visit to KUHF.COM redirected visitors to HOUSTONPUBLICMEDIA.ORG, which suggested that the radio station's primary conception of its brand no longer revolved around its call letters.[68] Regardless, the university had added to its arsenal of intangible rights a lightly trafficked domain name it must pay to maintain. The domain name's letters could mean anything, but the availability of this name to the rest of the world will be restricted for as long as the university chooses to continue its registration.

Also on the spectrum of brand-expansion activities are efforts by two universities to wrangle control of generically worded, seemingly innocuous domain names related to the field of health care, an increasing source of revenue for institutions of higher education. Neither domain name involved the recognized name or trademark of either university. In one case, the institution was successful; in the other, it was not. The first dispute, initiated by the University of Miami, involved the domain name UHEALTH.COM.[69] The university owned a 2009 trademark registration for a graphical rendering of the words UHEALTH UNIVERSITY OF MIAMI HEALTH SYSTEM, and enjoyed common-law rights for UHEALTH, when it filed a UDRP action in 2013. The disputed domain name was first registered in 2002, and then acquired by the respondent in 2004, well before the university's claim for its first use of the UHEALTH mark, in December 2007. Although the arbitration panelist was generous, stating that the University of Miami had established rights to the mark UHEALTH, the panelist declined to find that the respondent had registered and used the domain name UHEALTH.COM in bad faith, and therefore ruled in favor of the respondent.

The second dispute occurred in 2002, involving the University of Iowa's successful attempt to obtain ownership of VIRTUALHOSPITAL.INFO.[70] In that UDRP action, the university actually owned a federal trademark registration for VIRTUAL HOSPITAL, dating back to 1997, for uses of that mark in relation to "providing medical information, education, and instruction through database accessible by remote computer."[71] The respondent, located in Zilina, Slovakia, registered

the disputed domain name in 2001. Prior to filing its UDRP complaint, the university wrote the respondent, asserted its trademark rights, and sought to purchase the disputed domain name from him. The respondent replied that he "didn't intend to break intellectual property rights of the University of Iowa. I have prepared another activities [*sic*] on my domain VIRTUALHOSPITAL.INFO. With the stopping of those activities I shall lose 10,000 USD. This is my offer to sell my domain VIRTUALHOSPITAL.INFO." The respondent further stated that the disputed domain name was the English-language equivalent of two domain names that he had registered in the ccTLD-extensions for the Slovak Republic and the Czech Republic (VIRTUALNANEMOCNICA.SK and VIRTUALNINEMOCNICE.CZ).

The University of Iowa was unwilling to pay the respondent more than the price charged for registering the domain name. It also noted that it "is actively involved in trademark licensing activities that utilize the term VIRTUAL HOSPITAL." Although the nature of those activities was not specified by the university, the panelist did his own fact finding and found that the institution had licensed the use of its mark to hospitals in various countries where the mark was also registered, including Australia, Iceland, Japan, and Venezuela. Because of the registrant's offer to sell the domain name to the university for $10,000, the panelist found that the bad-faith element in the UDRP had been met, notwithstanding the respondent's plausible arguments that he intended to use the domain name for legitimate noncommercial purposes and was not aware of the university's trademark registration in the United States. In short, the panelist ruled that the university had a more compelling claim to the disputed domain. In reading the panelist's decision, however, it is easy to conclude that the respondent's inability to fluently communicate in English jeopardized his ability to mount what otherwise might have been an effective defense.[72]

The URDP actions of both the University of Miami and the University of Iowa are telling, in that they show the extent to which universities are willing to go to use their trademark rights to further their

brand-formation and brand-protection efforts in online space. In the UDRP action involving the University of Miami, even a poor set of facts did not dissuade it from seeking control of a domain name that did not even explicitly refer to the university. That institution's cause was hurt by the fact that it waited over ten years from the registration of the disputed domain name before filing a UDRP action. Additionally, the university did not receive federal trademark rights to UHEALTH until seven years after the domain name was registered, which also prejudiced its efforts.[73] The University of Iowa's UDRP action shows that even far-flung international actors are not immune from the brand expansion and enforcement efforts of American universities.[74]

In another twist on brand expansion, at least one university has used the UDRP to claim rights to a domain name that it claims refers to one of its alumni. That person is no typical graduate, but a professional football player who won the Heisman Trophy while playing for the institution in question, Baylor University. Baylor filed the UDRP in November 2013, nearly three years after Robert Griffin III—also known by his nickname, RG3—graduated from the university, and more than two years after he threw his last pass as the quarterback for Baylor's football team and entered the NFL.[75] The university owns no trademark for RG3's legal name or nickname, yet was aggrieved when a fantasy-football enthusiast registered the domain names RG3BAYLOR.COM and RG3BU.COM, using them for fantasy-football purposes.[76] Owning federal registrations for both the words BAYLOR and BU, the university asserted that the disputed domain names were confusingly similar to its trademarks.[77] The panelist agreed, finding that the addition of the descriptive term "RG3"—"likely meant as an allusion to Robert Griffin III, who achieved fame while playing for Complainant's football team"—did not undermine Baylor's rights to the domain names. It is doubtful that RG3—whose nickname as a professional athlete clearly has commercial value for *him*—prompted this enforcement activity. In my visits in December 2015 to the two domain names, which were transferred

to Baylor in December 2013, neither led to a webpage. I wonder whether RG3 benefited from his alma mater's enforcement of his name.

Higher Education's Online Brand and the Public Good

The involvement of institutions of higher education in UDRP actions like these reflects an expanding concept of a university, where the boundaries and limits of its outreach no longer are constrained solely by its institutional name and the name of its athletic team. As colleges' and universities' notions of brands expand, so, too, will their perceived need to seek out more space online and to fight those who may have gotten there first.

The interplay between trademark rights and domain names merits reiteration. The complainant must have rights to a mark in order to prevail in a UDRP action. Owning a federal registration for a mark, while not necessary, enhances the prospects of winning a UDRP action when that mark is incorporated into a disputed domain name. Thus, a trademark–domain-name feedback loop exists: the stronger and more robust the rights colleges and universities acquire for their marks—in the form of a federal trademark registration, or multiple registrations either for different versions of the mark or in different classes—the broader the options they have to pursue enforcement efforts against domain names that contain those marks. Success in those efforts then is more likely, and UDRP actions become more tempting to institutional decision makers. In short, the more trademark rights a college or a university accumulates, the greater the online footprint it is able to claim in areas outside the .EDU extension, and the more attractive those spaces may appear to those making enforcement decisions.

The behavior of colleges and universities in the realm of trademark acquisition therefore has an impact on their battles for cyberspace. They have shown great zeal in accumulating the rights for descriptive terms and phrases associated with their institutions, no matter how loosely (see chapter 3). Increasing numbers of college- and university-owned trademarks refer not to the institution as a whole—in the

form of its official name, seal, logo, nickname, or athletic-team name—but to constituent parts of the institution, such as schools (of law, medicine, business, and the like), programs, and curricular initiatives.

Higher education's online presence may soon reflect these trademark trends, if it doesn't already. Registering domain names like HARVARDESSAYS.ORG, CORNELLRENTALS.COM, YALEPARENTINGCENTER.ORG, and STANFORDEVENTS.COM—all of which have already been sought and obtained by universities—may become quite common for colleges and universities, without ever rising to the level of a UDRP dispute.[78] It is unclear how far the practice extends, because institutions of higher education do not divulge this information, and conducting a comprehensive search for all domain names owned by colleges and universities would be expensive and cumbersome. To the extent that institutions are motivated to seek online space to further their brands, such efforts are far cheaper if carried out proactively, instead of reactively. The cost of registering and maintaining a domain name is much less than pursuing arbitration to obtain the domain name once an institution realizes it does not own that name.

The more important concern, however, involves asking when preemptive registration of online space is advisable for colleges and universities. Although protecting its brand does not require an institution to expand that brand, the former often elides into the latter, whether that consequence is intentional or not. In part, the problem stems from the belief that a modern college or university must be all things to all people. Its constituents are many, as are its purposes.[79] These institutions no longer exist merely to provide educational services; their boundaries with all aspects of the commercial sphere are much more fluid. In higher education's ever-expanding quest for revenue, hardly any activity, endorsement, or affiliation will seem untoward, meaning that more cyberbattles probably will be fought. In this new world order for higher education, protecting a brand first requires defining it, and that definition often seems to stem from efforts at brand protection. In short, a domain name combining a

college or a university trademark with nearly any descriptive word or phrase—be it a product, service, geographic place, or even a famous alumnus's nickname—may lead to legal action, no matter what the actual extent of harm is for the institution.[80]

Made in Their Image

The right of publicity is related to intellectual-property law but has its own distinct legal underpinnings, with antecedents in the common-law right to privacy.[81] It is also of relatively recent vintage (compared with patent and copyright protections, both of which are mentioned in the U.S. Constitution), having first emerged in various states' laws in the 1950s.[82] Unlike trademark law, no contention of consumer confusion or deception is required in order to pursue a right-of-publicity claim, even though consumer confusion often results from the unlicensed commercial use of a famous person's name, image, or likeness in an advertisement, since consumers often believe that individual sponsors or endorses the product. When this happens, the aggrieved party can pursue both a right-of-publicity claim and a trademark-like unfair-competition claim, with the argument being that the famous person's identity serves as a form of mark.

An actual case involving a famous civil rights icon, Rosa Parks, and a hip-hop music group, OutKast, helps clarify these issues. OutKast was popular in the late 1990s and into the early 2000s. In 1998, the group released an album called *Aquemini* that, within a year, was certified double platinum. A hit song off the album was entitled "Rosa Parks." The real-life Rosa Parks felt that the song's title had little or nothing to do with her life or her historic role in the civil rights movement. She sued the group's record label, alleging violation both of her right of publicity and of the federal trademark statute, the Lanham Act, which the court determined was applicable, because celebrities like her "possess an economic interest in their identities akin to that of a traditional trademark holder."[83]

Rosa Parks argued that the group's use of her name in the song title was misleading, in that it suggested she endorsed or approved of the song and/or album, which she adamantly did not. She also

asserted that the use of her name in the song title and related advertising violated her publicity rights, as it constituted an unlicensed use of her name to sell records. The appellate court weighed these arguments against the First Amendment interests that OutKast said protected their use of her name, which they maintained they used in an expressive, symbolic way.

Unfortunately for OutKast, the only ostensibly direct invocation of Rosa Parks or her legacy was in the song's opening stanza, "Ah ha, hush that fuss / Everybody move to the back of the bus." In an interesting attempt by staid jurists to interpret the meaning of rap lyrics, the appellate court gave a less charitable interpretation to the song's meaning than did OutKast. The court wrote that the lyrics amounted to "nothing more and nothing less than a paean announcing the triumph of superior people in the entertainment business over inferior people in that business."[84] In what was seen as a victory for Parks, the court ultimately ruled that genuine issues of material fact existed in the case, and that a jury should hear both claims. The parties settled their dispute, however, before a jury was asked to make those determinations.

While publicity rights can be of benefit to anyone whose name or image has commercial value, such as Rosa Parks, issues concerning them quite commonly arise and are contested in relation to sports figures. As one right-of-publicity scholar noted, "The history of the right of publicity was largely developed by the desire of advertisers to attract attention to their goods and services by using the identity of prominent athletes—without paying them for that value."[85] Publicity rights are what give athletes the ability to license their endorsements or sponsorships of products to companies for money, even long after they have retired from competitive sports.[86] This activity is considered to be a form of commercial speech, and engagement in the world of commerce is exactly what the right of publicity protects. This right does not, however, provide athletes with the ability to control the use of their names, images, and likenesses for purposes of news reports, stories, entertainment, satire, or parodies. These forms of expression involving athletes (or anyone else) are protected by the

First Amendment, which is why newspaper articles and *Saturday Night Live* sketches do not infringe on publicity rights.

This legal background brings the application and value of publicity rights for college athletes into focus. In most college towns, fans of all stripes would struggle to identify the name or image of the local institution's president, provost, or even any Nobel laureates on faculty. Yet those same fans probably know all manner of details about the institution's starting quarterback, point guard, and other key players. Literally any statement these players make is subject to press scrutiny, and their every public act analyzed for meaning and its potential impact on what happens on game day. Love it or hate it, hysteria over student-athletes—particularly star players on football and men's basketball teams—defines the state of collegiate athletics in the United States.

From the standpoint of brands, prominent college athletes generate enormous recognition and equity for the institutions on whose teams they play. The value inherent in the names, likenesses, and affiliating details of collegiate student-athletes is advantageous first and foremost for the players, but also, by association, for their institutions. Colleges and universities have claimed, commercialized, and realized that value in various ways, without receiving permission from or compensating student-athletes. Higher education institutions have entered into agreements with licensing consortia, negotiated broadcast agreements with television networks, and signed endorsement and sponsorship agreements with purveyors of athletic equipment and companies looking to place corporate names and trademarks on stadiums, arenas, and sports fields. College athletics therefore operates like a theatrical show: student-athletes are the unpaid actors, while their colleges and universities are the directors and producers, poised to benefit financially when audiences like the show and keep coming back for more. And what a production college athletics is. The college-sports industry in 2014 was valued at more than $11 billion.[87]

Many have written about the ills of this system, equating student-athletes with slaves who work for modern-day plantation masters

who pay them nothing, or at least nothing of value.[88] In fairness, many college athletes receive full or partial scholarships in exchange for playing their sport, and some actually receive an education on a par with that received by non–student-athletes at the same institution. But the overall system—which is unique to higher education in the United States—has been called exploitative and shameful, at least at the most-competitive institutions at the Division I level. The only ones permitted to benefit financially from the arrangement are the coaches, athletic directors, NCAA officers, and member institutions themselves, which rake in the revenue from their student-athletes' activities without directly sharing any of it with them. NCAA rules require member institutions to control the publicity rights of their athletes, and those rights can be commercialized. The rules also do not permit member institutions to share licensing revenues with athletes, lest the institutions risk violating the NCAA's insistence on amateurism.[89]

Recognizing these imbalances is easy, and scholars, sports enthusiasts, and popular pundits have done so for years. Rectifying them has proven to be much harder than expected. Perhaps the main reason is that the NCAA and its controlling member institutions have had no interest in changing the landscape, as it is "simply too profitable for college administrators, athletic directors, and coaches to willingly forgo."[90] Money and inertia are powerful forces. In recent years, however, lawyers for student-athletes have been able to start changing the landscape in collegiate athletics, with the reclamation of publicity rights leading the way.

The first plan of attack involved focusing on the uncompensated uses of student-athlete names, images, and likenesses in video games, which is a lucrative industry. Without seeking the permission of student-athletes, or compensating them, colleges and universities gave the NCAA a right they themselves did not have: the right to control commercial uses of their student-athletes' identities. The NCAA, in turn, ceded those rights to the Collegiate Licensing Company, which handles commercial licensing arrangements for the NCAA, as well as for dozens of universities noted for their focus on

athletics. The CLC, together with the NCAA, licensed these rights to EA Sports (EA), one of the major producers of video games. That license became exclusive to EA in the mid-2000s, when the games' popularity grew exponentially.

EA used its exclusive license to student-athlete publicity rights to create video games involving college football and basketball, and the company sold millions of copies per year. In 1996, EA released a game called NCAA Football, and two years later, NCAA Basketball, which later became NCAA March Madness. Every player on real-life collegiate teams had a corresponding avatar in the games. Everything about the virtual players was identical to the actual players—jersey numbers, heights, weights, physical builds, skin tones, hair colors, playing styles, skill sets, and facial features.[91] The only thing missing was the actual player's name, although gamers could add a name to a given avatar, selecting from a list—created by third parties, yet maintained by EA on its servers for easy downloading—that contained all the surnames of the NCAA athletes in the year of each game's release.

The legal actions begun by former student-athletes who challenged this arrangement date back to 2009, when two such athletes sued EA Sports for using their images in football and basketball games. One case, involving lead plaintiff Ryan Hart (a former quarterback for Rutgers University), took place in New Jersey. A second case—which eventually was consolidated with others—was argued in California, with former Arizona State University quarterback Samuel Keller as its lead plaintiff. In both instances, EA took the position that the First Amendment protected its use of the athletes' likenesses in the games, and that the players had consented to these uses in documents they signed with the NCAA each year they participated in their sport.

While different conclusions were reached at the initial trials, both cases were resolved in favor of the student-athletes on appeal. The lengthy appellate court opinions ruled that EA's use of the plaintiffs' likenesses did not alter them sufficiently to bring them within the

protection of the First Amendment. In short, EA's application of student-athlete names and likenesses was commercial, not expressive. The appeals courts also ruled that EA did not have the consent of the players to use their likenesses commercially. In 2014, the group of student-athletes involved in these lawsuits settled their claims with EA and the CLC for $40 million, and with the NCAA for $20 million. The settlements provided some compensation, however inadequate, to the thousands of student-athletes whose names, images, and likenesses were used in the games from 2003 through 2014.[92]

Moving through the court system at the same time was a case initiated in 2009 by Ed O'Bannon, a former standout basketball player at UCLA during the 1990s, on behalf of current and former players. While this lawsuit also involved student-athletes' rights of publicity, at its core, the claims were rooted in antitrust law. The plaintiffs alleged that the NCAA conspired with member institutions to set the price of student-athletes' publicity rights at $0. By forcing member institutions to agree to and enforce rules that forbid student-athletes from receiving revenue, the NCAA and member institutions were thereby able to capture the commercial value inherent in the student-athletes' images and likenesses without having to fairly compete for it. This activity therefore violated antitrust laws by restraining trade.

In August 2014, a federal trial court ruled against the NCAA, agreeing with the class-action plaintiffs that the NCAA's rules unreasonably restrained trade. The NCAA had argued that its zero-compensation-to-players rules preserved its so-called important and cherished principles of amateurism and athletes as students. The court disagreed, noting that the NCAA could place reasonable caps on compensation—without prohibiting it completely or violating antitrust law—by holding funds in trust for student-athletes until they graduate. Additional compensation for cost-of-living expenses, not covered by scholarships, could also be permissible, the court said. The NCAA appealed the outcome in March 2015, and that September, a federal appellate

court largely upheld the lower-court decision, stating that the NCAA "is not above the antitrust laws."[93] The appellate court ruled that the NCAA's amateurism rules are anticompetitive, but it rejected the trial court's plan for holding compensation in trust for student-athletes.[94] Instead, the appellate court suggested that the NCAA could allow member institutions to grant players scholarships in amounts up to the full cost of attendance (to include, for example, gasoline, groceries, and expenses incurred traveling to and from the student's home). In May 2016, the NCAA joined a petition by the plaintiffs asking the Supreme Court to hear a final appeal in the case.[95]

In the meantime, the NCAA and member institutions continue to resist any change that would permit student-athletes to receive compensation. For example, FANPAY.ORG started as a website to allow family, friends, and fans of college sports to establish a place where funds could be contributed to pay student-athletes when they graduate from college. Instead of institutions holding money in trust for student-athletes, FANPAY.ORG does. As of spring 2015, the company had received 140 cease-and-desist letters from colleges and universities, threatening legal action if the site did not remove the names of these institutions' student-athletes.[96]

The battle to compensate college athletes is ongoing and no doubt will take years to resolve. Even though the NCAA no longer insists that student-athletes sign away their publicity rights, many individual institutions and conferences have decided to impose this requirement.[97] These organizations know the power of student names, images, and identifying indicia (such as height, weight, playing style, left- or right-handedness) to infuse equity into an institutional brand. They seem committed to go to great lengths to continue to claim what is not theirs, in the service of brand-development initiatives that generate millions of dollars in revenue for higher education institutions each year. Until laws and policies evolve to compel colleges and universities to treat student-athletes as independent adults and bargain for their publicity rights accordingly, most will do what they can to ensure that student-athletes' publicity rights conform with their own, institution-defined vision of brand.

Insert Catchy New Slogan Here

Roughly through the 1970s, colleges and universities were slow to seek formal trademark protection over any aspect of their identities (see chapter 3). These institutions' reluctance to protect even their names led some sportswear companies to attempt to capitalize on college and university names without paying licensing fees.[98] Higher education institutions, starting to be at risk of losing the ability to control their names and images, began to take hold of the concept of trademark protection by the early 1980s. They sought and received registration of their names, logos, and athletic insignia at the federal level, with the number of trademark registrations granted to colleges and universities nearly tripling from the 1980s through the 1990s. These registrations permitted institutions to license the use of their identifying insignia on all manner of merchandise, from traditional leisurewear and straightforward goods (for example, t-shirts, hats, and notebooks) to more unusual or even provocative items (such as coffins, fragrances, and underwear). In the space of three decades, collegiate licensing went from a $100 million industry to a $4.6 billion industry.[99]

By the early 2000s, however, higher education experienced a trademark saturation of sorts. With institutional names and major logos, seals, and athletic insignia covered by registered trademarks, colleges and universities seemingly had protected the aspects of their intangible identities most important to them. Yet their applications for federal trademark registrations did not stop there. Instead, the decade from the 2000s to the early 2010s saw substantial growth in the number of institutions seeking protection for nontraditional items. During this time period, many colleges and universities sought an escalating number of trademark registrations for their .EDU domain names, faculty-research initiatives, and the names of individual programs, centers, and schools within an institution. Even products that resulted from faculty research were looked at and claimed for their trademark potential.

One segment of this trademark frenzy stands out for its relation to brands: slogans for institutions as a whole, or for any of their

components. By the end of 2012, of the over 10,000 trademark registrations owned by American colleges and universities, 1,105 of them consisted of slogans, 94 percent of which were registered between the year 2000 and the end of 2012 (table 6.3). Many of the slogans convey a sense of marketplace identification and orientation. An underlying or even explicit current in these trademarks is that colleges and universities are part of the "real world," not set apart from it in any ideological or philosophical sense. Slogans such as REAL-WORLD THINKING, WORLDWIDE REACH; KNOWLEDGE THAT WORKS; BRINGING KNOWLEDGE TO LIFE; WE'RE ALL BUSINESS; TURNING RESEARCH ON EDGE; and CREATING VALUE FOR THE WORLD embody this quality. They tap into a market-oriented vision of higher education, where subjects related to business are touted and given primacy over courses and disciplines that are more distant from the marketplace, no matter what their societal importance is or their traditional value to higher education.

Several of the slogans also explicitly incorporate a private-goods orientation toward higher education's purpose and values, suggesting that it exists to bestow private benefits on individuals, not to develop public goods that contribute to all of society. Pithy, trademark-protected slogans—such as CA$HING IN; BECOME EXCEPTIONAL; SUCCESSREADY; BECOME MORE; PURSUE YOUR PASSION; BUILDING A WINNING LEGACY; BIGGER OPPORTUNITIES, BIGGER REWARDS; THERE'S AN MBA FOR THAT; SOLUTIONS FOR YOUR LIFE; DISCOVER THIS PLACE, SHAPE YOUR WORLD; and IMAGINE POSSIBILITIES, REALIZE SUCCESS—all convey a sense of the private gains that colleges and universities are positioning themselves to offer to students.

In contrast, a few of the slogans suggest that higher education contributes to a greater public good, such as VALUES. SCHOLARSHIP. VISION; CHANGE IS CENTRAL; IN THE NATION'S SERVICE AND IN THE SERVICE OF ALL NATIONS; LEARN TO THINK; CREATE THE FUTURE; ENGAGING THE CULTURE, CHANGING THE WORLD; and EMPOWERING MINDS THROUGH SCIENCE. Ironically, by seeking trademark protection for slogans that call to mind

Table 6.3. Examples of trademark-protected slogans owned by colleges and universities

Owner	Trademark
Adelphi U.	DON'T FEAR SUCCESS
Arizona State U.	CA$HING IN
Bellevue College	BECOME EXCEPTIONAL
Boston U.	CREATING VALUE FOR THE WORLD
Buena Vista U.	IOWA'S ACCESSIBLY SCALED, EYE-OPENING UNIVERSITY
California State U.–Fullerton	READY TO WORK. READY TO LEAD
Carlow U.	VALUES. SCHOLARSHIP. VISION.
Central State U.	CHANGE IS CENTRAL
Clarkson U.	DEFY CONVENTION
Cleveland State U.	THERE'S AN MBA FOR THAT
Colorado State U.	SUCCESSREADY
Dickinson College	ENGAGE THE WORLD
Drake U.	BUILDING A WINNING LEGACY
Florida International U.	WORLDS AHEAD
Furman U.	BRIDGES TO A BRIGHTER FUTURE
Guilford College	BECOME MORE
Hastings College	PURSUE YOUR PASSION
Loyola U. of Chicago	PREPARING PEOPLE TO LEAD EXTRAORDINARY LIVES
Michigan Technological U.	CREATE THE FUTURE
Montgomery County Community College	THINK BIG
Ohio State U.	BRINGING KNOWLEDGE TO LIFE
Princeton U.	IN THE NATION'S SERVICE AND IN THE SERVICE OF ALL NATIONS
Roosevelt U.	GREAT MINDS UNLEASHED
Rutgers, the State U. of New Jersey	JERSEY ROOTS, GLOBAL REACH
Saint Edward's U.	LEARN TO THINK
Seattle Pacific U.	ENGAGING THE CULTURE, CHANGING THE WORLD
Syracuse U.	INSIGHTS INCITE CHANGE
U. of Alabama	EMPOWERING MINDS THROUGH SCIENCE
U. of Baltimore	KNOWLEDGE THAT WORKS
U. of Central Florida	REACH FOR THE STARS
U. of Florida	FLAGSHIP FOR DISCOVERY
U. of Florida	SOLUTIONS FOR YOUR LIFE
U. of Maryland–Baltimore	REAL-WORLD THINKING WORLDWIDE REACH
U. of Pennsylvania	WE'RE ALL BUSINESS
U. of South Florida	TURNING RESEARCH ON EDGE
U. of West Florida	LEAP TO LEAD
U. of Wisconsin	SEARCHING FOR EXCELLENCE AND DIVERSITY
Vanderbilt U.	DISCOVER THIS PLACE. SHAPE YOUR WORLD.
Wichita State U.	BIGGER OPPORTUNITIES. BIGGER REWARDS.
Wilkes U.	THE POWER OF INDEPENDENT THINKING
Winston-Salem State U.	IMAGINE POSSIBILITIES. REALIZE SUCCESS.

the public good, colleges and universities effectively are asserting some form of ownership in them. The very broad-based, public-serving qualities, goals, and aspirations that some members of society may have for higher education as a whole have been branded, protected, and claimed as their own by certain institutions.

Considered together, these trademark-protected slogans mirror popular conceptions of higher education as a vehicle for personal and social transformation, as well as an agent of collective and individual service, leadership, and fulfillment. Many of these qualities are not new values or aspirations for this sphere. Some of the slogans even seem to reflect a conscientious effort by institutional leadership to define and promote to targeted audiences the historically valued aspects of their institutions' identities. Other slogans seem to represent more-recent recalibrations of institutional culture and identity in favor of neoliberal objectives and free-market ideologies.

In either instance, by formulating these slogans and then protecting them through trademark law, colleges and universities are harnessing the power of brands to position themselves in the marketplace. No longer does an institutional name alone convey adequate meaning to potential consumers, for elite and non-elite institutions alike. Colleges and universities, in fierce competition for students at home and abroad, choose to use trademark-protected slogans to make themselves stand out—not only to paint a picture of who they are for internal constituents, but also to present to the world how they would like to be seen.

Keeping Secrets

Before he became an associate justice of the United States Supreme Court in 1916, attorney and scholar Louis Brandeis wrote, in an article for *Harper's Weekly*, that "sunlight is said to be the best of disinfectants."[100] So it was in higher education, at least public higher education, for much of the twentieth century. In recognition of the position of colleges and universities in the public sphere, the public had a right to know about the nature of their activities and undertakings. After all, states and the federal government were the largest

sources of their funding, after tuition dollars. The right to know came in various forms: the press seeking information to help further news stories; students obtaining nearly unfettered access to data sources for purposes of scholarship; and the general public expecting that most aspects of public higher education were legitimate subjects of public inquiry and interest, even if that meant relying on public records and other sunshine laws to obtain desired information. In short, the public's trust in public higher education was tethered to the concepts of access and transparency.

As the funding sources for higher education have changed, and public higher education's relationship with government has deteriorated in most states, some public universities are turning their backs on this history of openness and sharing, relying on trade-secret laws to erect and enforce barriers between their institution and the public.[101] These efforts not only represent caving in to the private-rights allure of intellectual property, they also signal institutional interest in developing a marketplace presence as a corporate entity, a commercial partner that can be trusted not to divulge secrets to a prying public, unless forced to do so by law. Recognition of the powers of trade secrecy is central to this movement, and notions of public commitment and transparency risk being toppled by the pursuit of brands.

Trade secrets are essentially the opposite of patents (see chapter 2). Whereas patents recognize and reward public disclosures of inventions, trade secrets reflect private decisions not to share valuable information with others. If we think of patents as having the potential to contribute to the public's storehouse of knowledge, patent law operates against a status quo governed by trade-secret laws, which recognize and reward selfish tendencies.[102]

In light of these qualities, discerning the secrets that higher education is keeping is not easy. No searchable database of trade secrets exists, let alone a listing of all trade secrets claimed by and hidden within colleges and universities. Furthermore, because the public is less familiar with what constitutes a trade secret (compared with, say, a copyright or a trademark), news outlets may not be equipped to pursue this story angle. Perhaps the most compelling reason why the

public scarcely hears of or considers trade secrets in higher education is because the very concept challenges conventional wisdom: why would public universities seek to hide information about their operations from the public? After all, even public-employee salary information is available and searchable online. What kinds of information could universities possibly be harboring that are more confidential than the salaries of their professors, presidents, and football coaches?

A few cases and news stories provide glimpses into the nature of higher education's secrets and why institutions are keeping them. The first segment dates back to the 1980s, when students began requesting information from their universities about the research that faculty members were conducting. For example, in 1989, the Students for the Ethical Treatment of Animals group at the University of North Carolina–Chapel Hill (UNC) sought information from their institution about the use of animals in scientific experiments conducted there. UNC refused to provide the requested items, claiming trade-secret protection. An appellate court ultimately rejected the university's stance, noting: "What type and how many animals are going to be used in a particular research project is not a trade secret, nor is whether surgery is going to be performed or the type of anesthesia used. Pre and post operative procedures are not trade secrets, nor is how the animals' pain and discomfort is to be minimized, nor the method of euthanasia."[103]

More recently, a court came to the opposite conclusion in a similar case. In 2008, the Supreme Court of Mississippi upheld Mississippi State University's decision to withhold information about the university's contractual relationship with Iams, the pet food company, as it pertained to live-animal research. The court held that information of that kind fell squarely within an exemption in Mississippi open-records law that permits higher education institutions to withhold "confidential commercial and financial information of a proprietary nature"—not just trade secrets—developed "under contract with a firm, business, partnership, association, corporation, individual, or other like entity."[104] Rather than permitting a public institution to

have a choice in whether to reveal such information, Mississippi's law actually insists that such information "shall not" be disclosed.[105] Some have argued that colleges and universities should indeed claim trade secrecy in situations like this one, in order to encourage industry sponsorship of academic research that could lead to breakthroughs that benefit the public.[106]

At first glance, this trend may seem deleterious to the public interest. A complicating factor, however, is that cases of this sort typically involve an institution claiming trade secrecy in support of a respected value—academic freedom—which is of great interest to the public. In fact, in the case involving UNC, the university made that position explicit: it chose to withhold the requested information about live-animal research out of fear that releasing it could cause a "chilling effect" on faculty research.[107] Although the court ultimately rejected that argument—and appropriately so, given how innocuous the requested information from UNC actually was—we should appreciate that some political agendas go too far in subjecting higher education's activities to far-reaching examinations. Recent efforts to unearth years of emails from a climate-change scientist at the University of Virginia, as well as emails relating to the affiliations of a conservative scholar at the University of Kansas, are but two examples.[108] Colleges and universities are acting properly when they resist divulging information that would form part of political witch hunts. Doing so might only make other academics and their research sponsors think twice before pursuing a potentially controversial research subject, for fear of triggering an onslaught of invasive information requests.[109]

If these were the only situations involving trade secrets in higher education, the story would end here. But a second, more recent set of cases and controversies involving trade secrets exists, and is detrimental to the public interest, as the justification for claiming trade secrecy in these situations is more commercial than academic. The scenarios typically involve institutions seeking to withhold information from the public on the grounds that donors will be upset if the information is disclosed, or that corporate partners or friends of a college or a university expect anonymity and will resent their

names or the nature of their relationship with the institution being revealed.

One early case involved California State University, Fresno, and its construction of a multimillion-dollar, multipurpose arena, the Save Mart Center, named for its largest corporate donor. A local reporter sought the names of the companies and individuals who had signed license agreements to lease luxury suites in the arena, as well as copies of the agreements themselves. The university resisted divulging this information, claiming that it was proprietary and that its disclosure would be contrary to the public's interest. Fortunately, a California appellate court disagreed, ruling that the requested information had to be released.[110] Although trade secrecy was not the legal basis for the university's unavailing defense in that case, the concept that some donor information is valuable information, and should be shielded from prying eyes, has since taken hold at other institutions, with trade secrecy emerging as the leading grounds for legal defense.

The University of Connecticut (UCONN) attempted to claim trade secrecy regarding databases that were related to the institution's educational, cultural, and athletic activities. In 2008, Jonathan Pelto submitted a freedom-of-information request to the university, seeking the disclosure of certain information he believed UCONN was maintaining. The data he sought included the names, addresses, telephone numbers, and email addresses in (1) the athletic department's database of season-ticket subscribers, (2) the university auditorium's database of full-season subscribers, prospective subscribers, and individual-event ticket buyers, (3) the university's continuing-education database of persons having an interest in its programs and course offerings, and (4) the library's database of donors and friends. Pelto wanted this information so that he could create "an advocacy organization to help persuade legislators, public officials, and the university's board of trustees to provide the university with proper support."[111]

UCONN is a public institution in Connecticut and is subject to the provisions of state law that require it to divulge public records unless the disclosure of such records is otherwise prohibited by law.

For example, a nosy reporter, looking for a story, could not make UCONN release the transcript of any student without that student's permission, as the federal student-privacy law known as FERPA prevents the disclosure of student "education records" in most instances. Most other requests for information that do not pertain to student education records or personnel matters, however, must be fulfilled.

UCONN resisted Pelto's requests for information, relying explicitly on trade-secret laws to do so. Connecticut's freedom-of-information law allows state agencies to decline to release information if the agency believes it constitutes a trade secret. State law defines trade secrets as "information, including formulas, patterns, compilations, programs, devices, methods, techniques, processes, drawings, cost data, customer lists, film or television scripts, or detailed production budgets that (i) derive independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from their disclosure or use, and (ii) are the subject of efforts that are reasonable under the circumstances to maintain secrecy."[112] UCONN argued that the information Pelto sought constituted customer lists that were protectable as trade secrets within the meaning of this exception.

A lower court rejected this argument, ruling that UCONN is not engaged in trade, but rather in education, and therefore could not maintain a trade secret. This rationale was motivated by the court's understanding that the trade-secret exemption in the state's freedom-of-information law was intended to protect *third-party trade secrets* maintained by a state agency—the exemption did not suggest that state agencies could independently create and claim their own trade secrets.

The Connecticut Supreme Court disagreed with this reasoning, as other courts in other states have.[113] The higher court ruled that the focus of the case should be on whether the information UCONN sought to withhold met the definition of a trade secret, not whether the university was engaged in trade. Even though Connecticut's freedom-of-information law, in the words of this court, "embodies a

public policy in favor of disclosure," it concluded that UCONN's trade-secret claim was consistent with the legislature's intentions. The court ruled that the university did not have to provide information in response to three out of four of Pelto's requests.[114]

UCONN's position—that the university's business is nobody's business—reflects a new way of orienting the functioning of public higher education, making public colleges and universities seem more like businesses and less like state agencies. By taking this stance, UCONN and other institutions show industry their willingness and aptitude to engage in commerce, as they have learned to use trade-secret laws to gain an advantage in the marketplace.

Another example is the effort by Purdue University, a public university in Indiana, to keep the nature of its contractual relationship with Amazon.com a secret. In 2015, the university entered into an agreement that allowed the online retailer to open a staffed customer-order pickup and dropoff location on Purdue's campus. When a trade association of college-store operators sought access to the terms of the contract, the university reluctantly provided it, but deleted key portions of the contract that Purdue claimed were trade secrets.[115] The trade association subsequently sued the university for access to a version of the contract that did not have various portions removed, hoping to obtain "as much information as we can about an important arrangement for the industry and for students, to understand the most they can about it."[116] While Purdue is an educational institution, and thus a site of learning, claiming trade secrecy in this instance was a way of saying that learning about the functioning of the university as a business is off limits, no matter who stands to benefit.

In a meta-example of higher education's movement toward brands and secrecy, the University of Akron—a public institution—recently claimed trade-secret protection in marketing studies it conducted as part of its effort to brand itself as "Ohio's polytechnic university." The university paid over $110,000 to four different companies for the marketing reports, but it was unwilling to disclose their contents. As a public-records expert was quoted as saying at the time: "Why is it bad for Youngstown State, another arm of the state, to know [what

is in these reports]? Aren't they just other arms of the state for the most part?"[117] Good question.

As colleges and universities resort to trade-secret laws to shield details of certain of their activities from the public, they show prospective funders their willingness to keep secrets when building brands and forging commercial partnerships. For example, publicly supported Utah State University (USU) renamed its football stadium in 2015. The facility's old name, Romney Stadium, honored the legacy of a former football coach at the institution. The new name—Maverik Stadium—recognizes the financial contribution of Maverik, a chain of convenience stores across ten western states. The university initially refused a request to release documents pertaining to the naming rights of the stadium to a local newspaper, claiming trade-secret protection. When the newspaper challenged that decision in court, the initial ruling was in the newspaper's favor, and Maverik and the university considered an appeal. Fortunately, USU and its corporate sponsor changed course. They decided to disclose the naming-rights agreement rather than appeal the decision, even though the university "strongly believes" the law did not require it to do so. The agreement revealed that Maverik ultimately would pay the university $6.3 million over twenty-two years to have its name on the stadium and receive some additional perks—such as being named the "official gas station and convenience store of Utah State University Football"—in exchange for this fee.[118]

Comments made at the time by Maverik's vice president for marketing help explain the lure of trade secrets to universities like Utah State: "We like to partner with people who are all about adventure and excitement and we felt like football stadiums all fit into our brand. We think it's a great way to connect with students, alumni, and fans at USU, so we're excited about it."[119] Brand alliances in higher education are nothing if not exciting, and apparently secrecy adds to that thrill.

Other higher education institutions may be more bullish in their refusals when asked by the public to divulge what should be public information. For example, in 2014, Ohio State University (OSU)

entered into a ten-year, $17.1 million contract with Nationwide Insurance, naming the company as the "official insurance sponsor for the university community." Around the same time, in a $12.05 million deal, OSU also chose Lids Sports Group as the "official headwear retailer of OSU." OSU provided copies of both contracts when a newspaper asked for them, but all financial and other numerical details were missing, unlike other sponsorship contracts the newspaper had requested and received from OSU before, which came in a complete and unedited form. An OSU spokesman called the withheld information "business trade secrets of OSU that the university is permitted to protect under the law."[120] Concern for what Nationwide and Lids Sports considered proprietary, sensitive, and even secret business information also played a role the decision, the spokesman said.

These stories help show how colleges and universities are turning to trade secrecy to help further the brand interests of others. In doing so, institutions of higher education position themselves as attractive commercial partners, set apart from the public sphere, despite their historic placement in it. In short, knowing the importance of keeping secrets has emerged as a brand of its own in public higher education.

Private Rights, Public Goods

The pursuit of brand can be intoxicating. In the crowded and increasingly national marketplace for higher education, institutions fight for fame, recognition, and riches. Corporate sponsorships, licenses, and affiliations are attractive in this landscape, not only for the attention they bring in and of themselves, but also for the signals they send to future students, their parents, and alumni. Brand represents a negotiated identity, and colleges and universities in fierce competition with one another sense that they cannot risk being complacent in matters involving self-identification and self-promotion.

As this chapter has shown, intellectual property and related legal principles and rules have played formative roles in helping higher education harness the power of brands. Trademarks drive TTO naming decisions, the pursuit of additional online space, and the coining

of institutional slogans. For years, seizing the monetary and other values in student publicity rights has fueled a brand-burnishing effort, centered around collegiate athletics. Capturing and claiming trade secrets has become perhaps the newest way to attract businesses, by acting like them.

All of these efforts and initiatives come at a cost to society. Overclaiming trademarks leads to the unnecessary creation and potential enforcement of commercial rights. Values siphoned from students' publicity rights come at the expense of justly compensating those whose hard work and dedication should earn them compensation, not just recognition. And wielding trade secrets as a buffer against public inquiry and knowledge degrades the public's trust in higher education, signaling the latter's shifting allegiances to corporate shareholders over the public at large.

The overprotection of intellectual property by colleges and universities, as illustrated in this chapter, should be viewed with skepticism and concern. Although the harms associated with this tendency may sometimes be difficult to quantify, they are no less real.[121] Higher education's historic brand was as a marketplace of ideas, a place intentionally removed from the sphere of commerce, so that the search for ideas and the pursuit of truth could be unfettered, and knowledge could flourish. That vision of higher education is a shared one, based on access, openness, freedom, and transparency—principles that are threatened by the over-accumulation of intellectual-property rights in the service of brand initiatives.

To cherish and adhere to that vision requires brand consciousness, but not of the kind we have been witnessing. Unless higher education, as a sector, is willing to look and act differently than business in its treatment of intellectual property, the esteem of a collective public will continue to dissipate, perhaps to the point of being forever lost. In a fitting twist of efforts and realities, resisting the pursuit of brand is itself a brand, and the one that higher education should work to reclaim.

Chapter Seven

Private Rights in the Public Interest: A Path Forward

Higher education faces enormous challenges. It needs to fulfill its promise of social mobility for students from diverse and nontraditional backgrounds. Rising tuition costs have resulted in an entire generation emerging from college with student-loan debt that can seem insurmountable. State support for public institutions is declining. Calls for colleges and universities to contribute to local economies through job creation and workforce development are rapidly mounting. A growing administrative class in higher education often only adds to bureaucracies and mounting costs, instead of alleviating them. Colleges and universities increasingly rely on adjunct (contingent, or non-tenure-track) professors to teach core subjects, leading to a dwindling stable of tenure-stream faculty. These institutions also face urgent needs to comply with governmental regulations, often in areas—such as the U.S. Department of Education's "Dear Colleague" letter regarding Title IX of the Education Amendments of 1972 (requiring every educational program that receives federal funding to respond promptly and effectively to allegations of sexual violence against students)—where they are virtually guaranteed to upset someone, no matter what they do.

Amid these very real concerns, the way colleges and universities treat intellectual property may seem to deserve less attention, as the consequences of failing to take concerted action can seem distant, or not even be apparent, to decision makers at these institutions. Yet the treatment of intellectual property has never been more important to higher education than now. As the United States moves further toward an information- and knowledge-based economy, the impetus

to lay claim to intangible intellectual outputs is increasing. Thus colleges and universities, as the originators of much of this production, face a critical decision: will they resist the temptation to seek out and amass rights in ways and areas that run counter to higher education's purpose—to serve society before serving itself—or will they succumb to the pressures to generate revenue in ways that might forever alter their fundamental values and historic orientation toward the public?

Instead of turning to intellectual property as a legal means of obtaining power, higher education would be better served by looking at it more cautiously—and more academically—as an illumination of what that power can lead to.[1] Every policy put forth and each right claimed ought to be defensible; every decision to act or not act should be acknowledged as such; and each college and university must recognize that matters of intellectual-property policy are too important, and too fundamental to the essence of their institution, to be left solely in the hands of lawyers.

This chapter reviews the key problems regarding how colleges and universities are behaving in the various dimensions of intellectual property and its allied areas discussed earlier in the book, offering workable solutions for bringing laws and institutional behavior more in line with the public interest. In short, this chapter outlines a path forward for how legal and policy changes involving intellectual property could be implemented, so higher education might better use private rights for the public good.

Stopping the Accretion: Bringing Sanity Back to College and University Trademarks

Chapter 3 told an alarming story about the accumulation and enforcement of trademarks. What started as a natural and understandable method for colleges and universities to protect their identities, and generate revenue in the process, has grown into a mammoth activity, with important policy ramifications. Seemingly overlooked by these institutions in their wide-reaching accretion of trademark rights is higher education's role in society, serving as an open and

public sphere where private rights, such as federal trademark registrations, should be utilized sparingly, and then only to further the most compelling of public interests. When colleges and universities seek and obtain trademark protection in expansive and unnecessary ways, they lay claim to words and devices in a manner that threatens to diminish, rather than maintain, a vibrant public domain. Because trademark registrations grant certain rights to commercial uses of words, mark holders and the public often mistakenly think that these rights confer ownership for the words themselves. This misperception tends to promote risk-aversion behavior and stifle what otherwise should be open expression. Determining when a mark is confusingly similar to another, or distinguishing between impermissible commercial uses of a term and fair uses of it, are complicated legal questions.

We should not want—or expect—institutions of higher education to seek private rights for uses of language that describe or promote educational services or represent attempts to solve community concerns. These forays clutter the linguistic arena and are creating a growing blizzard of marks in higher education. Fueling the storm are the hypersensitive image-consciousness of colleges and universities and their mistaken belief that any pet phrase needs protection, generally in the form of a trademark registration. Unfettered speech—long considered a hallmark of academia—is highly likely to be buried under drifts of regulated intellectual property unless these institutions change course.

Some may reject these premises by arguing that, similar to a publicly traded corporation's duty to shareholders, colleges and universities bear a weighty responsibility to the public to protect their assets, whether tangible or intangible. This argument has force, but it overlooks the inescapable root problem, which is of higher education's own making: many institutions are staking out claims to aspects of their identity that instead should be kept freely available. Colleges and universities should not be stockpiling registrations in their trademark portfolios. Unlike for-profit companies, higher education institutions operate without any prospect of a

buyout that would be made more attractive by an arsenal of trademarks.

Stopping this accretion and bringing sanity back to college and university behaviors regarding trademarks will take dedicated work. Every higher education institution needs to start by identifying which trademarks are truly crucial to its mission. In other words, which trademarks protect the primary identity and essence of the institution? The answer is likely to be an array of formal and abbreviated names, logos, and insignia. Federal trademark registrations for these items are advisable, and often necessary. Trademarks for programs, slogans, and products developed at a college or a university to address public-health and safety needs are likely to be further afield. These are less-often necessary to protect any internal or popular conception of what it is that the institution does and, in some instances—particularly where they lay claim to some aspect of the public good—may not even be defensible.

As part of this conscientious exercise, colleges and universities should place a primary emphasis on protecting trademarks that create licensing opportunities, instead of ones merely offering avenues for enforcement. Licensing, however, should have some clear connection with the institution, other than merely reflecting a product, service, or idea that emanated from it. Licensing opportunities may abound if what is sought are generalized and broadly based trademarks, such as "bioflex" for scientific research, or "the premier online high school" for high school educational services. Yet what links these marks, in the public's eye, to higher education, let alone to a particular institution? Colleges and universities should seek to protect what we would expect them to protect and not venture into registering marks whose primary association with the institution will only be apparent when an attorney drafts a cease-and-desist letter.

Colleges and universities should decline to aggressively claim ownership in trademarks that suggest a removal of teaching, scholarship, and research activities from the public sphere. Institutions of higher education receive tax subsidies and other preferential treatment precisely because they undertake scholarship and research for

reasons that do not translate into a return on investment, at least in the quantifiable sense that stockholders of for-profit corporations expect. To a large degree, the general public, that is, the people, are the stockholders in nonprofit higher education, and colleges and universities should not be in competition with them. By parceling out and asserting rights to fundamental aspects of their teaching, scholarly, and research activities, institutions of higher education are abusing their historic pact to pursue those activities for the benefit of everyone, not just those who pay a licensing fee for the privilege.

All of these suggestions raise a common question: when is federal registration of a mark actually necessary for colleges and universities?[2] What may be a best practice for a for-profit company looking to dominate a given market by using a catchphrase or slogan should not dictate the behavior of higher education institutions. Colleges and universities do not operate in hopes of a merger, purchase, or sale that would entail transferring trademark rights, free and clear, to a new owner.[3] Most are not start-ups looking to make a name for themselves, nor does every higher education institution attract students from all fifty states. Although the competition between colleges and universities for students is generally fierce, institutions supported by and intended to benefit the public should not pursue marketing advantages that come at the expense of cluttering the marketplace with excessive and needless assertions to rights.[4]

These proposed initiatives deserve thoughtful consideration by every college and university that claims rights for a trademark. They also merit implementation. Antitrust worries may prevent higher education institutions from *collectively* agreeing to play by the rules sketched above, but nothing prevents the development of points to consider, or other advisory documents, that institutions publicly could endorse and profess to follow. At a minimum, colleges and universities should

- register only "mission critical" trademarks;
- favor the registration of trademarks with clear or apparent ties to their institution;

- place primary importance on registering marks that the institution plans to use well into the future, or that present legitimate and natural licensing opportunities;
- register trademarks for their institutional value, never for their enforcement value; and
- decline to assert ownership for or seek registration of trademarks that suggest the removal of teaching, scholarship, or research functions from the public sphere.

As part of preparing or endorsing these suggested practices, colleges and universities should make their trademark holdings—whether registered or unregistered—easily publicly accessible in a single place on their institutional websites. A public listing of their owned trademarks could be seen as a commitment to transparency, as it would allow the public and other constituents to learn about the boundaries and limits of the college or university as a commercial, corporate entity. Secrecy and obfuscation have no legitimate roles to play in this arena, and a widely and easily accessible list of a college's or a university's ownership rights for specific marks is likely to discourage that institution from asserting claims of infringement on unlisted rights or on listed rights in situations where there would be negligible confusion or a marginal threat to its interests—for example, attempts to squelch lewd speech that administrators find objectionable for its potential to bring their college or university to mind in some way. Institutions should relinquish rights that never should have been claimed or that no longer make sense to maintain because of their unlikely ability to further legitimate educational and research interests.

College and university attorneys might oppose this proposal, precisely because this level of transparency could effectively stymie or hamper an institution's future enforcement efforts. Yet two of the main points of chapter 3 are that amassing trademarks has a bearing on educational policy, and that the ramifications of trademark activity in higher education are too important—not merely too legal or too specialized—for other stakeholders within higher education to cede all decision making in this arena to lawyers.

Unfortunately, college and university trademark activities seldom capture the concerted attention of higher education policy groups or commentators, in part because of the mistaken assumption that such activities begin and end with athletics. This obstacle must not prevent a long-overdue discussion and hinder subsequent actions aimed at creating sensible trademark norms in higher education. Trademark rights do not have to last forever. Colleges and universities choose which trademarks to register and which to maintain. At present, the choices are many, but the guiding principles seem to be few. It is time to encourage institutions to regain the public good in higher education, and release college and university trademarks that lay claim to important parcels of the public domain, before it is too late.

Contrary to prevailing beliefs, the choices colleges and universities make regarding which trademarks to protect and enforce is no trifling matter. These decisions are important—too important to be overlooked or written off as merely reflecting the nature of higher education in the twenty-first-century marketplace. If we, as a society, expect higher education to further the public good, we must expect its leaders to do more than simply allow trademark accretion to run its course. To thoughtfully manage and control colleges' and universities' relationships with trademarks is to ensure that higher education remains a vibrant site of discourse, and culture, that benefits us all.

Patent Law Made University Friendly

Universities are inextricably linked with the creation of intellectual property, and patenting and commercialization are activities that, in many ways, are situated at the crossroad of their mission to disseminate knowledge and their countervailing need to seek revenues. As diminishing state support for higher education has fueled colleges' and universities' ever-expanding search for revenues to underwrite their missions, many view patenting and technology transfer as potentially lucrative sources of income for cash-strapped institutions. The perceived benefits of technology transfer have led some policy makers to think of colleges and universities as engines of economic

growth. Their role in driving this form of development is expanding as American society continues to confront significant and enduring financial challenges that are causing the public to reevaluate its covenants with, expectations of, and funding for higher education.

Yet universities that are active in the technology-transfer sphere face extraordinary difficulties as they strive to keep pace in the rapidly expanding world of patents and patent law. The stakes are high, the guideposts are few, and, unfortunately, the prospects for success—however defined—seem low. Institutional successes in this sphere are unlikely, in part because patent law is unforgiving and insensitive to higher education's unique role and purpose in society. Patent law does not distinguish between university patentees and other patent owners. Moreover, as institutions of higher education have adopted commercial practices and trappings, federal courts have been all too willing to treat them as no different from any other patent owner, despite occasional pleas for preferential treatment that go unanswered. As Peter Lee observed, "Whereas uniquely 'academic' norms, practices, and policies justified exceptional treatment of universities in earlier generations, modern courts view universities as much more akin to commercial entities."[5] Live by the sword, and die by the sword. As courts have rejected these calls for treating universities differently, an implicit message has been transmitted to the higher education community: institutions intending to capitalize on their patent portfolios must adopt the practices that have led commercial firms to succeed in this arena.[6]

This message, regrettably, sends universities on a fool's errand. By definition, nonprofit, public-serving institutions cannot compete effectively in the modern landscape of patents and patent laws. The terrain is costly and complex to navigate, not to mention rife with ever-evolving, sharp marketplace practices that are not conducive to nonprofit norms. As chapter 4 described, higher education's unflinching support of patent reform, its engagement in infringement litigation, its experimentation with patent trolls, and its resistance to transcending the traditional views of the Bayh-Dole Act all illustrate

how adrift, and even inept, most universities are when forced to play in this demanding arena.

The answer to these problems is not that universities should stop innovating or engaging in technology transfer; we need them to continue their groundbreaking research. Rather, the rules and expectations of their involvement with technology transfer should change. The extent to which universities are making poor choices here largely reflects the constrained set of options they (or, rather, some of their decision makers) believe they have to pursue. The entire model for university engagement in technology transfer therefore needs to be reformulated, which will require amending existing laws as well as revising institutional policies. Moreover, these legal changes should drive much needed policy shifts.

Patent laws need to recognize that university patent owners are not the same as all the rest. They are not patent trolls, but neither are they biotech firms, pharmaceutical corporations, or the Ford Motor Company. Instead of turning to the business sector to lead the charge, which inevitably results in revising patent laws in ways that favor industry, the higher education lobby should be standing on its own, demanding that Congress recognize that universities are exceptions to the norm and amend patent laws to be sensitive to this sector's noble purposes and high aspirations. Universities need more freedom, more choices, and legal mandates to behave in ways that encourage their disinterest in the marketplace. At present, we expect them to do the impossible: compete and excel in the rough-and-tumble world of patents and patent laws, while generating revenue but not overriding the public good.

One revision that Congress should implement is to remove any legal requirement for universities to participate in patent-infringement lawsuits with their exclusive licensees. This may seem an odd place in which to start reform efforts, given that universities should be reluctant to offer exclusive licenses in the first place, but legal actions of this nature accounted for nearly 70 percent of all patent-infringement lawsuits involving universities from 1973 through 2014. These institu-

tions should be in the business of supporting innovation, not litigation, and changing the patent laws would help keep it that way.

University involvement in patent-infringement litigation impacts an institution in important and noticeable ways, as chapter 4 described. This type of activity is a costly undertaking for any party involved in it, even for universities that are paying only a portion of the total cost, whether out of pocket or set off against future royalties from their licensees. Patent litigation has a tendency to drain the productivity of TTOs, and it often brings with it delicate political issues that can impact university relationships with important funders or supporters, whether public or private, not to mention damage the public's image of universities as purveyors of unbiased knowledge.

For these reasons, if not for others, Congress should revise patent laws so universities could continue to enjoy the upsides of patent ownership without the pronounced downside of occasionally having to assertively pursue patent infringers in court. From a policy perspective, in many ways this proposal picks up where the CAFC leaves off. Unwilling to loosen the strictures of patent laws as they apply to higher education institutions, the CAFC, as early as 1987, noted and rejected efforts by at least one prominent university "to have its cake and eat it too, i.e., to act in a noncommercial manner and yet preserve the pecuniary rewards of commercial exploitation for itself."[7]

What the CAFC determined patent laws did not permit is precisely what these laws *should allow* if we want universities to use their research capacities to improve society to the fullest. Legislative revisions to patent laws could offer these institutions a way out of assertive infringement litigation without upsetting other important balances struck in the technology-transfer system. For instance, in exchange for ceding patent-enforcement authority to their exclusive licensees, colleges and universities would no longer be required to participate in infringement actions involving those patents. If an institution declined to join its exclusive licensee in a lawsuit against a specific party, it would be prohibited from suing that party for the

same alleged act of patent infringement at a later time. Thus universities would retain the *option* to join infringement lawsuits brought by their exclusive licensees, but would avoid the *obligation*.

This proposal for amending patent laws better aligns university aptitudes with societal expectations. Most universities are poorly suited for initiating litigation regarding their patents, no matter what their motivation for doing so, and both these institutions (as owners and licensors of patents) and society (which funds them and their research activities) suffer as a result of this inefficiency. In most instances, shifting the legal burden of patent enforcement to exclusive licensees would do little to disrupt the current relationship between exclusive licensees and university patent owners, at least with respect to patent-infringement lawsuits. Companies that license patents typically are more accustomed to assertive litigation than universities. Regardless of any actual past experiences they have had in court, commercial licensees, as a sector, are better situated—financially and strategically—to deal with lawsuits. Legal actions involving university-owned patents still would be undertaken, but without the mandated involvement of the universities themselves, which would be freed to pursue more historically defined activities that further their research missions.[8]

At its core, this legislative proposal would relieve universities of the expense and distraction of having to pursue patent infringers in court. Instead, they could redouble their research and commercialization efforts and focus more energy on innovation. This change would better align university activities with traditional societal expectations for the research these institutions conduct, and it would do so without compromising their increasing focus on partnerships within the marketplace or undermining their encouragement of inventiveness. In short, my proposal recognizes that letting exclusive licensees litigate, while universities innovate, better serves the public good.

This suggested revision to the law would only address those instances when a university is faced with joining an exclusive licensee (or co-owner) as a plaintiff in an enforcement action. It would not

apply to patent infringements where a university either has not licensed the patent or has licensed it nonexclusively. But this limitation is also one of my proposal's strengths. If universities had more freedom of choice about whether to join an exclusive licensee's patent-enforcement actions, "But the law makes us do it" would no longer be a technically accurate statement in defense of all university decisions to file infringement lawsuits. True choice by these institutions concerning their involvement in patent litigation would lead to greater accountability for their actions.

The second way the law should be revised is to explicitly state that if federal dollars support faculty research that leads to patent-eligible inventions, the faculty members who create them can determine who commercializes them, and on what licensing terms. Although the Bayh-Dole Act, as currently written, does not prohibit faculty involvement in such decisions, many universities have taken the position that it does and have refused to explore any model of technology transfer that does not rely on a fully staffed TTO to make nearly all the decisions involving licensing arrangements. Flexibility, not orthodoxy, should be embraced in patent-based technology transfer if the public is to receive the full benefit from faculty inventions. Faculty members should never face a situation where their institution proceeds with a licensing or commercialization plan that runs counter to their personal ethics or professional judgment.

Choices have a way of spurring competition and innovation. Some universities may find that their TTOs have little to offer faculty inventors in this new environment—for example, the personal relationships of TTO staff at an institution with relevant industries may be weak, and their ability to raise funds or negotiate reasonable licenses might be limited. Faculty members should be permitted to look elsewhere for commercialization assistance in such instances—whether to other TTOs or to third-party providers. As long as these inventors do not license the patent to a troll or another entity with no intention of legitimately commercializing it, few limits should be placed on whom faculty members can partner with to create useful applications of their inventions.[9]

Universities that are unwilling to fully subsidize the cost of building, maintaining, and defending patent portfolios in this new environment would have several options. One would be to decline to claim ownership for inventions they do not consider promising, releasing them back to their faculty creators to commercialize on their own. Another option for a university would be to claim ownership but require the inventor to pay some or all of the patenting costs up front, in exchange for the institution accepting a reduced royalty rate. A third option would be to assign patent ownership to an organization legitimately dedicated to managing the inventions of university scientists (not a patent troll), which even the current formulation of the Bayh-Dole Act permits.

This last option leads to my third proposed change in the existing university technology-transfer model, which is the reemergence of licensing consortia. Every university does not need its own TTO, and creating consortia along regional lines or based on areas of scientific expertise would be highly advantageous. Smaller institutions, with limited research budgets, might dispense with a TTO, and many larger ones could stand to scale back the ranks of their TTOs. These licensing consortia—which would serve functions similar to those performed by entities like the Research Corporation and University Patents, prior to the passage of the Bayh-Dole Act—would be in a better position to bundle university patents together and license them widely on a nonexclusive basis. Institutional intellectual-property policies would have to be rewritten to facilitate the transfer of patent rights to these consortia, which would be controlled by their member institutions. Although the institutions in a consortium would need to grant it ownership rights for inventions by their faculty members in order for the consortium to operate effectively, these individuals could choose whether to commercialize their inventions with that consortium, in line with my previous proposal. For faculty who decide to have a consortium manage their patent's commercialization, licensing revenues would be shared with the member institutions and the inventor, on the basis of each institution's contributions to the consortium's overall patent portfolio. Nonexclusive

licensing should be the norm for these consortia, which, as sole owners of university patents, would have the burden of suing prospective licensees that refused to obtain licenses covering their commercial activities.

The combined effect of these three proposals would be to pull individual universities away from competitive market practices, in which few are positioned to succeed. They would also serve to share more of the decision making and risks involved in patent licensing and commercialization with faculty inventors, in some cases downplaying or even eliminating the institution's role in these matters. TTOs would not be eliminated, but their activities would be drastically changed. By realizing economies of scale through consortia, universities would consolidate costs and be better protected against institutional risks and exposures. By being able to decline involvement in patent-infringement lawsuits with their exclusive licensees, universities would move into a world where their involvement in assertive legal actions over patents would be rare, instead of an all-too-common reaction that is justified as being a legal requirement. University patents would no longer be subject to a generate-revenue-at-all-costs framework, where TTO directors view patent-infringement lawsuits as a "necessary evil," and the lines between commercial and academic norms would be more firmly drawn. Finally, faculty members would have a better potential to play expanded roles in this new landscape, which would allow them to carry the public's interest in their inventions and discoveries into the marketplace.

From Claiming Copyright to Claiming Commons

Higher education resides in the public sphere and is intended to further the public interest. Colleges and universities best serve the public by protecting the intellectual freedom of the talented individuals that are a part of higher education and the valuable tangible resources that institutions possess, all of which can lead to innovation and new forms of knowledge, as described in chapter 5. For higher education to truly flourish as a repository and promoter of knowledge, however, individual institutions must temper their impulses to

restrict or claim the intellectual fruits of their faculty, students, and donors, which existing copyright laws and policies all too often allow them to do.

Higher education holds great potential to serve as a cultural and knowledge commons: a site where these resources are generally available for all to use and consume at a minimal cost. Doing so, however, will require devising different copyright parameters that apply to campuses. What we need are certain copyright exceptions—not simply ones permitting students and scholars ample room to make fair use of copyrighted works (which the law should allow), but others removing and prohibiting certain copyright-ownership barriers that threaten the long-term existence and vibrancy of higher education as a cultural and knowledge commons.

More ought to be expected of colleges and universities regarding copyright, but "more" does not entail an increase in ownership claims by institutions. Just the opposite should apply. These institutional claims to creative works generated by their students and faculty ought to be circumscribed. The questions of what should be and even can be owned in the cultural and knowledge commons of higher education are complicated, but they are not without answers. These issues must be definitively decided in favor of students and faculty and, ultimately, the public.

First, I propose that higher education institutions should be prohibited from laying claim to the copyrightable works authored by their students, as well as from allowing third parties to extract copyright assignments from students as a condition of their enrollment in or completion of a course. Second, institutions should be barred from exerting ownership claims over the copyrightable scholarly works of their faculty, including courses and course components, unless a faculty member voluntarily signs an assignment agreement with the institution before the work's creation. Third, institutions should be prohibited from receiving cultural or knowledge artifacts from donors unless the giver agrees in writing to the following conditions: (1) by donating an object to the university, the donor is re-

linquishing any potential copyright claim he or she may have in that work; (2) the donee institution will make no copyright claim to the work or derivatives of it; and (3) both the donor and the donee intend for the work to enter into the public domain, as long as copyright for it is not owned by a third party. These restrictions could be adopted as a matter of law, through amendments to the Copyright Act and the Higher Education Act, or voluntarily, through changes in institutional policies.

Silence or ambiguity on the applicability of institutional intellectual-property policies with regard to students should not be an invitation to claim ownership or co-ownership in their works. Nor should a student's use of any university resource, participation in any sponsored project or competition, or receipt of any financial support from the institution result in an ownership claim by that institution or by a third party. Students who attend colleges and universities pay a hefty price for their educational experience, in part so they can be exposed to "substantial" and "significant" resources in many forms: expensive and elaborate equipment, specialized software, rare and valuable cultural objects, and leading experts in a number of fields. They also expect to be able to take part in institution-sponsored contests or events, and to apply for and receive funding in recognition of their scholarly and extracurricular pursuits. Exposure to these types of resources, and participation in these kinds of opportunities and events, ought to be seen as part of the higher education experience, not as interactions that may open the door to ownership claims by colleges and universities.

To eliminate any potential doubt, higher education institutions must be committed to and bound, whether by laws or by their own policies, by precepts that allow students to own everything they create as students, whether in the classroom, through exposure to university resources ("substantial," "significant," or otherwise), or on their own time. Furthermore, any time an institution of higher education employs a student, the presumption should be that nothing the student creates *while that person remains a student* is work made

for hire or otherwise subject to claims by the institution, unless the parties have entered into a signed agreement, before any employment begins, that specifies otherwise. Standard, more-general institutional policies should not be used to classify work generated by students employed by a college or university as work made for hire.

Additionally, institutions should get out of the business of requesting, requiring, suggesting—or even presenting the possibility as an option—that students waive, assign, or constrain in any way their intellectual-property rights as the price of admission to a course, whether that course is mandatory or elective. Students should never be made to feel as though they must hold back their ideas, lest their institution or an outside sponsor try to claim them. Laws, or their own policies, should prohibit institutions from permitting companies to extract these types of agreements from students as part of their coursework. If fewer firms are willing to sponsor problem-solving and capstone courses because of this prohibition, so be it. The public-serving nature of higher education breaks down when institutions willingly permit students in the classroom to become a captive source of free labor for businesses.[10]

Having faculty tell students that the latter can or should consult an attorney, proactively draft contracts to "agree to their roles," or be required to actively acknowledge or sign their institution's intellectual-property policy each semester have all been suggested as potential ways to clarify the ownership question, at least as it applies to students.[11] None of these possibilities is a good idea. They do not go far enough to protect what should be viewed as inalienable student rights, and they place the burden on students to understand or engage in dubiously beneficial contract negotiations. These practices continue to permit a mishmash of policies to exist, the application of which, in any instance, may hinge on definitional interpretations, slippery factual variances, and differing interpretations across institutional stakeholders. For higher education to fulfill its highest and best purpose as a cultural and knowledge commons, we must conceive of the learning experience as a transforming, unfettered intellectual exchange, not as the prelude to a rights contest or a power grab.[12]

My second proposal, concerning faculty and copyright, stems from most institutions' intellectual-property policies being both confused and confusing. Critical terms—such as "substantial use," "courses," and "traditional scholarship"—evade easy or even comprehensive definition amid rapidly developing new technologies. While most legal scholars would agree that faculty scholarship technically falls within the work-made-for-hire doctrine, even institutional policies that purport to allow faculty to hold the copyrights for their own scholarly works do not comply with the letter of copyright law, which requires signed copyright-transfer agreements. Meanwhile, developments like digital humanities are upending the traditional understanding of the kinds of work in which academics engage.

Faculty members' pursuit of new modes of research, teaching, and scholarship should not be repressed because of antiquated policies that fail to fully consider or adequately address the copyright-ownership issue in these new contexts. Even at institutions with policies that cede copyright ownership to their faculty, these policies do not grant an actual transfer of copyright for any given work. Faculty should not be lulled into trusting that their institutions will not take a special interest in new forms of creative endeavor or will not change their position regarding copyright ownership at a future date.

At the same time, most colleges and universities are savvy enough, and possess enough administrative staff, to determine which faculty members have the capacity or interest to create copyrightable works that the institution might feel it should own or co-own, given its investment in the resources required to assist in the creation or preservation of those works. For example, institutions of higher education have become aware of the profit potential in massively open online courses (MOOCs), as well as in distance learning in general. They seek and obtain copyright assignments from faculty in many of those situations, or at least obtain clearly defined licensing rights that enable the institution to continue to offer a MOOC, even if the professor who creates it leaves the institution.[13] Thus, if a college or a university has a particular financial interest in a work, or in the research and

teaching agenda of a given faculty member, the burden should be on the institution to obtain an individually tailored copyright assignment or licensing agreement from that individual, in advance of the work's creation.

My second proposal would do nothing to disrupt the presumption that institutions own the copyright for works produced by faculty members as part of their job duties—for example, self-study reports, committee notes, and other creative works that faculty commonly generate in carrying out their service functions for their institution. Any other creative work by a faculty member, however, would be owned by that person, unless an institution could produce an individualized and signed copyright-transfer agreement between it and the faculty member concerning the work in question. Any attempt to establish a copyright assignment after the work's creation would presumptively be null and void.[14]

This second proposal would eliminate any need for faculty to seek assurances regarding their creative rights from their college or university. No one would ever toil over determining whether certain uses of campus equipment or resources brought work by faculty members within their institution's right to claim ownership of it. At present, this happens all too frequently, particularly as institutions continue to tweak the wording in their intellectual-property policies to make them ever broader in scope.[15] My proposal would also diminish the possibility that, when students and faculty work together on projects, the institution and the student could end up as co-owners of any resulting copyright.

Innovations like digital humanities hold great promise for revolutionizing how students, faculty, and the world engage with scholarship. Creativity and an impulse to innovate must not be dampened by copyright concerns brought on by a kaleidoscope of policy considerations and legal uncertainties, all of which have a bearing on the ultimate question of copyright ownership. For higher education to realize its promise of serving as a cultural and knowledge commons of lasting importance, the prospect of any institutional claim of

ownership for faculty works must soon become a historical problem, instead of an ongoing concern.

My third and final proposal, involving library special collections, is motivated by a concern about some donors to those collections who wish to have their cake and eat it, too. On the one hand, they look to liberal tax laws that can provide financial benefits for those who make these kinds of donations.[16] On the other hand, donors often seek to tie the hands of recipient institutions, burdening them with the responsibility of custodianship but limiting who can access a work and how it may be used, either for the duration of the copyright or longer. Even if the donor makes no copyright claims for a work, the recipient institution might do so. For example, some colleges and universities seek to transfer a copyright from the donor to the institution in the deed of gift, or inappropriately claim a copyright for faithful reproductions of the donated objects made by the institution for preservation or archival purposes.[17] Donor or institutional copyright claims for special-collections materials threaten higher education's potential to serve as a vibrant cultural and knowledge commons, freely open to the public. Yet the prospect of profits and a human inclination to maintain tight control over artifacts instead of reasonably releasing them make these actions all too common.[18]

Student, faculty, and staff creativity involving special-collections materials is of value to an institution and should be encouraged. To that end, laws or institutional policies should prohibit academic libraries from (1) accepting gifts in which the donor claims a copyright or seeks to impose copyright-like restrictions on access to and use of the items, and (2) claiming copyrights for the donated materials or any derivatives of them, whether the latter are prepared by library staff, faculty, or students. While this proposal would not address the question of or prevent colleges and universities from accepting donations of objects whose copyrights are owned by third parties, or whose copyright status is unknown, at least it would eliminate an irksome and inappropriate barrier to what otherwise could be free and unfettered use of these donated objects.

My third proposal has intentional limits. It would do nothing to disrupt or transfer copyrights for books donated to academic libraries by publishers, corporations, alumni, or anyone else. Those copyrights would continue to remain with the books' publishers or authors. The proposal would, however, prevent famous alumni, or their estates, from restricting access to and use of their personal papers once these documents were donated to their alma mater, as well as prevent that institution from asserting similar rights on the basis of its ownership of those papers. The public's interest in and access to donated works to library special collections should not be subject to a donor- or institution-imposed embargo.

This third proposal would be a boon to faculty and students, who could use unrestricted works in campus collections in new ways—for example, by creating apps involving them, incorporating them into online courses, and making them accessible to the world through digital-humanities projects. Fair use should not have to be stretched to its limits to create a robust cultural environment on campuses. My proposal would help recalibrate the starting premises for what is available for use in campus libraries and firmly situate institutions of higher education as the leading repositories for works in the public domain.

One criticism of this proposal is that it risks saddling colleges and universities with the maintenance and preservation of the donated works and the attendant staff costs, while opening the possibility that others—namely faculty and students—could reap financial gains from their institution's special collections. This is a fair criticism, and one that prompts continued reflection over the degree to which society truly expects higher education to serve as an open site of culture and knowledge. Further investigation is also needed regarding the extent to which new donations affected by this proposal would result in institutions incurring any additional costs in caring for them, or whether costs that have already been borne (such as purchasing specialized equipment or additional physical space necessary for housing expansive collections) could cover these activities. This latter

criticism, by itself, is no reason to shelve the proposal, however. If data show that the anticipated costs for the maintenance and preservation of special collections are likely to rise, that increase could easily be offset by creating a compulsory royalty payment that would require anyone turning a profit from special-collections materials to return a fixed percentage of that revenue back to the college or university that owns the artifacts. Copyright laws already contain provisions for how to handle compulsory or negotiated royalty payments in other spheres impacted by these laws, such as the music industry, and there is no reason to think that this same concept could not be successfully implemented in the context of higher education special collections.[19]

Another criticism of this proposal is that it could result in fewer donations of valuable objects to academic libraries. A famous person's estate could decide to withhold a donation of personal papers to a college or university library because of the prospect of immediate open access to that donation. But that potentiality does not negate implementing my proposal. Academic libraries were never designed to be locked warehouses into which no patrons can venture, lest they create problems with the copyright interests and other limitations imposed by donors, and even by the institutions themselves. The public should not have to wait decades to receive the benefit of donations that many donors are gaining rewards from in the present, in the form of tax incentives. If prospective donors would prefer to hold, store, and preserve their valuable materials privately, in order to fastidiously control access to these items, then let them. The cultural and knowledge commons in higher education suffers less from donations that are withheld, and more from donations that come burdened and restricted by an excessive staking of claims to certain rights.

We must keep in mind that higher education stands to offer something invaluable to prospective donors in exchange for their gifts to special collections: public access to materials that can bring enduring life, meaning, and memory to the donor or decedent. After all, that

is why college and university libraries are of lasting value, as the sites of cultural and knowledge commons. Most prospective donors, whatever their collections, assuredly would rather be publicly remembered than privately forgotten.

All three of my proposals are similar, in that each envisions higher education as resisting the impulse to make institutional claims for copyrights, instead insisting that, as a special commons, colleges and universities have different priorities and are deserving of exceptional treatment in some specific matters of copyright law and policy. The first two proposals recognize the unique capacity of students and faculty to engage in creative undertakings that can benefit society, particularly through the use of new technologies. Potential copyright claims by institutions of higher education should not challenge the public good that would result from these activities. The third proposal seeks to remove access barriers that copyrights can impose on resources that should be freely available for the public's benefit and use. These three proposals are not without controversy, but each would ensure that college and university campuses fulfill their potential to serve as sites of vibrant discourse and largely unencumbered innovation, distinct from other areas of the cultural environment where restrictions and ownership claims abound.

The prohibitions envisioned in these three proposals could be carried out in one of two ways: as a matter of law, by Congressional amendments to the Copyright Act and the Higher Education Act, or as a matter of policy, by voluntary collective action, spearheaded perhaps by groups such as the American Association of University Professors or the American Council on Education. While revising the laws would be more effective in shaping the campus commons (for example, federal funding could be denied to any institution failing to comply with these new laws), I recognize that mobilizing Congress around such issues is an uncertain proposition. Whatever the route to implementation, laws or policies need to be reshaped if we want education to fully serve as a cultural and knowledge commons—a site marked by sharing, openness, and resource availability, distinct from the world of commerce.

Pulling Back from Brands

Chapter 6 surveyed the surprising ways in which institutions have used the principles and rules regarding intellectual property and allied areas—namely, trademarks, trade secrets, and the right of publicity—to further brand-building initiatives in higher education. That chapter identified and explored TTO name changes, college and university battles for cyberspace, institutional uses of student-athletes' names and likenesses, the proliferation of registered slogans, and institutional trade-secret claims. In each of these areas, if colleges and universities continue along their present paths by amassing private rights, they risk losing the public's trust in higher education's ability to serve society by standing as a free and neutral site of knowledge and inquiry.

The changing names of TTOs reflect the evolving purposes of these offices and their desire to align themselves more closely with the marketplace. Perhaps one of the goals of these new names is to make prospective licensees forget that they are dealing with universities, whose moral and ethical obligations to the public are paramount. The new names signify instead that prospective licensees are dealing with something akin to a business, which has no obligations except to generate returns on investment for its owners or shareholders. Research institutions, however, are not for-profit actors, so their ready adoption of commercial naming conventions for their TTOs does little to reflect what ought to be the overriding purpose of their engagement in technology transfer: furthering the public good, not acting, behaving, or looking like a for-profit company. Announcing that TTOs will engage in business practices by choosing names similar to those of commercial ventures builds a brand that runs counter to higher education's position in the public sphere.

The same holds true for the adoption of institutional slogans. Few students pick which college or university to attend on the basis of a catchy word or phrase. Yet these institutions no longer are satisfied with merely using their names to identify themselves and are coining and protecting slogans that bear little resemblance to the

public-serving qualities for which higher education used to be known. Instead, they announce the private benefits that individuals stand to gain from higher education. The trademark registrations for these new slogans root themselves in the commercial marketplace and hinder actors outside of higher education who may wish to use them for other purposes that would not create confusion between the slogan and a college or university. Instead of embodying an open-knowledge commons, higher education risks becoming a propertied space where institutions predominantly view their identities through a commercial lens. The greater the number of colleges and universities that coin and federally register slogans, the more that higher education, as a sector, projects its value to society as being merely transactional: services in exchange for tuition. Surely no institution's worth can be reduced to a word or phrase, and that reason alone is why colleges and universities should stop turning to slogan protection as a significant component of their branding efforts.

The challenge that the contentious acquisition of domain names presents for higher education lies in articulating what interests colleges and universities have in enforcing their trademark rights online. Will an institution take a constrained approach, seeking to limit the domain-name battles it chooses to wage, or will it view its expanding trademark holdings as manifest destiny, seeking to reflect, online, all the variations on its intangible rights? My constrained approach recognizes that trademark-rights enforcement should be viewed with reluctance when the identified harms are more theoretical than actual, as typically is the case. Here one day, gone the next, is often the nature of domain names. Yet the very sector of society that should be open to critiques and to competing speech can be too quick to grab domain names of questionable long-term utility to individual colleges and universities. In this sphere, higher education's might often makes right, and individual institutions' trademark rights produce might. So the cycle continues, with higher education protecting its brand by expanding it. The needless accumulation of online space in the service of brand formation and protection must come to an end.

As colleges and universities continue to leverage the power of trademarks to position themselves according to the norms of the marketplace in all of these areas and take expansionist-oriented steps to ensure their various rights, crises may occur in their overall mission. Mission often defers to money in higher education, but at what cost? Although higher education's long-standing mission has entailed harnessing intellectual capability and outputs, claiming and taking legal actions regarding those outputs for primarily private purposes may bring new losses: the involvement of faculty in shared governance; the aim of colleges and universities to remain impartial in their pursuit of knowledge and how it gets disseminated; and, ultimately, the trust of the public. From another perspective, these changes may mean that institutional brands will become more diffuse as they shift to reflect new values, goals, and priorities. In short, as colleges and universities use trademarks to position their brands more closely to those in the marketplace, the value of the brands themselves may suffer.

As higher education continues to move toward commercial behaviors with the ascendancy of brands, these become an important yet largely overlooked site of contestation, one that creates an image/marketplace feedback loop. Sensitivity to brands creates brand opportunities, and college and university brands come to reflect markets and marketplace practices. In short, institutional image consciousness drives the creation and enforcement of brands in higher education, which serve as commercial tools, defining, signaling, and mediating between public and private spheres. Trademarks are central to this process.

Higher education institutions' use of trade secrecy presents its own, related problems. Many public colleges and universities are becoming resistant to operating in ways that are transparent and open, and they are using trade secrecy to erect barriers between themselves and the public. A courted or existing corporate partner or sponsor that an institution aims to appease is often at the heart of such secrets. While the impetus for secrecy may originate outside higher education, the backbone to resist it must come from within. The public loses if the operations of a public college or university are removed

from legitimate inspection. Faith is built on trust, which requires accountability, which demands transparency. The public may soon have little faith in the ability or desire of for-profit companies to serve society's best interests, in part because their operations are generally kept secret. Higher education must resist the formation of brands that view secrecy as a prized value, as this only serves a private good, which benefits select institutions and companies over the public.

On the topic of private gain, the NCAA's historical practice of grabbing student publicity rights in less than arms-length transactions thankfully has ceased, in light of legal outcomes that recognized this exploitative practice for what it was. Unfortunately, some individual colleges and universities continue to lay claim to students' publicity rights, believing that the value from these names, images, and likenesses is theirs to claim and brand, based merely on a student's affiliation with the institution. This abusive commercial practice must stop. Students should not be prevented from participating in college athletics because they refuse to sign away valuable rights to their identity, nor should they be denied either the full value or a fair share of those bargained-for rights after graduation. If the concept of the student-athlete is ever to be real again, as opposed to merely a rhetorical and legal construct divorced from the actual interests of students, colleges and universities must obtain any student's publicity rights through fair dealing, not by demanding them at the threatened expense of not being able to participate in college athletics.

All five of these areas of brand activity in higher education require essentially the same medicine in order to bring about a cure: shifting current norms, so activities claiming private rights, using the principles and rules of trademarks and allied areas, are viewed with suspicion and shunned, not welcomed and embraced, as often seems to be the case nowadays. Trademarks should rarely be viewed as appropriate vehicles for brand expansion, as the increasing prevalence of brands, in itself, is pushing higher education in misguided directions. Colleges and universities were built not to be responsive to markets, but to exist—to the extent possible—apart from them. In a similar vein, capturing students' publicity rights, and claiming in-

stitutional trade secrets, demonstrate the power of modern colleges' and universities' attraction to the marketplace. While that attraction may not diminish, higher education can still engage with the marketplace without adopting its intellectual-property norms and attempting to brand itself in the market's image.

A few hypothetical questions help illustrate the nonessential nature of these brand activities. Will corporations stop sponsoring stadiums if the terms of that sponsorship are subject to public inspection? Will college athletics, as we know it, cease to exist if student-athletes are treated as the actual owners of their publicity rights, with the ability to decide how those rights will be used? Will universities be unable to engage in technology transfer if their TTOs function with descriptive names, instead of brand names? Will colleges close, or will their admissions be affected, if they fail to coin a catchy slogan or register yet another domain name? Surely the answer to all of these questions is a resounding no, which speaks volumes about the questionable nature of the intellectual-property activities occurring in these areas of higher education.

Necessity, not opportunity, ought to prevail in college and university perspectives on the role of brands. What intellectual property permits, higher education need not always implement. Colleges and universities must pull back from brands, in order to better present themselves as society intended them to be: disinterested sites of knowledge production, not socially embedded marketplace actors in competition with everyone, looking to claim nearly everything.

Implementing Intellectual-Property Change on Campus

With the above suggestions in mind, which mostly involve institutional actions, three questions arise. How can these changes occur? Who will be entrusted with helping colleges and universities use private intellectual-property rights in the public interest? Who will serve as the natural champion for implementing intellectual-property change on campus?

To answer these questions, we first need to explore the types of personnel in higher education, as well as that sector's broader purposes.

The notion that higher education exists as a protected site of culture, knowledge, and free inquiry is well established. Higher education serves as this commons in large measure because of its core components: teaching, research, and service to society. These activities are performed by many different people, but their chief catalysts are those who have chosen the academic life not as a noble application of another skill or career (for example, business or law), but rather as *the* career to which they wish to dedicate their talents and passions. Those individuals are the full-time faculty.

A separate category of institutional actors are those relied on to create, implement, and enforce intellectual property in higher education. Lawyers for the institutions, whether in-house or from outside law firms, create and interpret intellectual-property policies on individual campuses. At all levels, attorneys play central roles in defining what the law permits and in suggesting actions colleges and universities may take to further the legal interests of their institution, as these individuals define them. In addition, other nonfaculty administrators frequently deal with intellectual property: TTO staff implement intellectual-property policies in multiple ways; athletics departments, public relations offices, and other administrative units help conceptualize and define institutional brands; and university lobbyists mediate their institutions' practices and messages with legislators, who are in a position to influence how laws impact higher education's policies and behavior.

These professionals all have important jobs to perform, which sometimes even entail being asked to implement misguided ideas initiated by hard-headed faculty. Nonetheless, we must also recognize that these professionals often have vested interests in pursuing courses of action that bolster their positions and place them in situations enhancing their power, influence, or prestige. TTO directors are unlikely to propose that their ranks be trimmed as their institutions pull back from exclusive licenses and litigation involving university patents. In-house attorneys are unlikely to recommend that a college or a university seek fewer trademark registrations, when claiming these rights helps support the notion that they are protect-

ing their institution. University-advancement staff are unlikely to suggest that their institutions comply with an open-records request if, by doing so, influential alumni or corporate sponsors may become upset and withhold donations. Whether openly recognized or not, intellectual-property laws become an attractive mechanism for people in such positions, as these laws can be used to defend the status quo and entrench offices and positions in ways that incumbents realize are in *their* best interests, even if not necessarily in the public's interest.

In many ways, these interpersonal forces and workplace dynamics are understandable—such actions and perceptions are innately human and are not unique to higher education. Nonetheless, they collectively threaten to mire colleges and universities in legal, administrative, and bureaucratic thinking about intellectual property that compromises the integrity of higher education as a whole.

What is needed is a cultural change that reframes these institutions' understanding of intellectual property. Complacency can make the accumulation of intellectual-property rights seem desirable or even inevitable. An appropriate and overdue solution to counter these forces is to recognize that intellectual-property policies and activities go to the heart of higher education's existence in the public sphere as primarily an *academic* institution, not a corporate or a bureaucratic entity. As such, intellectual-property issues are too important to view as either simple or routine decisions to be left in the hands of business-oriented or legal administrators. Instead, they deserve full-scale treatment as academic issues, and higher education institutions should create a new position within their provost's offices to handle them.

At large universities, the person occupying this post could be called an associate provost or vice-provost for intellectual property, and the job would be a full-time position. At smaller institutions, the post could be part time, and the incumbent called the director of intellectual property. The purpose of these positions, which should be filled by tenure-stream academics, is to recognize, mediate, and coordinate the intellectual-property dimensions of their institution's

existence. Instead of having only lawyers and corporate-type administrators set intellectual-property policies and oversee the private-rights climate on campuses, individuals in these newly created positions would share in this undertaking. The success of their efforts would not depend on the creation of more private rights, but, rather, on the protection of the public interest. Instead of serving, by default, as intellectual-property *proponents*, they would stand as intellectual-property *skeptics* in the face of multiple forces, both within and outside of higher education, that seek to lay claim to aspects of our cultural and knowledge commons. These positions could be filled by academics in the legal field, but they need not be. Any scholar with an interest in and aptitude for understanding the ways in which the accumulation of private rights affects the public's trust in higher education would be fit for the job. The best outputs of a broad-based liberal education—a fertile mind and an ability to appreciate the intersections of art and science—should enable academics of all stripes to recognize and seize the importance of this topic.

On most campuses today, deans, provosts, presidents, and boards of trustees are given legal and business guidance about intellectual property, but rarely do they receive academic advice on this topic. A frequent presumption is that faculty are too busy to be bothered with intellectual-property issues or decisions, or are too uninterested or lack sufficient knowledge to be consulted. The ostensible voice of faculty members on most campuses, the faculty senate, is often ineffectual in its ability to provide quick or useful insight about any pressing topic of the moment. The new position I propose would exist precisely so that college and university decision makers could understand the academic dimensions and implications of intellectual-property activity on campus. People in these posts would not practice law or engage in business, but instead intervene in the private-rights climate in higher education, serving as bastions of a public domain, which should be largely unfettered by the needless amassing of intellectual-property rights by colleges and universities.

Proposing the formation of a new position to help solve problems created, in part, by bureaucratic and administrative growth may at

first seem contradictory, or even unhelpful. Wouldn't the incumbents in these positions eventually develop entrenched views of intellectual property, just as many other administrators have done? Such a risk seems overstated. Higher education has a history of employing academic talent to marshal energy and resources around problems of importance. One example is the creation and growth of diversity and multicultural-affairs offices, to foster welcoming and inclusive climates on college and university campuses. Most would agree that instilling an appreciation of these issues is an academic topic worth developing, as much as it is a legal or business mandate that must be addressed.[20] The existence of this kind of office on a campus sends a message regarding that institution's stance toward what many define as a problem for higher education. What I propose in the realm of intellectual property is far more modest, but it is inspired by the successes of these other models: simply situate a person with an appropriate aptitude for and interest in a position with the authority to work across institutional sectors on matters that have a bearing on their college's or university's use of private rights in ways that affect the public good.

Instead of resisting the creation of my proposed intellectual-property position, in-house attorneys, TTO directors, and other administrators who regularly deal with these issues in higher education should support it, viewing the occupant of this post as an internal resource to help an institution fulfill its responsibilities to the public. *Permitted* action is not necessarily *appropriate* action, and this new post could be an allied voice against intellectual-property actions and undertakings with no clear ties to public benefits. When faculty or deans are the ones advocating for the needless expansion or inappropriate use of intellectual property, legal or business-oriented administrators may not have the institutional clout or support to stand up to them. Who better to help educate bullish faculty and deans than a faculty colleague in a position of administrative influence?

Implementing intellectual-property changes on campus will not be easy, nor will it occur overnight. But creating an academic position to give voice to the educational and public dimensions of this important

field should be viewed as a crucial first step toward alleviating many of the growing tensions in how colleges and universities approach intellectual property.

Private Rights in the Service of the Public Good

Once thought of as an ivory tower, higher education, as a sector, continues to move toward the marketplace. This has led to the adoption of corporate practices and to colleges' and universities' growing allegiance to business values and constructs, such as innovation, commercialization, and branding. No longer set apart from society, institutions of higher education increasingly seek private alliances that may open up new avenues of revenue generation. Although this sector historically was not designed to quickly serve any political objective, it now finds itself in the center of contentious debates over the appropriate roles and purposes of academic activity. Even the ongoing viability of traditional scientific norms, such as communalism and disinterestedness, are open to question in the face of directives that can, at times, appear politically motivated.[21]

The traditional view of higher education—as pursuing knowledge wherever it may lead, because of the virtue inherent in knowledge itself—seems to have given way to private-good mindsets that view the predominant purpose of institutional activities related to knowledge as a means of building power and contributing to the accumulation of private wealth. Amid these changes, intellectual-property laws and protections stand as promising vehicles through which colleges and universities can solidify their commitment to these developing allegiances, priorities, and value systems. Many institutions have come to view a deep and ongoing engagement with the intellectual-property system as a mandate or as part of their ongoing mission. Approaching higher education's cultural and knowledge commons through the lens of intellectual property seemingly provides colleges and universities with a tantalizing array of benefits: inventions that can be commercialized; marketplace symbols (trademarks and brands) that can be licensed; creative works that can become sources of profits; and images, trade secrets, slogans, and Internet spaces that

can be claimed, counted, closed off, and potentially captured, thus amassing commercial values to be wielded later in any number of useful ways.

With these activities, however, come great risks, as this book has described. Institutions face pressures to claim private rights that they do not need, do not deserve, and, in some cases, cannot appropriately use. Yet the availability of intellectual-property protections, and ever-growing marketplace competition, have converged to create a rights-rich environment in which most institutions of higher education cannot resist participating. This atmosphere keeps colleges and universities mired in what Corynne McSherry calls "the perpetual boundary work" of policing how the privatization of intellectual property influences the public mission of higher education.[22]

Unfortunately, few colleges and universities seem up to the job. This book's central premise is that the boundaries have blurred and are in desperate need of careful redefining. While the preceding chapters discuss what may seem to be remote harms that come from higher education's excessive claims to multiple rights and the enforcement activities linked with them, in no sense are these injuries hypothetical. Intellectual property is all too often a system of winners and losers. Rights that are claimed by a college or a university come at the exclusion of more-appropriate owners, be they students, faculty, or third-party companies outside of higher education. Even when those individuals or groups are not directly impacted, the public at large suffers when colleges and universities spend their efforts and resources on establishing private rights for images, words, objects, and expressions that should not be claimed by these institutions.

What higher education needs is focused attention on its appropriate role in creating and protecting private rights when using the mechanisms of intellectual property, particularly in light of this sector's public funding, tax incentives, and public-focused mission. The solution is certainly not the banishment of colleges' and universities' claims of ownership for trademarks, patents, copyrights, and trade secrets. Nor is the answer an unthinking and uncoordinated

approach, where any claim to a right is presumably justified and any inquiry into the institutional decision making that leads to that right is rebuffed as being inappropriate or ill informed.

Alex Kozinski is a prominent judge on the Federal Court of Appeals for the Ninth Circuit, known for his interest in intellectual-property law. In a dissenting opinion from a 1993 case, he made the following observations about the impact of private rights on the public domain: "Private property, including intellectual property, is essential to our way of life. It provides an incentive for investment and innovation; it stimulates the flourishing of our culture; it protects moral entitlements of people to the fruits of their labor. But reducing too much to private property can be bad medicine. . . . So too it is with intellectual property. Overprotecting intellectual property is as harmful as underprotecting it. Creativity is impossible without a rich public domain. . . . Overprotection stifles the very creative forces it's supposed to nurture."[23]

Although not written with higher education in mind, Judge Kozinski's statements acutely apply to that sector, the longest-running and most conspicuous site we look to as a reliable source of creativity, culture, and knowledge dissemination. These fruits often require intellectual-property protections to flourish, but they need them in measured doses. The public contributes financially to higher education and offers it tax subsidies in exchange for receiving its fruits at modest or no cost, with few strings attached. Yet, as this book has detailed, higher education is increasingly adding strings, in the form of intellectual-property protections that impede the public's freedom and its ability to benefit directly from higher education's undertakings, which should serve the public good. The challenge therefore lies in ending this institutional impulse to overprotect, deciding instead to cede more rights to individual creators and, ultimately, to the public. The claiming of private rights through intellectual-property initiatives should not be an autonomous mission for colleges and universities, but rather a conscientious and transparent act, subject to public inspection and public defense.

Understanding what is possible is the first step in recalibrating higher education's orientation toward intellectual property. This book has laid that groundwork. Now it is incumbent on all who are aware of higher education's struggle with intellectual property to call on decision makers at colleges and universities, urging them to implement a public-serving path forward, erecting sensible and visible boundaries in the face of the alluring temptations that intellectual-property protections often offer. Only by exposing the role of choice in this arena, and redefining, through legal and policy changes, institutions' freedom to act, can we expect colleges and universities to make better decisions regarding intellectual property—decisions that benefit us all.

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Appendix

The following list contains all domain names subject to uniform domain-name dispute-resolution policy (UDRP) actions filed by Baylor University from the years 2003 through 2013, listed in alphabetical order. Baylor contested ownership of more than 125 domain names in over 60 distinct UDRP actions.

BAYLORAIDS.COM
BAYLORALLSAINTSHOSPITAL.COM
BAYLORALUM.COM
BAYLOR-ALUM.COM
BAYLORALUMNIGAMING.COM
BAYORALUMNILIVING.COM
BAYLORALUMNILOTTERY.COM
BAYLORALUMNIONLINE.COM
BAYLORRIVALS.COM
BAYLORBANKS.COM
BAYLORBEARS.BIZ
BAYLORBEARS.NAME
BAYLORBEARS.NET
BAYLORBEARSGAMING.COM
BAYLORBEARSSUCK.COM
BAYLORBEARS.TV
BAYLORBKSTR.COM
BAYLORCAREERS.COM
BAYLORCOLLEGE.COM
BAYLORCOLLEGEMD.COM
BAYLORCOLLEGEMEDICINE.COM
BAYLORCME.COM
BAYLOR.COM
BAYLORCOMMUNITY.COM
BAYLORCRAVE.COM
BAYLORDALLAS.NET
BAYLORDALLAS.ORG
BAYLORDENTAL.COM
BAYLORDENTALCOLLEGE.COM
BAYLORDENTALSCHOOL.COM
BAYLORDOWNTOWN.COM
BAYLOREDU.COM
BAYLOREYE.ORG
BAYLORFAN.COM
BAYLORFLORIST.COM
BBAYLORFOOTBALLSTADIUM.COM
AYLORFRISCO.COM
BAYLORFRISCOIVF.COM
BAYLORGAMING.COM
BAYLORGARLAND.COM
BAYLORGIRLS.XXX
BAYLORGRAD.COM
BAYLORGRAPEVINEHOSPITAL.COM
BAYLORGROUP.COM
BAYLORHEALTHCAREGARLAND.COM
BAYLORHEALTHCENTER.COM
BAYLORHELATH.COM
BAYLORHELTH.COM
BAYLORHOMECOMING.COM
BAYLORHOSPITAL.COM
BAYLORHOSPTIAL.COM
BAYLORHOSPITALDALLAS.COM
BAYLORHOSPITALGARLAND.COM
BAYLORHOSPITALINDALLAS.COM
BAYLORHOSPITALJOBS.COM*
BAYLORHOSPITAL.MOBI
BAYLORHOSPITALS.COM
BAYLORHOSPITALS.MOBI
BAYLORHOSTIPAL.COM
BAYLORJOBS.COM*

BAYLORKEHOE.COM
BAYLORLAMBDAS.COM
BAYLOR-LAW.COM
BAYLORLOCATORS.COM
BAYLORLOTTERY.COM
BAYLORMBA.COM
BAYLORMEDICALCENTER.COM*
BAYLORMEDICALCENTER ATIRVING.COM
BAYLORMEDICALCENTER HOSPITAL.COM
BAYLORMEDICALCLINIC.COM
BAYLORMEDICALHOSPITAL.COM
BAYLORMEDICALSCHOOL.COM*
BAYLORMEDICINE.COM
BAYLORNATION.COM
BAYLORNURSERY.COM
BAYLOROFDALLAS.COM
BAYLOROFGARLAND.COM
BAYLOROFIRVING.COM
BAYLOR.ORG
BAYLORPLAN.COM
BAYLORPSYCHIATRIST.COM
BAYLORPSYCHIATRY.COM
BAYLORREGIONALMEDICAL CENTER.COM
BAYLORRIVERFRONTSTADIUM .COM
BAYLORSALSA.COM
BAYLORSCHOOLOFNURSING .COM
BAYLORSCHOOLS.ORG
BAYLORSING.COM
BAYLORSPORTSNET.COM
BAYLORSPORTSTALK.COM
BAYLORSPORTSTALK.NET
BAYLORSTADIUM.NET
BAYLORSTORE.COM
BAYLORSTUDENT.COM
BAYLOR-STUDENT.COM
BAYLORSUCKS.COM
BAYLORUMC.COM
BAYLORUNIVERSITY.COM
BAYLOR-UNIVERSITY.COM
BAYLORUNIVERSITYU.COM
BAYLORUNVERSITY.COM
BAYLORWAXAHACHIE.COM
BAYLORYELLOWPAGES.COM
BELMONTBAYLOR.COM
BELMONTLOFTSBAYLOR.COM
BELMONT-LOFTS-BAYLOR.COM
BIGBAYLORFAN.COM
BYBAYLOR.COM
CMEBAYLOR.COM
FANSOFBAYLOR.COM
4MYBAYLOR.COM
GOBUSONG.COM
IHATEBAYLOR.COM
JUSTBUIT.COM
MYBAYLOR.COM
MYBAYLORLOGIN.COM
MYCHARTBAYLORCLINIC.COM
RG3BAYLOR.COM
RG3BU.COM
SEARCHBAYLORHEALTH.COM
THEBAYLORSTORE.COM
THEBELMONTBAYLOR.COM
UNIVERSITYOFBAYLOR.COM

*Domain name subject to two different UDRP actions initiated by Baylor University.

Notes

Preface

1. Jeffrey J. Williams, "Deconstructing Academe: The Birth of Critical University Studies," *Chronicle Review*, February 23, 2012, http://chronicle.com/article/An-Emerging-Field-Deconstructs/130791/.

2. I use the words "college" and "university" more-or-less interchangeably throughout this book. Sometimes they appear together ("colleges and universities"), and sometimes not. My use of just "university" typically is shorthand for all nonprofit institutions of higher education that offer a four-year degree, not just those elite institutions where research takes center stage. Universities are ground zero for the intellectual-property trends discussed in this book, because of their greater degree of focus on research. These trends, however, are occurring at liberal arts colleges as well. My commentary should not be read as directed to one type of institution over another, unless otherwise implied in the text.

3. Steve Lohr, "Apple-Samsung Patent Battle Shifts to Trial," *New York Times*, July 30, 2012, B1 (noting that "patents can be powerful tools for determining the rules of engagement for major companies in a fast-growing industry like smartphones"); Nick Wingfield, "Jury Awards $1 Billion to Apple in Samsung Patent Case," *New York Times*, August 24, 2012 (describing the Apple-Samsung trial and the substantial damages awarded to Apple), www.nytimes.com/2012/08/25/technology/jury-reaches-decision-in-apple-samsung-patent-trial.html; Charles Duhigg & Steve Lohr, "The Patent, Used as Sword," *New York Times*, October 7, 2012 (describing the use of software patents as "destructive weapons"), www.nytimes.com/2012/10/08/technology/patent-wars-among-tech-giants-can-stifle-competition.html.

Chapter 1. Intellectual Property, Higher Education, and the Public Good

1. "Bioethics and Patent Law: The Case of the OncoMouse," 2(3) *WIPO Magazine* 16 (June 2006).

2. Fiona Murray, "The OncoMouse That Roared: Hybrid Exchange Strategies as a Source of Distinction at the Boundary of Overlapping Institutions," 116(2) *American Journal of Sociology* 341 (2010).

3. The initial patent's first claim covered "a transgenic nonhuman mammal all of whose germ cells and somatic cells contain a recombinant activated oncogene sequence introduced into said mammal, or an ancestor of said mammal, at an embryonic stage." See U.S. Patent No. 4,736,866 (issued April 12, 1988).

4. Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980).

5. Murray, 2010, p. 361.

6. Ibid., p. 368.

7. Sam Jaffe, "Ongoing Battle over Transgenic Mice," *Scientist*, July 19, 2004, www.the-scientist.com/?articles.view/articleNo/15821/title/Ongoing-Battle-over-Transgenic-Mice/.

8. President and Fellows of Harvard College v. Rea, 2013 WL 2152635 (E.D. Va. May 15, 2013).

9. President and Fellows of Harvard College v. Lee, 589 Fed. Appx. 982 (Fed. Cir. 2014).

10. Ibid., p. 984.

11. David F. Labaree, "Public Goods, Private Goods: The American Struggle over Educational Goals," 34(1) *American Educational Research Journal* 39 (Spring 1997) (defending the concept of education as a public good in the face of mounting efforts to ignore its public impacts in favor of private-sphere orientations and rewards).

12. U.S. Constitution, art. I, § 8, cl. 8.

13. Edmund W. Kitch, "The Nature and Function of the Patent System," 20(2) *Journal of Law & Economics* 265 (1977).

14. Jürgen Habermas, *The Structural Transformation of the Public Sphere* (1962); Robert A. Rhoads, "The U.S. Research University as a Global Model: Some Fundamental Problems to Consider," 7(2) *InterActions: UCLA Journal of Education & Information Studies* Article 4 (2011).

15. Brian Pusser, "Reconsidering Higher Education and the Public Good: The Role of Public Spheres," in *Governance and the Public Good* (William G. Tierney ed., 2006), p. 17.

16. Pusser, 2006; Brian Pusser, "Power and Authority in the Creation of a Public Sphere through Higher Education," in *Universities and the Public Sphere: Knowledge Creation and State Building in the Era of Globalization* (Brian Pusser, Ken Kempner, Simon Marginson, & Imanol Ordorika eds., 2011).

17. Simon Marginson, "Higher Education and Public Good," 65 *Higher Education Quarterly* 411 (2011), p. 419.

18. Christopher S. Collins, "Land-Grant Extension as a Global Endeavor: Connecting Knowledge and International Development," 36(1) *Review of Higher Education* 91 (2012).

19. Walter W. McMahon, *Higher Learning, Greater Good: The Private and Social Benefits of Higher Education* (2009).

20. Burton A. Weisbrod, Jeffrey P. Ballou, & Evelyn D. Asch, *Mission and Money: Understanding the University* (2010).

21. Derek Bok, *Universities in the Marketplace: The Commercialization of Higher Education* (2003).

22. David C. Mowery, Richard Nelson, Bhaven Sampat, & Arvids Ziedonis, *Ivory Tower and Industrial Innovation: University-Industry Technology Transfer before and after the Bayh-Dole Act* (2004).

23. Gary Rhoades & Sheila Slaughter, "Academic Capitalism and the New Economy: Privatization as Shifting the Target of Public Subsidy in Higher Education," in *The University, State, and Market: The Political Economy of Globalization in the Americas* (Robert A. Rhoads & Carlos Alberto Torres eds., 2006), pp. 103–104.

24. Rhoades & Slaughter, 2006; Margo A. Bagley, "Academic Discourse and Proprietary Rights: Putting Patents in Their Proper Place," 47(2) *Boston College Law Review* 217 (2006).

25. Sheila Slaughter & Gary Rhoades, *Academic Capitalism and the New Economy: Markets, State, and Higher Education* (2004), p. 112.

26. Irwin Feller, "Technology Transfer from Universities," in 12 *Higher Education: Handbook of Theory and Research* (John C. Smart ed., 1997), p. 36.

27. David L. Kirp, *Shakespeare, Einstein, and the Bottom Line: The Marketing of Higher Education* (2003), p. 7.

28. Christopher Newfield, *Unmaking the Public University: The Forty-Year Assault on the Middle Class* (2008), p. 223.

29. Simon Marginson, "The 'Public' Contribution of Universities in an Increasingly Global World," in *Universities and the Public Sphere* (Pusser, Kempner, Marginson, & Ordorika eds., 2011).

30. Brett M. Frischmann, Michael J. Madison, and Katherine J. Strandburg, in their article "Governing Knowledge Commons," in *Governing Knowledge Commons* (Frischmann, Madison, & Strandburg eds., 2014), define "knowledge commons" as "shorthand for the institutionalized community governance of the sharing and, in some cases, creation, of information, science, knowledge, data, and other types of intellectual and cultural resources" (p. 3). Colleges and universities enjoy a unique capacity to serve as vibrant cultural and knowledge commons, due to the creative capacity of their human resources (students and faculty), their abundant tangible resources (articles, books, works of art, and other objects of intellectual value, often housed in campus libraries), and their historical norms of openness, sharing, and a disinterested pursuit of knowledge (p. 11).

Chapter 2. Intellectual Property Explained

1. Lateef Mtima, "Prologue: A Social Activist's Guide to Intellectual Property," in *Intellectual Property, Entrepreneurship, and Social Justice* (Lateef Mtima ed., 2015).

2. Impromptu speeches or pantomimes are examples of activities not subject to copyright, presuming they are not recorded or otherwise "fixed" in a tangible medium of expression.

3. 17 U.S.C. § 102(a).

4. 17 U.S.C. § 102(b).

5. 17 U.S.C. § 106.

6. Christopher Jon Sprigman, "Reform(aliz)ing Copyright," 57 *Stanford Law Review* 485 (2004).

7. 17 U.S.C. § 412.

8. 17 U.S.C. § 504.

9. This example presumes that you took the step of registering a copyright for your email, which is a prerequisite to filing an infringement lawsuit.

10. Feist Publications, Inc., v. Rural Telephone Service Co., 499 U.S. 340 (1991).

11. The price varies, depending on whether the application is filed on paper or online and, for online filings, depending on the complexity of the filing. See "Fees," United States Copyright Office, http://copyright.gov/about/fees.html.

12. Willa Cather, *O Pioneers!* (1913), part 4.

13. 17 U.S.C. § 101.

14. Ibid. The types of commissioned works subject to this portion of the work-made-for-hire statute include "a work specially ordered or commissioned for use as a contribution to a collective work, as part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas."

15. 17 U.S.C. § 107.

16. Susan M. Bielstein, *Permissions, a Survival Guide: Blunt Talk about Art as Intellectual Property* (2006).

17. 35 U.S.C. § 101.

18. 35 U.S.C. § 102. The rules regarding novelty are even stricter if the inventor wishes to obtain patent protection in international jurisdictions, where "absolute novelty" is required. One public disclosure of the invention by the applicant, prior to filing for patent protection, can defeat the inventor's ability to obtain a patent in foreign jurisdictions.

19. Giles S. Rich, "Laying the Ghost of the 'Invention' Requirement," 1 *AIPLA Quarterly Journal* 26 (1972) (calling nonobviousness "the heart of the patent system and the justification of patent grants"); *Nonobviousness—The Ultimate Condition of Patentability: Papers Compiled in Commemoration of the Silver Anniversary of 35 USC 103* (John F. Witherspoon ed., 1980).

20. 35 U.S.C. § 103.

21. Thomas Jefferson, letter to Isaac McPherson, August 13, 1813, The Founders' Constitution, http://press-pubs.uchicago.edu/founders/documents/a1_8_8s12.html.

22. 35 U.S.C. § 154.

23. 35 U.S.C. § 271.

24. The term of protection is fifteen years for design patents that are issued from applications filed on or after May 13, 2015. The term of protection is fourteen years for design patents issued from applications filed before that date.

25. Jeffrey H. Matsuura, *Jefferson vs. the Patent Trolls: A Populist Vision of Intellectual Property Rights* (2008), p. 23.

26. We have thirteen federal courts of appeal in the United States. All but the CAFC are based on geography. For example, the United States Court of Appeals for the Fourth Circuit hears appeals from the states of Maryland, North Carolina, Virginia, and West Virginia. In addition to patent cases, the CAFC also hears appeals involving veterans' claims, disputes between contractors and the federal government, disputes between federal employees and the federal government related to employment benefits, and disputes involving international trade, among other issues.

27. See "Supreme Court Patent Cases," Written Description, http://writtendescription.blogspot.com/p/patents-scotus.html.

28. Jeff John Roberts, "Patent Trolls Hurt R&D Say Scholars in Letter to Congress," Gigaom Research, March 2, 2015, https://gigaom.com/2015/03/02/patent-trolls-hurt-rd-say-scholars-in-letter-to-congress/.

29. For examples, see Colleen V. Chien, "From Arms Race to Marketplace: The New Complex Patent Ecosystem and Its Implications for the Patent System," 62 *Hastings Law Journal* 297 (2010); Ira Glass & Chicago Public Media, "When Patents Attack!," *This American Life* podcast, episode 441 (July 22, 2011); James E. Bessen, Michael J. Meurer, & Jennifer Ford, "The Private and Social Costs of Patent Trolls," 34(4) *Regulation* 26 (2011).

30. Michael Risch, "Patent Troll Myths," 42 *Seton Hall Law Review* 457 (2012); Ashby Jones, "When Lawyers Become 'Trolls,'" *Wall Street Journal*, January 23, 2012, www.wsj.com/articles/SB10001424052970203750404577173402442681284/.

31. Chien, 2010, p. 355.

32. In addition to his many other talents and undertakings, Thomas Jefferson was an inventor and served as one of the founding members on the Board of Arts, the nation's first patent-examination office.

33. In re Hiniker Co., 150 F.3d 1362, 1369 (Fed. Cir. 1998).

34. A patent attorney or a patent agent typically drafts patent applications. Both are members of the patent bar and are licensed to practice before the

USPTO. Patent attorneys differ from patent agents in that they also hold law degrees and are licensed to practice law in at least one state in the United States.

35. For example, design patents are limited to one claim.

36. Broad claims do come with some pitfalls, however. An independent requirement of patentability is that the patent must enable a person having ordinary skill in the relevant art to put the claimed invention into practice without undue experimentation. See 35 U.S.C. § 112. This is called the enablement requirement and is aimed at making sure the public receives the full benefit of knowledge about the invention, in exchange for the grant of a limited property right to the patentee. Broad patents risk being invalidated in litigation if the full scope of the claims is not "enabled."

37. Patent law does recognize an experimental-use exception to patent infringement. The exception is extraordinarily narrow and applies only to uses of patented inventions "for amusement, to satisfy idle curiosity, or for strictly philosophical inquiry." See Roche Products, Inc., v. Bolar Pharmaceutical Company, 733 F.2d 858, 863 (Fed. Cir. 1984). Unlicensed uses of patents by university researchers working in academic laboratories, however, do not qualify as experimental uses. See Madey v. Duke University, 307 F.3d 1351 (Fed. Cir. 2002).

38. 15 U.S.C. § 1127.

39. Deven R. Desai, "From Trademarks to Brands," 64 *Florida Law Review* 988 (2012).

40. TrafFix Devices, Inc., v. Marketing Displays, Inc., 532 U.S. 23 (2001).

41. 15 U.S.C. § 1057(b).

42. Desai, 2012, p. 981.

43. Alternatively, they may choose to sue in state court, citing unfair competition as the cause for legal action.

44. 15 U.S.C. § 1125(b).

45. Consumer confusion away from the point of sale, known as "post-sale confusion," is actionable in some courts. Another potential claim is for "initial-interest confusion," or the theory that a defendant's mark causes consumers to have initial confusion about the source, sponsorship, endorsement, or affiliation between the defendant's product and the plaintiff, even though that confusion dissipates by the time of purchase.

46. This phenomenon, known as genericide, occasionally happens. Historical examples of trademarks that have lost protection in the United States and are now deemed generic, because they have come to be known as a category of product, include "escalator," "aspirin," and "trampoline." One might say that these trademarks became victims of their own success.

47. The classification numbering is the same in other countries, although registration in one country does not provide protection in other countries.

48. David A. Divine & Richard W. Goldstein, *AIPLA [American Intellectual Property Law Association] Report of the Economic Survey* (2013), p. I-100.

49. For examples, see Feller, 1997 (describing the centralization of technology transfer in higher education); Pat K. Chew, "Faculty-Generated Inventions: Who Owns the Golden Egg?," 1992 *Wisconsin Law Review* 259 (1992) (arguing that faculty ownership of inventions should not preclude universities from benefiting from faculty inventions to some extent); Jay P. Kesan, "Transferring Innovation," 77 *Fordham Law Review* 2169 (2009) (arguing that higher education has primarily limited its technology-transfer activities to licensing and that higher education should pursue additional technology-transfer revenue streams); Laura G. Lape, "Ownership of Copyrightable Works of University Professors: The Interplay between the Copyright Act and University Copyright Policies," 37 *Villanova Law Review* 223 (1992) (discussing professors' ownership of copyrights and methods to resolve ownership conflicts between professors and universities); Gregory Kent Laughlin, "Who Owns the Copyright to Faculty-Created Web Sites? The Work-for-Hire Doctrine's Applicability to Internet Resources Created for Distance Learning and Traditional Classroom Courses," 41 *Boston College Law Review* 549 (2000) (exploring who owns materials associated with distance education); Michael A. Olivas, "Introduction: Intellectual Property on Campus; Computers, Copyright, and Cyberspace," 27 *Journal of College & University Law* 1 (2000) (introducing a collection of articles from a conference on intellectual property in higher education, largely discussing copyright); Dale P. Olson, "Copyright and Fair Use: Implications of 'Nation Enterprises' for Higher Education," 12 *Journal of College & University Law* 489 (1986) (reviewing implications of the Supreme Court's limitation of the fair-use defense for higher education); Jacob H. Rooksby, "Innovation and Litigation: Tensions between Universities and Patents and How to Fix Them," 15 *Yale Journal of Law & Technology* 312 (2013) (recommending changes to university patent policies and an amendment to the Patent Act that would enable universities to generate revenue from patent ownership while avoiding patent litigation); Sheila Slaughter & Gary Rhoades, "The Social Construction of Copyright Ethics and Values," 16 *Science & Engineering Ethics* 263 (2010) (explaining approaches to copyright law in higher education).

50. For some recent exceptions, see Alexandra J. Roberts, "Goodwill U: School Name Change & Trademark Law," 3 *IP Theory* 129 (2013) (discussing the role of institutional names in branding and consumer perception); Samantha King & Sheila Slaughter, "Sports 'R' Us: Contracts, Trademarks,

and Logos," in *Academic Capitalism and the New Economy: Markets, State, and Higher Education* (Sheila Slaughter & Gary Rhoades eds., 2004) (arguing that trademark and licensing activities blur the line between nonprofit and commercial activities in higher education); Ann Bartow, "Trademarks of Privilege: Naming Rights and the Physical Public Domain," 40 *U.C. Davis Law Review* 919 (2007), p. 948 (discussing naming opportunities at colleges and universities).

51. U.S. Constitution, art. I, § 8, cl. 8.

52. Sheila Slaughter & Larry L. Leslie, *Academic Capitalism: Politics, Policies, and the Entrepreneurial University* (1997) (describing the traditional role of faculty in higher education).

53. Elizabeth Popp Berman, *Creating the Market University: How Academic Science Became an Economic Engine* (2012), p. 158 (describing how marketplace logic came to prevail over the logic of science in higher education); Christopher Newfield, *Unmaking the Public University: The Forty-Year Assault on the Middle Class* (2008), p. 172 (describing how revenue-centered management-accounting practices helped "confirm . . . the market not as academic servant but as academic master, the de facto final authority on the health of the enterprise"); Paolo Guarda, "Creation of Software Within the Academic Context: Knowledge Transfer, Intellectual Property Rights, and Licenses," 44 *International Review of Intellectual Property & Competition Law* 494 (2013), p. 496 (stating that "we are witnessing a whole series of pressures to make universities, and the activities performed there, cater to the needs of the market"); Lionel S. Lewis, *When Power Corrupts: Academic Governing Boards in the Shadow of the Adelphi Case* (2000) (describing the illusion of faculty-shared governance in the era of self-perpetuating boards of trustees at private colleges and universities).

54. See, for example, Ruth H. Alexander, "The Economic Impact of Licensing Logos, Emblems, and Mascots," 5 *Journal of Legal Aspects of Sport* 28 (1995) (discussing the economic value of trademarks in collegiate athletics); David A. Anderson, "Licensing of College and University Trademarks," 8 *Journal of College & University Law* 97 (1981) (explaining how changes in case law allowed universities to more easily profit from their marks in athletic merchandise); Scott Bearby & Bruce Siegal, "From the Stadium Parking Lot to the Information Superhighway: How to Protect Your Trademarks from Infringement," 28 *Journal of College & University Law* 633 (2002) (recommending that colleges and universities adopt various remedies for infringement on sports trademarks, in order to protect and increase a trademark's value); Richard L. Irwin, David K. Stotlar, & Aaron L. Mulrooney, "A Critical Analysis of Collegiate Licensing Policies and Procedures," 20 *Journal of College & University Law* 97 (1993) (reporting on a survey of sport-licensing

and collegiate programs and recommending administrative protocols); Robert Lattinville, "Logo Cops: The Law and Business of Collegiate Licensing," 5 *Kansas Journal of Law & Public Policy* 81 (1996) (outlining the history of trademarks in higher education and intercollegiate sports and predicting future revenue streams for sports-related trademarks); Jack Revoyr, "Non-definitive History of Collegiate Licensing," 88 *Trademark Reporter: The Law Journal of the International Trademark Association* 370 (1998) (outlining the evolution and spread of trademark-licensing programs in higher education and noting the parallel rise in the popularity of intercollegiate athletics).

55. I recognize that the formula has changed over the years, notably to remove cocaine from it. Nonetheless, the principles discussed regarding the choice of trade-secret protection instead of patent protection remain the same.

56. Dan L. Burk, "Trademarks along the Infobahn: A First Look at the Emerging Law of Cybermarks," 1 *Richmond Journal of Law & Technology* 1, ¶ 30 (1995).

57. Xuan-Thao N. Nguyen, "Cyberproperty and Judicial Dissonance: The Trouble with Domain Name Classification," 10 *George Mason Law Review* 183 (2001), p. 187.

58. Milton L. Mueller, *Ruling the Root: Internet Governance and the Taming of Cyberspace* (2002), p. 3.

59. Ibid., pp. 50–56.

60. Jacqueline Lipton, *Internet Domain Names, Trademarks, and Free Speech* (2010), p. 310.

61. "CIRA Policies, Rules, and Procedures," Canadian Presence Requirements for Registrants, Version 1.3, acei.ca/sites/default/files/attachment/policies/cprregistrants-en.pdf.

62. For a listing of the new extensions and the dates on which they were created, see "Delegated Strings," ICANN New Generic Top-Level Domains, http://newgtlds.icann.org/en/program-status/delegated-strings/.

63. Stuart Fuller, "Why Are Brands Yet to Wake Up to the Dawn of the New Internet?," World Intellectual Property Review, June 1, 2014, www.worldipreview.com/article/why-are-brands-yet-to-wake-up-to-the-dawn-of-the-new-internet/.

64. David Eccles, "New Unrestricted Domain Extension .College Approved by ICANN," *SBWire* Blog, August 22, 2013 [no longer posted at this website, but available through the online legal research service Westlaw, using citation 2013 WLNR 20912378].

65. Carl Straumsheim, ".YourUniversityHere," *Inside Higher Ed*, February 3, 2014, www.insidehighered.com/news/2014/02/03/icanns-personalized

-domain-names-attracts-little-interest-higher-education#sthash.pxTVcz3y.dpbs. The other two Australian universities that applied were Bond University and La Trobe University.

66. "Monash First in the World to Acquire a New Brand Top-Level Domain," press release, Monash University, January 20, 2014, http://monash.edu/news/releases/show/monash-first-in-the-world-to-acquire-a-new-brand-top-level-domain/.

67. Esther Dyson, "What's in a Domain Name?," Project Syndicate, August 25, 2011, www.project-syndicate.org/commentary/what-s-in-a-domain-name/ (arguing that "the problem is that expanding the namespace—allowing anyone to register a new TLD such as .apple—doesn't actually create any new value").

68. Comedy III Productions, Inc., v. Gary Saderup, Inc., 21 P.3d 797, 809 (Cal. 2001).

69. In many jurisdictions, the estates of deceased famous people enjoy publicity rights in the name of the deceased for decades after that person's death. For example, in Indiana, the estates of celebrities enjoy publicity rights for 100 years after the celebrity's death. See Eriq Gardner, "Indiana Moves to Grant Broad New Legal Rights to Dead Celebrities," *Hollywood Reporter*, February 9, 2012, www.hollywoodreporter.com/thr-esq/indiana-dead-celebrities-legal-rights-james-dean-law-288124/. The immense value of these postmortem rights, which vary considerably by state, leads to legal maneuvering in determining in which state a celebrity's estate should be probated. See "'Rights of Publicity' Extended beyond the Grave," *Talk of the Nation*, NPR News, September 4, 2012, www.npr.org/2012/09/04/160551338/rights-of-publicity-extended-beyond-the-grave/.

Chapter 3. University™

1. See Mary's Cakes & Pastries, www.maryscakesandpastries.com.

2. Xarissa Holdaway, "Cupcakes Collide with Tuscaloosa Trademarks," *Chronicle of Higher Education: Tweed*, August 27, 2012, http://chronicle.com/blogs/tweed/cupcakes-collide-with-tuscaloosa-trademarks/30290/.

3. Patrick Rupinski, "University Apologizes to Local Bakery after Cease-and-Desist Order," *Tuscaloosa News*, August 23, 2012, www.tuscaloosanews.com/article/20120823/NEWS/120829901/.

4. Jon Solomon, "University of Alabama Aggressively Defends Trademarks: How Far Is Too Far?," *AL.com*, November 17, 2013, www.al.com/sports/index.ssf/2013/11/university_of_alabama_aggressi.html.

5. Ibid.

6. See Mary's Cakes & Pastries, www.maryscakesandpastries.com/.

7. Solomon, 2013.

8. University of Alabama Board of Trustees v. New Life Art, Inc., Daniel A. Moore, 683 F.3d 1266, 1269 (11th Cir. 2012); Daniel Grant, "Free Speech vs. Infringement in Suit on Alabama Artwork," *New York Times*, January 30, 2012, www.nytimes.com/2012/01/31/sports/ncaafootball/artist-still-fighting-alabama-over-football-paintings.html.

9. New Life Art, 683 F.3d, at 1276.

10. Scott Jaschik, "Appeals Court Backs Artist in Lawsuit Watched by Many Universities," *Inside Higher Ed*, June 12, 2012, www.insidehighered.com/news/2012/06/12/appeals-court-backs-artist-lawsuit-watched-many-universities/; Solomon, 2013.

11. Jaschik, 2012.

12. Board of Trustees of the University of Alabama and Paul W. Bryant, Jr. v. William Pitts, Jr. and Christopher Blackburn, Opposition No. 91187103 (TTAB July 23, 2013), http://ttabvue.uspto.gov/ttabvue/ttabvue-91/187, 103-OPP-71.pdf. "Houndstooth mafia" apparently is a phrase that "refers to a group of guys who 'hang out' together, sometimes attending college football games, including Alabama games" (p. 16).

13. Ibid., p. 23. In addition to claiming trademark rights to the houndstooth pattern, the university also asserted trademark rights to its crimson-and-white color scheme. The TTAB rejected this argument as well, mainly because the trademark application did not claim any specific color, and the university's rights to its color scheme only extend so far as it is used in connection with other trademarks or "indicia" of the university (pp. 45–46).

14. Solomon, 2013.

15. Kent Faulk, "Want to Use the Houndstooth Mafia Logo? See the University of Alabama," *AL.com*, May 24, 2014, http://blog.al.com/spotnews/2014/05/post_1143.html. Yet legal wrangling over HOUNDSTOOTH MAFIA continued, even necessitating the involvement of the United States Department of Justice. See Kent Faulk, "Trademark Appeals Board Believes It Doesn't Have to Void Its Houndstooth Opinion," *AL.com*, September 19, 2015, www.al.com/news/birmingham/index.ssf/2015/09/trademark_appeals_board_believ.html. The University of Alabama apparently did not want the TTAB ruling to become a precedent that could be used against it in future disputes, and thus went to great lengths to have the opinion vacated (legally voided). See John L. Welch, "Federal Court Orders TTAB to Vacate HOUNDSTOOTH MAFIA Precedential Decision," *The TTABlog*, February 23, 2016, http://thettablog.blogspot.com/2016/02/alabama-federal-court-orders-ttab-to.html.

16. Jack Revoyr, "Non-definitive History of Collegiate Licensing," 88 *Trademark Reporter: The Law Journal of the International Trademark Association* 370 (1998), p. 371.

17. University of Pittsburgh v. Champion Products, Inc., 686 F.2d 1040, 1043 n.10 (3d Cir. 1982).

18. Michael G. Schinner, "Establishing a Collegiate Trademark Licensing Program: To What Extent Does an Institution Have an Exclusive Right to Its Name?," 15 *Journal of College & University Law* 405 (1989), p. 414.

19. Revoyr, 1998, p. 372.

20. Ibid., p. 374.

21. Suzette M. Thweatt, "Collegiate Licensing at the University of North Carolina: A Historical Review of the Past and Present Role of Licensing at UNC and Recommendations for Future Growth" (2001) (MA thesis, University of North Carolina at Chapel Hill), p. 14.

22. "The Collegiate Licensing Company Names Top Sellers for Fiscal Year 2011–12," Collegiate Licensing Company, October 8, 2012, www.clc.com/News/Archived-Rankings/Rankings-Annual2012.aspx [page no longer available]; Thweatt, 2001, p.2.

23. Finus P. Gaston, "Administrative Decision Making: A Study of Collegiate Trademark Licensing Programs" (1984) (PhD dissertation, University of Alabama), pp. 59–62.

24. Revoyr, 1998, p. 393.

25. Revenue Ruling 81-178, 1981-2 C.B. 135; I.R.C. § 512(b)(2) (2012) (excluding "all royalties" from unrelated business income); Treasury Regulation § 1.513-1(d)(4)(iv) (1983) (stating that commercial activities of a tax-exempt organization that exploit goodwill or other intangibles generated by the performance of exempt functions are not considered to be trade or business income, unless the commercial activities themselves "contribute importantly" to the accomplishment of an exempt purpose).

26. John Brooks, "The Marts of Trade: The Law School and the Noodle Factory," *New Yorker*, December 26, 1977, pp. 48–49.

27. University of Pittsburgh, 686 F.2d at 1041–1042.

28. Ibid., p. 1049. The appellate court agreed with the trial court, however, in ruling that Pitt could not recover any of Champion's past profits (p. 1041).

29. Ibid., p. 1047.

30. Ibid.

31. This changed with Boston Professional Hockey Association v. Dallas Cap & Emblem Manufacturing, Inc., 510 F.2d 1004 (5th Cir. 1975), and later cases. See, for example, University of Georgia Athletic Association v. Laite, 756 F.2d 1535 (11th Cir. 1985); Kentucky Fried Chicken Corporation v. Diversified Packaging Corporation, 549 F.2d 368 (5th Cir. 1977).

32. University of Pittsburgh, 686 F.2d at 1047–1048 (ruling that "with negligible exception, a consumer does not desire a 'Champion' T-shirt, he (or she) desires a 'Pitt' T-shirt").

33. University of Pittsburgh v. Champion Products, Inc., 566 F. Supp. 711, 712 (W.D. Pa. 1983).

34. David A. Anderson, "Protecting the Demon—a Practical Guide to the Licensing of College and University Trademarks," 4 *CBA [Chicago Bar Association] Record* (July–August 1990) 29, pp. 29–30.

35. See, for example, University of Georgia Athletic Assoc., 756 F.2d 1535; 15 U.S.C. § 1125 (2012); J. Thomas McCarthy, 4 *McCarthy on Trademarks & Unfair Competition* (4th ed., 2014), § 23:8.

36. Glenn M. Wong, "Recent Trademark Law Cases Involving Professional and Intercollegiate Sports," 1986 *University of Detroit Mercy Law Review* 87 (1986), p. 111.

37. Gaston, 1984, p. 16.

38. The consortia approach to trademark licensing has no analogue in the university patent-licensing world. University patent owners and the Association of University Technology Managers resist occasional calls for university technology-transfer offices to merge operations, based on geographic location or technological skill. See Robert E. Litan & Robert M. Cook-Deegan, "Universities and Economic Growth: The Importance of Academic Entrepreneurship," in *Rules for Growth: Promoting Innovation and Growth through Legal Reform* (Robert E. Litan & Kauffman Task Force on Law, Innovation, and Growth eds., 2011), p. 73. I wonder whether collaboration across offices might instead lead to more technology being transferred to society, and more-efficient transfers, as discussed in chapter 4.

39. Gaston, 1984, pp. 17–18; Revoyr, 1998, pp. 375–376.

40. "About CLC," Collegiate Licensing Company, www.clc.com/About-CLC.aspx.

41. "About Us," Learfield Licensing Partners, http://learfieldlicensing.com/about-us/.

42. Eric Sylvers, "Are Origins of Italian Star Found in Hills of Kentucky?," *New York Times*, February 27, 2004, www.nytimes.com/2004/02/27/business/are-origins-of-italian-star-found-in-hills-of-kentucky.html.

43. Justin Story, "Italian Judge Rules against Big Red," *Bowling Green (KY) Daily News*, January 6, 2008, www.bgdailynews.com/news/italian-judge-rules-against-big-red/article_639f217b-ccdf-540e-8e87-fb613d5ae4e4.html. From Bowling Green to Italy, WKU showed it lives up to its motto of being "a leading American university with international reach."

44. Robert Lattinville, "Logo Cops: The Law and Business of Collegiate Licensing," 5 *Kansas Journal of Law & Public Policy* 81 (1996), p. 90.

45. Jane Bartman, "The Smell of Support: Notre Dame Unveils Fragrance Line," *Chronicle of Higher Education: The Ticker*, June 21, 2013, http://chronicle.com/blogs/ticker/the-smell-of-support-notre-dame-unveils-fragrance-line/62097/.

46. Karen Grassmuck, "Colleges Fight Bootleggers as Sales Boom for Goods That Bear Logos and Emblems," *Chronicle of Higher Education*, February 21, 1990, p. A32; Michael A. Olivas, "Introduction: Intellectual Property on Campus; Computers, Copyright, and Cyberspace," 27 *Journal of College & University Law* 1 (2000).

47. Revoyr, 1998, pp. 389–390.

48. Ibid., p. 393.

49. See, for example, Richard L. Irwin, *Development of a Collegiate Licensing Administrative Paradigm* (1990) (EdD dissertation, University of Northern Colorado), pp. 12–13.

50. Gaston, 1984, p. 116.

51. See "Finus Gaston," Alabama Athletics, www.rolltide.com/genrel/gaston_finus00.html.

52. See, for example, Irwin, 1990; Jane Cecilia Meyer, "Perceptions of Agencies That Market Collegiate Emblematic Merchandise toward Selected Factors Related to Royalty Income" (1992) (PhD dissertation, University of Iowa).

53. College and university trademark enforcement was not unheard of prior to this time. For one example, see Cornell University v. Messing Bakeries, Inc., 138 N.Y.S.2d. 280 (App. Div. 1955) (ruling that the defendant bakery had unfairly exploited Cornell's name for business purposes).

54. For citations, see Jacob H. Rooksby, "University™: Trademark Rights Accretion in Higher Education," 27(2) *Harvard Journal of Law & Technology* 349 (2014), p. 367, n.95.

55. Anne K. Walters, "Emory U. Relies on Diplomacy in Safeguarding Its Trademark," *Chronicle of Higher Education*, February 17, 2006, p. A33.

56. See, for example, Villanova University v. Villanova Alumni Education Foundation, Inc., 123 F. Supp. 2d 293 (E.D. Pa. 2000) (granting a preliminary injunction to the university, requiring the defendant, an alumni association formerly approved by the university, to cease its infringement).

57. University of Florida v. KPB, Inc., 89 F.3d 773, 776 (11th Cir. 1996).

58. Data presented here come from a research project that I undertook, which entailed conducting a structured search of a publicly accessible database maintained by the USPTO that consists of trademark-registration data. The goal of the search was to identify every federal trademark registration owned by an American college or university. My research assistant and I

coded the relevant records, in order to build a dataset about the types of institutions that seek trademark registrations, as well as the kinds of trademarks they sought to register. We reviewed, edited, and refined the data in fall 2012. Our final dataset included 10,265 trademark records, out of 13,042 records reviewed. The findings reported are under-inclusive, however. Due to the use-based nature of common-law trademark protection, colleges and universities unquestionably possess rights to more trademarks than those that appear in the dataset. For example, FUSION is the name of Case Western Reserve University's interdisciplinary, graduate-level certificate program in technology development and commercialization. As indicated on the program's website, www.fusioninnovate.com, the university claims trademark rights to the program's name. As of December 2015, however, Case Western did not own a federal trademark registration for FUSION. Relatedly, some institutions may register a mark for one or a few classes of goods and services (for example, educational services, entertainment services, clothing, etc.), but choose to assert rights for uses that are different from or broader than the descriptions of their use of the mark in their filings with the USPTO. Also, because the dataset reflects trademark filing and registration activity, it does not completely cover the entire universe of marks over which colleges and universities may claim rights or assert ownership, whether in the abstract ("We think this mark is ours, even though we do not own a federal registration for it") or in the particular ("We are going to sue a defendant for using a mark that is too similar to an unregistered mark that we consider ours"). The dataset also does not account for any trademark registrations obtained by a college or a university that were no longer valid or maintained at the time of our data collection. Actions that could place a trademark registration into these categories include the failure of the registrant to make periodic required filings with the USPTO (including the payment of maintenance fees), invalidation of the registration by a court, or cancellation of the registration in a cancellation proceeding conducted by the TTAB.

59. See, for example, U.S. Trademark Registrations Nos. 1,380,806 and 2,316,281 (each covering the mark UNIVERSITY OF VERMONT, the former with respect to services, the latter with respect to goods).

60. A trademark registration had to be valid and maintained at the time of our data collection in order to be included in the dataset.

61. For the mark NOW, U.S. Trademark Registration No. 0,427,814 (registered February 25, 1947, to R. G. LeTourneau, Inc., subsequently assigned to LeTourneau University).

62. For the purposes of figure 3.2, a federal trademark registration initially issued to an entity other than a college or a university, and then subsequently assigned to a college or a university, is listed as being issued to the college or

university in the year it was registered. The vast majority of trademarks in the dataset had never been assigned.

63. U.S. Trademark Registration No. 3,230,190 (registered April 17, 2007, to the University of the Virgin Islands).

64. U.S. Trademark Registration No. 3,088,162 (registered September 13, 2005, to Tufts University); U.S. Trademark Registration No. 3,088,161 (as used in relation to "food products, namely, eggs and egg products, namely, blue eggs, green eggs, blue-green eggs, speckled eggs, hard-boiled blue eggs, and salmonella tested eggs, meat and meat products, namely, veal," registered May 2, 2006, to Tufts University).

65. U.S. Trademark Registration No. 3,963,791 (registered May 17, 2011, to the University of Rhode Island).

66. U.S. Trademark Registration No. 3,333,546 (registered November 13, 2007, to California Lutheran University).

67. U.S. Trademark Registration No. 3,631,803 (registered June 2, 2009, to North Carolina A&T State University).

68. U.S. Trademark Registration No. 3,462,163 (registered July 8, 2008, to Harvard University).

69. U.S. Trademark Registration No. 3,700,838 (registered October 27, 2009, to Arizona State University).

70. U.S. Trademark Registration No. 2,197,580 (registered October 20, 1998, to the University of Pennsylvania); U.S. Trademark Registration No. 1,970,607 (as used in relation to "medical services," registered April 23, 1996, to the University of Pennsylvania).

71. U.S. Trademark Registration No. 3,488,332 (registered August 19, 2008, to the University of South Carolina).

72. U.S. Trademark Registration No. 2,638,139 (registered October 22, 2002, to George Mason University).

73. U.S. Trademark Registration No. 3,881,788 (registered November 23, 2010, to Mississippi State University).

74. Many registrations in the dataset were easily classified into one of these types. Some of the registrations, however, were judgment calls, in the sense that they could have been categorized in a different manner than the way selected. The primary limitation of the data presented in table 3.1 is the reliability of their internal consistency. Although I was careful to code data consistently, other coders might have made slightly different judgment calls.

75. A slogan for an institution as a whole was not further classified.

76. See, for example, NORTHWESTSTATE.EDU, U.S. Trademark Registration No. 3,966,142 (registered May 24, 2011, to Northwest State Community College); GRANTHAM.EDU, U.S. Trademark Registration No. 2,781,763 (registered November 11, 2003, to Grantham Education Corp., subsequently

assigned to Grantham University, Inc.); MATC.EDU, U.S. Trademark Registration No. 2,742,588 (registered July 29, 2003, to Milwaukee Area Technical College); GMU.EDU, U.S. Trademark Registration No. 2,638,139 (registered October 22, 2002, to George Mason University); WWW.WGU.EDU, U.S. Trademark Registration No. 2,374,880 (registered August 8, 2000, to Western Governors University).

77. See, for example, GOCRIMSON.COM, U.S. Trademark Registration No. 4,229,166 (registered October 23, 2012, to Harvard University); STRONGERMARRIAGE.ORG, U.S. Trademark Registration No. 4,008,747 (registered August 9, 2011, to the Utah Commission on Marriage, subsequently assigned to Utah State University); OSUGIVING.COM, U.S. Trademark Registration No. 3,311,458 (registered October 16, 2007, to Oklahoma State University); DARTMOUTHIMAGES.COM, U.S. Trademark Registration No. 3,128,682 (registered August 15, 2006, to Dartmouth College); REELGOOD.TV, U.S. Trademark Registration No. 3,055,231 (registered January 31, 2006, to Regent University); SOONERSPORTS.COM, U.S. Trademark Registration No. 3,041,815 (registered January 10, 2006, to Oklahoma State University); ZEV.NET, U.S. Trademark Registration No. 2,990,242 (registered August 30, 2005, to the University of California System); MSUCARES.COM, U.S. Trademark Registration No. 2,952,228 (registered May 17, 2005, to Mississippi State University); DREXEL.COM, U.S. Trademark Registration No. 2,893,677 (registered October 12, 2004, to Drexel University).

78. U.S. Trademark Registration No. 4,240,553 (registered November 13, 2012).

79. U.S. Trademark Registration No. 4,233,646 (registered October 30, 2012).

80. U.S. Trademark Registration No. 4,021,644 (registered September 6, 2011).

81. U.S. Trademark Registration No. 3,850,004 (registered September 21, 2010).

82. U.S. Trademark Registration No. 3,829,839 (registered August 3, 2010).

83. U.S. Trademark Registration No. 3,368,260 (registered January 15, 2008).

84. U.S. Trademark Registration No. 3,049,560 (registered January 24, 2006).

85. U.S. Trademark Registration No. 2,340,992 (registered April 11, 2000).

86. U.S. Trademark Registration No. 2,308,809 (registered January 18, 2000).

87. U.S. Trademark Registration No. 1,670,584 (registered December 31, 1991).

88. U.S. Trademark Registration No. 1,522,966 (registered January 31, 1989).

89. Michael J. Madison, Brett M. Frischmann & Katherine J. Strandburg, "The University as Constructed Cultural Commons," 30 *Washington University Journal of Law & Policy* 365 (2009) (describing the university as a

"constructed cultural commons" and exploring the intersection of innovation with patent and copyright strictures within such an environment).

90. 35 U.S.C. § 202(c)(7)(B) (for inventions over which a university has retained ownership, requiring the university to share royalties with the inventor).

91. See, for example, Liza Vertinsky, "Universities as Guardians of Their Inventions," 2012 *Utah Law Review* 1949 (2012) (arguing that universities need more discretion, responsibility, and accountability over inventions made by their faculty, in order to successfully meet society's growing demand for university innovation).

92. For more on the sports drink's history, see Darren Rovell, *First in Thirst: How Gatorade Turned the Science of Sweat into a Cultural Phenomenon* (2005). Although the University of Florida does not own a trademark registration for Gatorade®, it does receive a royalty for use of this name, following a contractual agreement with Stokely–Van Camp, Inc., which owns the trademark (p. 74).

93. U.S. Trademark Registration No. 3,905,291 (registered January 11, 2011).

94. U.S. Trademark Registration No. 3,825,430 (registered July 27, 2010).

95. U.S. Trademark Registration No. 3,531,554 (registered November 11, 2008, originally to Bradmer Pharmaceuticals).

96. U.S. Trademark Registration No. 3,134,902 (registered August 29, 2006).

97. U.S. Trademark Registration No. 2,914,941 (registered December 28, 2004).

98. U.S. Trademark Registration No. 2,781,298 (registered November 11, 2003).

99. U.S. Trademark Registration No. 2,646,242 (registered November 5, 2002).

100. U.S. Trademark Registration No. 0,661,636 (registered May 13, 1958, originally to Robert F. Borkenstein).

101. John Seabrook, "Crunch: Building a Better Apple," *New Yorker*, November 21, 2011, p. 61.

102. Ibid.

103. Ibid.

104. U.S. Trademark Registration No. 3,989,066 (registered July 5, 2011).

105. U.S. Trademark Registration No. 3,982,684 (registered June 21, 2011).

106. U.S. Trademark Registration No. 3,842,487 (registered August 31, 2010).

107. U.S. Trademark Registration No. 3,833,196 (registered August 10, 2010, originally to Lincoln Schatz Sculpture, Inc.).

108. U.S. Trademark Registration No. 3,826,265 (registered July 27, 2010).

109. U.S. Trademark Registration No. 3,365,147 (registered January 8, 2008, originally to Cancer Therapy and Research Center). The USPTO cancelled this registration on August 15, 2014, because the University of Texas System did not file an affidavit with the USPTO between the fifth and sixth years of registration, as required by law, indicating that the mark was in use.

110. U.S. Trademark Registration No. 2,924,489 (registered February 1, 2005). The USPTO cancelled this registration September 4, 2015, because the University of North Dakota did not file an affidavit with the USPTO between the ninth and tenth years of registration, as required by law, indicating that the mark was in use.

111. U.S. Trademark Registration No. 2,419,790 (registered January 9, 2001).

112. U.S. Trademark Registration No. 1,926,011 (registered October 10, 1995).

113. U.S. Trademark Registration No. 1,914,851 (registered August 29, 1995).

114. U.S. Trademark Registration No. 1,776,057 (registered June 8, 1993).

115. U.S. Trademark Registration No. 1,662,066 (registered October 22, 1991).

116. U.S. Trademark Registration No. 1,583,042 (registered February 13, 1990).

117. U.S. Trademark Registration No. 3,052,284 (registered January 31, 2006, to the Lance Armstrong Foundation, subsequently assigned to the Livestrong Foundation).

118. Nonprofit organizations outside of higher education can abuse the trademark system, too, and seek protection that goes beyond the purpose of protecting donors, such as when the ALS [Amyotrophic Lateral Sclerosis] Association filed trademark applications in 2014 to register ICE BUCKET CHALLENGE and #ICEBUCKETCHALLENGE with respect to "charitable fundraising." Fortunately, the organization decided to withdraw its applications in light of public backlash. See Robbie Couch, "ALS Association Withdraws Ice Bucket Challenge Trademark Applications amid Backlash," *Huffington Post*, September 2, 2014, www.huffingtonpost.com/2014/09/02/als-association-trademark_n_5752920.html.

119. U.S. Trademark Registration Nos. 3,620,461 (registered May 12, 2009); 3,620,476 (registered May 12, 2009); 3,620,477 (registered May 12, 2009); 3,624,117 (registered May 19, 2009); 3,624,118 (registered May 19, 2009); 3,624,119 (registered May 19, 2009); 3,624,120 (registered May 19, 2009); 3,624,122 (registered May 19, 2009); 3,624,128 (registered May 19, 2009); 3,624,129 (registered May 19, 2009); 3,624,130 (registered May 19, 2009); 3,624,133 (registered May 19, 2009); 3,624,136 (registered May 19, 2009); 3,628,676 (registered May 26, 2009); 3,628,677 (registered May 26, 2009); 3,658,924 (registered July 21, 2009); 3,658,926 (registered July 21, 2009);

3,658,927 (registered July 21, 2009); 3,664,460 (registered August 4, 2009); 3,664,462 (registered August 4, 2009).

120. David A. Divine, Richard W. Goldstein, and Law Practice Management Committee, American Intellectual Property Law Association, *AIPLA Report of the Economic Survey* (2013), p. I-100. Actual figures varied by region of the country and by the size of the law firm.

121. Ibid., pp. I-101–I-102. In 2012, intellectual-property lawyers received $998 per mark, on average, for preparing and filing a renewal application and statement of use, not including any other costs that were incurred in this process.

122. U.S. Trademark Registration Nos. 2,268,371 (registered August 10, 1999); 2,268,372 (registered August 10, 1999); 2,306,912 (registered January 11, 2000); 2,463,627 (registered June 26, 2001); 2,929,720 (registered March 1, 2005); 3,452,504 (registered June 24, 2008); 3,452,505 (registered June 24, 2008); 3,452,506 (registered June 24, 2008); 3,452,507 (registered June 24, 2008); 3,452,508 (registered June 24, 2008); 3,452,509 (registered June 24, 2008).

123. Goldie Blumenstyk, "Princeton's Royalty Windfall Leads to Challenge of Its Tax-Exempt Status," *Chronicle of Higher Education: Bottom Line*, July 8, 2013, http://chronicle.com/blogs/bottomline/princetons-royalty-windfall-leads-to-challenge-of-its-tax-exempt-status/; Anna Merriman, "Burden of Proof Falls to Princeton University in Tax-Exemption Lawsuit," *NJ.com*, November 5, 2015, www.nj.com/mercer/index.ssf/2015/11/burden_of_proof_falls_to_princeton_university_in_t.html.

124. College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board, 527 U.S. 666, 691 (1999) (ruling that a provision of the Trademark Remedy Clarification Act that purported to make states liable for false advertising violated the U.S. Constitution); Board of Regents of the University of Wisconsin System v. Phoenix International Software, Inc., 653 F.3d 448, 458 (7th Cir. 2011) (stating that the Supreme Court's decision in *College Savings Bank* "appear[s] to foreclose [i.e., prevent from being used] any argument that Congress" properly ended states' immunity from liability for trademark-infringement damages); J. Thomas McCarthy, 4 *McCarthy on Trademarks and Unfair Competition* § 25:66 (4th ed., 2014) (noting that "[the anomaly] is that a state can own a trademark and sue for infringement of it in federal court, but that a state cannot be held accountable for monetary damages for its own violations of another's trademark unless the state waives its sovereign immunity and consents to be sued").

125. Eleventh Amendment immunity is of no assistance to private institutions, which still could be held liable for monetary damages if they infringe on trademarks. Here, too, I am skeptical of the argument that a fear of liability lawsuits motivates private institutions to seek trademark protection.

Amid the mounting history of cases initiated by colleges and universities that claimed trademark infringement by others, I have not found one where a third party was the first to allege infringement against a college or a university (although in rare circumstances, this accusation was raised in a counterclaim).

126. James Gibson, "Risk Aversion and Rights Accretion in Intellectual Property Law," 116 *Yale Law Journal* 882 (2007), pp. 907–908.

127. Confusion as to the existence of a license is a legally actionable form of confusion.

128. Christopher Newfield, *Unmaking the Public University: The Forty-Year Assault on the Middle Class* (2008), p. 192.

129. Samantha King & Sheila Slaughter, "Sports 'R' Us: Contracts, Trademarks, and Logos," in *Academic Capitalism and the New Economy: Markets, State, and Higher Education* (Sheila Slaughter & Gary Rhoades eds., 2004), p. 273.

130. Deven R. Desai, "From Trademarks to Brands," 64 *Florida Law Review* 981 (2012).

131. Derek Bok, *Universities in the Marketplace: The Commercialization of Higher Education* (2004), pp. 118–119.

132. Ibid., pp. 119–121.

133. Walter C. Jones, "Regent University of Virginia Sues Georgia University System Regents for Trademark Infringement," *(Jacksonville) Florida Times-Union*, August 22, 2012, www.jacksonville.com/news/georgia/2012-08-22/story/regent-university-virginia-sues-georgia-university-system-regents/.

134. Steve Crawford, "Regents Reach Settlement with Virginia School in Trademark Lawsuit," *Augusta (GA) Chronicle*, June 28, 2013, http://chronicle.augusta.com/news/education/2013-06-28/regents-reach-settlement-virginia-school-trademark-lawsuit/. In fall 2015, Georgia Regents University announced that it would change its name again—this time to Augusta University. See Kellie Woodhouse, "Another New Name," *Inside Higher Ed*, September 16, 2015, https://www.insidehighered.com/news/2015/09/16/georgia-regents-university-undergoes-name-change-again/.

135. Trustees of Columbia University v. Axenfeld, 241 N.Y.S. 4 (Sup. Ct. 1930).

136. Lisa Guernsey, "Washington University Sues to Defend Its Name," *Chronicle of Higher Education*, April 3, 1998, p. A25.

137. Joye Mercer, "Colgate University Objects to Another Institution's Using Its Name," *Chronicle of Higher Education*, May 9, 1997, p. A40.

138. Julie L. Nicklin, "2 State Institutions Battle over 'Ohio,'" *Chronicle of Higher Education*, January 16, 1998, p. A44. A more recent dispute involving the University of Kentucky and a small Kentucky-based distillery raises a related

issue: when and under what circumstances should state-affiliated universities be able to enforce rights to their name when that name also serves as a geographical indicator? Although the University of Kentucky does not manufacture moonshine, the university took the position that t-shirts and other promotional materials bearing the mark KENTUCKY MIST MOONSHINE risked endorsement or sponsorship confusion with the university. See Scott Jaschik, "U of Kentucky Asserts Trademark Right to 'Kentucky,'" *Inside Higher Ed*, October 22, 2015, https://www.insidehighered.com/quicktakes/2015/10/22/u-kentucky-asserts-trademark-right-kentucky/.

139. For further reading on these problems, see James L. Shulman & William G. Bowen, *The Game of Life: College Sports and Educational Values* (2001); Richard T. Karcher, "Broadcast Rights, Unjust Enrichment, and the Student-Athlete," 34 *Cardozo Law Review* 107 (2012); Taylor Branch, "The Shame of College Sports," *Atlantic*, October 2011, p. 80.

140. Board of Supervisors for Louisiana State University Agricultural & Mechanical College v. Smack Apparel Co. [Smack], 550 F.3d 465, 475 (5th Cir. 2008) (ruling that university color schemes are protectable as trademarks); Martin Van Der Werf, "Colors Are Trademarks, Court Says," *Chronicle of Higher Education*, August 11, 2006, p. A25.

141. Smack, 550 F.3d at 478. The court also ruled that the alleged marks were nonfunctional and had acquired a secondary meaning, and that no fair-use defense was available to Smack (pp. 477, 488–489).

142. Bruce Siegal, "Colorful Trends in Collegiate Trademark Protection: School Colors as Trademarks," 25(4) *Entertainment & Sports Law* 6 (2008), p. 8.

143. Arelis Hernandez, "School Attorneys: FAMU Settlement with Porn Video Company Sets Precedent for Trademark Protection," *Diverse Issues in Higher Education*, May 27, 2010, p. 11.

144. Ibid.

145. For a pre-*Smack* dispute emblematic of this problem, see Kelly McCollum, "NYU Sues Proprietor of 'Dorm Cam' Sex Site," *Chronicle of Higher Education*, July 31, 1998, p. A20 (quoting a university official as saying "it's our fundamental right to choose when and how our name gets used").

146. For a well-written elaboration on this doctrine, see Peter M. Brody & Alexandra J. Roberts, "What's in a Domain Name? Nominative Fair Use Online after *Toyota v. Tabari*," 100 *Trademark Reporter: The Law Journal of the International Trademark Association* 1290 (2010), pp. 1301–1318.

147. U.S. Trademark Registration No. 1,948,306 (registered January 16, 1996, to Texas A&M University); U.S. Trademark Registration No. 1,612,053 (registered September 4, 1980, to Texas A&M University).

148. Erin Strout, "Texas A&M Challenges Seattle Seahawks' Use of '12th Man' Trademark," *Chronicle of Higher Education*, February 10, 2006, p. A25.

149. Creg Stephenson, "Florida State Runs Afoul of Texas A&M's Closely Guarded '12th Man' Trademark, Re-Issues Ticket Ad," *AL.com*, June 2, 2014, www.al.com/sports/index.ssf/2014/06/florida_state_runs_afoul_of_te.html; Mark Alesia, "Texas A&M Sues Indianapolis Colts Over Use of '12th Man' Trademark," *Indianapolis Star*, November 12, 2015, www.indystar.com/story/news/2015/11/12/indianapolis-colts-jim-irsay-andrew-luck-texas-am-12th-man-trademark/75661462/.

150. Adam Himmelsbach, "We're the Gators: So Are We; Can't Look Alike, Colleges Say," *New York Times*, November 26, 2010, p. A1.

151. Auburn University v. Moody, No. 3:08-cv-796, 2008 WL 4877542, at *4 (M.D. Ala. Nov. 4, 2008).

152. See, for example, Michael C. Shull, "Biting the Hand That Feeds: How Trademark Protection Might Threaten School Spirit," 21 *Marquette Sports Law Review* 641 (2011) (mentioning enforcement efforts against student organizations at the University of Texas and the University of Kansas involving the unauthorized use of university trademarks).

153. Darren Rovell, "A&M, Family Covet 'Johnny Football,'" ESPN, November 11, 2012, http://espn.go.com/college-football/story/_/id/8619087/johnny-manziel-family-trademark-johnny-football/.

154. Rick Reilly, "Selling Johnny Football," ESPN, February 26, 2013, http://espn.go.com/espn/story/_/id/8990966/selling-johnny-football/.

155. Manziel is not the only college athlete to seek trademark protection for his nickname. The parents of Texas A&M quarterback Kenny Hill sought federal registration of their son's nickname, "Kenny Trill," in 2014. See Darren Rovell, "Hill's Parents Want 'Kenny Trill' Mark," ESPN, September 11, 2014, http://espn.go.com/college-football/story/_/id/11506988/parents-texas-quarterback-kenny-hill-file-kenny-trill-trademark/.

156. Michael Sanserino, "Robert Morris Graduates Coin a Phrase," *Pittsburgh Post-Gazette*, February 2, 2010, www.post-gazette.com/stories/sports/rmu/robert-morris-graduates-coin-a-phrase-231689/.

157. Ibid.

158. U.S. Trademark Registration No. 3,529,382 (registered November 4, 2008, to Robert Morris University).

159. Sanserino, 2010.

160. Lydia Nuzum, "WVU Aims to Stop Sale of Illegal Apparel," *Daily Athenaeum* (Morgantown, WV), February 9, 2012, www.thedaonline.com/article_59ca7354-1d8a-52cf-847d-5d7efe7adeod.html; Jessica M. Karmasek, "WVU Suing Clothing Manufacturer for Obscene Shirts," *(Hurricane) West*

Virginia Record, January 23, 2012, http://wvrecord.com/news/241161-wvu-suing-clothing-manufacturer-for-obscene-shirts/.

161. "Pair Sues Del. College over 'U Can Suck Our D' T-Shirts," *USA Today*, December 14, 2012, www.usatoday.com/story/news/nation/2012/12/14/tshirts-free-speech-lawsuit/1769195/.

162. Ibid.

163. Duke University v. Benson J. Williams, Opposition Nos. 91/220,555, Notice of Opposition (February 9, 2015).

164. Ibid., ¶ 14, p. 5.

165. Ibid., ¶ 15, pp. 5–6.

166. Duke University's opposition to this trademark application had been suspended, pending settlement negotiations, as this book went to press in 2016. Benson Williams received a registration for DRANK UNIVERSITY, as used in relation to assorted cups, in March 2015. See U.S. Trademark Registration 4,702,269 (registered March 17, 2015, to Benson Williams). There is no indication why Duke chose to oppose the trademark application related to athletic apparel, but not the one related to cups.

167. See "Welcome to Drank University Clothing," https://drank-university.com, and the Facebook page for Drank University Clothing, https://www.facebook.com/DrankUniversityClothing/.

168. U.S. Trademark Registration No. 4,561,709 (registered July 8, 2014, to the Pennsylvania State University).

169. As this book went to press in 2016, the trademark cancellation proceeding was still pending, and Penn State's application to register PENN STATE WHITE OUT in relation to shirts was suspended, pending the resolution of the cancellation proceeding.

170. U.S. Trademark Registration No. 3,707,623 (registered November 10, 2009, to Boise State University).

171. Michelle Gallagher, "Who Owns Blue? An Examination of the Functionality Doctrine in University Sports Color," 104(3) *Trademark Reporter: The Law Journal of the International Trademark Association* 765 (May–June 2014).

172. Ibid., p. 799.

173. Ibid.

174. Boise State is not the only institution to run afoul of this principle. In 2014, Oklahoma State University agreed to license the image of its Pistol Pete mascot to New Mexico State University, which adopted and continues to use a similar image for its sports team. The mascots are nearly identical, both with wild mustaches, bowed legs, titled cowboy hats, and one gun holstered and the other drawn. The main difference is in the mascots' coloration and the

direction in which their faces are pointing. Oklahoma State University initially sued New Mexico State University for trademark infringement but agreed to license the mark for $10.00 per year as part of the settlement. See Mike Bush, "Pistol Pete Showdown Ends in a Draw," *Albuquerque Journal News*, December 3, 2014, www.abqjournal.com/504850/news/pistol-peter-showdown-ends-in-a-draw.html.

175. Gallagher, 2014, pp. 807–808.

176. Several other universities own other curious, athletics-related trademark registrations that have a potential for enforcement abuse. For example, Arizona State University, the University of Miami, and the University of Texas at Austin all have registered depictions of human hands making various gestures. See, respectively, U.S. Trademark Registration Nos. 4,631,228 (registered November 4, 2014); 4,147,043 (registered May 22, 2012); and 4,535,612 (registered May 27, 2014). The University of Arkansas has registered a sound mark that consists of a cheering crowd using the words—and here I quote from the federal registration certificate—"Wooooooooo. Pig. Sooie! Wooooooooo. Pig. Sooie! Wooooooooo. Pig. Sooie! Razorbacks!" See U.S. Trademark Registration No. 4,558,864 (registered July 1, 2014). See also Briana Emerson & Michael Spink, "We've Got Spirit—and It's Trademarked," *Law360*, March 18, 2015, www.law360.com/articles/632439/we-ve-got-spirit-and-it-s-trademarked/.

177. Gallagher, 2014, p. 810.

178. U.S. Trademark Registration No. 1,542,293 (registered June 6, 1989). The university elected not to renew the registration, and it was subsequently cancelled in January 2010.

179. Nick DeSantis, "East Carolina U. Fights with Cisco over Marketing Slogan," *Chronicle of Higher Education: The Ticker*, January 11, 2013, http://chronicle.com/blogs/ticker/east-carolina-u-fights-with-cisco-over-marketing-slogan/54071/; U.S. Trademark Registration No. 3,950,816 (registered April 26, 2011, to East Carolina University).

180. Kirk Johnson, "A University Steak to Go with That Sweatshirt?," *New York Times*, March 2, 2013, www.nytimes.com/2013/03/03/us/how-about-a-university-steak-with-your-sweatshirt.html.

181. "The Miracle Apple," *Planet Money: The Economy Explained*, episode 627, NPR, May 27, 2015; Greg Breining, "Get a Load of This Apple," *Minnesota Alumni Magazine*, Winter 2010, www.minnesotaalumni.org/s/1118/content.aspx?sid=1118&gid=1&pgid=947&cid=2189&ecid=2189&ciid=13702&crid=0/.

182. U.S. Trademark Registration Nos. 3,455,128; 3,905,291; 3,901,739; 4,028,686 (all owned by the University of Minnesota and covering SWEETANGO, as used in relation to fresh apples and related products).

183. Seabrook, 2011, p. 54.

184. For example, see Manny Fernandez, "Not To Be, Um, Trifled With, Texas Guards Its Slogans," *New York Times*, September 15, 2013, p. A13 (describing the lengths to which the Texas Department of Transportation has gone to enforce its registered trademark, DON'T MESS WITH TEXAS, against over 100 companies and individuals, including the author of a romance novel). The New York State Department of Economic Development has behaved similarly with respect to its registered trademark, I ♥ NY, enforcing it against local coffee shops and other small-scale concerns. See Andy Newman, "Cup in Logo Is at Heart of a Trademark Dispute," *New York Times*, May 30, 2013, p. A18.

185. The enforcement stories discussed in this chapter do not suggest that trademark enforcement is always an improper activity for colleges and universities. Every institution should enjoy rights in its name and related logos and insignia (assuming that they serve a source-identifying function) and be able to enforce those rights in appropriate instances. The public benefits from the recognition and maintenance of these rights, as they limit the potential for confusion when college applicants determine where to apply and employers decide whom to hire. It is no secret that higher education plays a sorting function. The value of a Yale University degree becomes cheapened if there is more than one university with that name. Trademark protection helps set the rules of the educational hierarchy that exists in this country. Within any given student's academic career, thousands of decisions are made by that student and the institution alike (for example, which courses are offered, which are taken, how hard one works, the grades one receives, etc.) that help set the student on a given path in life. Ultimately, however, these decisions fade into personal and institutional memory, and the only thing that is lasting is the degree, which is part certification and part brand.

186. Alan Pifer, "Beyond Divestment: The Moral University," 38(9) *AAHEA [American Association for Higher Education and Accreditation] Bulletin*, May 1986, p. 3.

187. Goldie Blumenstyk, "Graduate Students Press for 'Humanitarian Licensing' Vow in U. of California Patent Policy," *Chronicle of Higher Education*, December 14, 2011, http://chronicle.com/article/Graduate-Students-Press-for/130097/.

188. 35 U.S.C. §§ 200, 202(c)(3) (2013) (describing the policy and objective of the Bayh-Dole Act to be, in part, "to promote collaboration between commercial concerns and nonprofit organizations, including universities," and requiring universities electing to retain rights in inventions covered by the act to seek patents on those inventions).

Chapter 4. University Patents under the Sun

1. See Kyle Jensen & Fiona Murray, "Intellectual Property Landscape in the Human Genome," 310 *Science* 239 (October 14, 2005).

2. See Christopher M. Holman, "Will Gene Patents Derail the Next Generation of Genetic Technologies? A Reassessment of the Evidence Suggests Not," 80(3) *UMKC [University of Missouri–Kansas City] Law Review* 563 (2012), p. 575 (stating that "[Jensen & Murray's 2005] article provides no quantitative assessment of the extent to which human genes are patented. Any assertion that their article provides evidence that 20% of human genes are patented is pure nonsense"); Susan Decker, "Myriad Wins U.S. Appeal Over Ability to Patent Isolated DNA," *Bloomberg*, August 16, 2012, www.bloomberg.com/news/2012-08-16/myriad-wins-u-s-appeal-over-ability-to-patent-isolated-dna-2-.html (noting that "the U.S. Patent and Trademark Office has issued more than 2,600 patents on genes," although other sources put the number of gene patents at 4,000); Lori Pressman, Richard Burgess, Robert M. Cook-Deegan, Stephen J. McCormack, Io Nami-Wolk, Melissa Soucy, & LeRoy Walters, "The Licensing of DNA Patents by Large U.S. Academic Institutions: An Empirical Survey," 24 *Nature Biotechnology* 31 (January 2006), p. 33 (mentioning that of the thirty entities holding the largest number of DNA patents in the United States as of 2005, thirteen were nonprofit universities).

3. E. Richard Gold & Julia Carbone, "Myriad Genetics: In the Eye of the Policy Storm," 12(4) *Genetics in Medicine* S39 (April 2010, Supplement), p. S41. Mary-Claire King, a researcher at the University of California, Berkeley, was the first to make the general discovery that a single gene located on chromosome 17 was responsible for a large number of cases of early-onset breast cancer. Mark Skolnick and his team, however, were the first to identify the precise location of the gene, clone it, and then sequence the clones. See Jacob S. Sherkow & Henry T. Greely, "History of the Patenting of Genetic Material," 49 *Annual Review of Genetics* 161 (December 2015). History might have turned out differently had King been the first to sequence the gene. In an interview in 2015, she seemed to indicate that she would not have sought a patent on the gene at all, or at least would have licensed any patent nonexclusively, at a reasonable cost. At one point, Myriad Genetics even sent King a cease-and-desist letter. See Claudia Dreifus, "A Never-Ending Genetic Quest," *New York Times*, February 9, 2015, www.nytimes.com/2015/02/10/science/mary-claire-kings-pioneering-gene-work-from-breast-cancer-to-human-rights.html.

4. The decision to license the patents to Myriad Genetics on an exclusive basis may have been driven as much by Skolnick as it was by any administrator

at the University of Utah. Superstar faculty often enjoy decision-making authority over how their patents are commercialized, as universities fear losing such individuals to other institutions if the original university does not accede to their wishes.

5. Dennis Crouch, "Federal Circuit Hears Myriad Gene Patent Case," *PatentlyO*, April 4, 2011, www.patentlyo.com/patent/2011/04/federal-circuit-hears-myriad-gene-patent-case.html.

6. Jacob S. Sherkow & Christopher Scott, "Myriad Stands Alone," 32 *Nature Biotechnology* 620 (2014); Sheldon Krimsky, *Science in the Public Interest: Has the Lure of Profits Corrupted Biomedical Research?* (2003), p. 67 (noting that the University of Pennsylvania conducted more than 700 tests a year before terminating its breast cancer–testing program in response to threats from Myriad Genetics).

7. Sherkow & Scott, 2014.

8. Peter Lee, "The Supreme Court's *Myriad* Effects on Scientific Research: Definitional Fluidity and the Legal Construction of Nature," 5(5) *UC Irvine Law Review* 1077 (2015); Sandra S. Park, "Gene Patents and the Public Interest: Litigating *Association for Molecular Pathology v. Myriad Genetics* and Lessons Moving Forward," 15 *North Carolina Journal of Law and Technology* 519 (2014), p. 523 (mentioning "near unanimity within the medical and scientific communities that ending gene patents would benefit patients, science, and medicine").

9. See Jonathan Stempel, "Supreme Court to Decide if Human Genes Patentable," *Reuters*, November 30, 2012, www.reuters.com/article/2012/11/30/us-usa-court-genes-idUSBRE8AT19620121130.

10. Some Americans traveled abroad in order to undergo additional genetic testing to verify the results reported by Myriad Genetics.

11. See Robert Langreth, "Do-It-Yourself Gene Testing Threatens Myriad's Monopoly," *Forbes*, October 10, 2011, www.forbes.com/sites/robertlangreth/2010/10/11/do-it-yourself-gene-testing-threatens-myriads-monopoly/ (reporting that Myriad Genetics charged $3,000 to test for breast cancer risk).

12. Some have questioned the clinical validity of genetic sequencing offered by companies like Myriad Genetics. While the test may be less than predictive, there is no doubt that patients benefit from information about probabilities, as well as that the University of Utah's handling of its patents unreasonably restricted who could access information about an individual's genetic predispositions, and on what terms.

13. It should be noted that the American Civil Liberties Union (ACLU) was instrumental in identifying plaintiffs for the lawsuit, representing them, and funding the litigation. See Park, 2014. The actual plaintiffs in the case consisted of four national associations of pathologists and geneticists; six

individual geneticists; two genetic counselors; two breast cancer and women's health groups; and six patients (p. 527). Arti K. Rai and Robert Cook-Deegan have persuasively argued that litigation most likely would have been avoided if the University of Utah had licensed its patents nonexclusively. See Rai & Cook-Deegan, "Moving Beyond 'Isolated' Gene Patents," 341 *Science* 137 (July 12, 2013), p. 138.

14. Association for Molecular Pathology v. Myriad Genetics, Inc., 689 F.3d 1303, 1324 (Fed. Cir. 2012).

15. Sandra S. Park, "James Watson, Discoverer of DNA: Patenting Human Genes Is 'Lunacy,'" ACLU, June 26, 2012, www.aclu.org/blog/womens-rights-free-speech-capital-punishment-criminal-law-reform/james-watson-discoverer-dna/. Watson actually resigned from the National Institutes of Health because he disagreed with the government's decision to seek patents on isolated genes (p. 525). Fortunately, the federal government changed its position on whether human genes could or should be patented once the *Myriad* litigation reached the CAFC (p. 526).

16. Association for Molecular Pathology, 689 F.3d at 1352 (Bryson, J., dissenting). See also Sigrid Sterckx, "Knowledge Transfer from Academia to Industry through Patenting and Licensing: Rhetoric and Reality," in *The Commodification of Academic Research: Science and the Modern University* (Hans Radder ed., 2010), p. 58 (arguing that "patents should require invention rather than serendipitous discovery and skilled wordplay").

17. Universal Declaration on the Human Genome and Human Rights (November 11, 1997), art. 4. Myriad Genetics and its supporters argued that the act of isolating the *BRCA1* and *BRCA2* genes, like the isolation of any human gene, is an act of human intervention that removes the genes from their natural state.

18. See Michael J. Madison, Brett M. Frischmann, & Katherine J. Strandburg, "The University as Constructed Cultural Commons," 30 *Washington University Journal of Law and Policy* 365 (2009), p. 388 (stating that "control of technology transfer operations is a form of governance at the boundary between commons and commerce"); Michael A. Heller & Rebecca S. Eisenberg, "Can Patents Deter Innovation? The Anticommons in Biomedical Research," 280(5364) *Science* 698 (May 1, 1998), p. 701 (noting that "privatization of upstream biomedical research in the United States may create anticommons property that is less visible than empty storefronts but even more economically and socially costly. In this setting, privatization takes the form of intellectual property claims to the sorts of research results that, in an earlier era, would have been made freely available in the public domain").

19. Park, 2014, p. 529. Plaintiffs in the *Myriad* case included physicians at the University of Pennsylvania School of Medicine and the New York

University School of Medicine, all of whom offered *BRCA* testing until they faced lawsuits and litigation threats from Myriad Genetics. See Association for Molecular Pathology, 689 F.3d at 1314–1316.

20. Gold & Carbone, 2010, pp. S65–S66.

21. Association for Molecular Pathology v. Myriad Genetics, Inc., 133 S.Ct. 2107, 2117 (2013).

22. Ibid., p. 2118.

23. Dan L. Burk questioned the coherency of the court's determination, arguing that its "split the baby" approach to holding that isolated DNA is ineligible for patent, but that cDNA is patent eligible, "by no means implies a just or preferable outcome," as both isolated DNA and cDNA convey information, and both are created through acts of human intervention. See Burk, "The Curious Incident of the Supreme Court in *Myriad Genetics*," 90(2) *Notre Dame Law Review* 505 (2014), p. 510. His argument has resonance from the standpoint of legal and logical consistency; it does not, however, take into account the court's important and long-standing role in deciding and formulating macroscopic-level policy in ways that can positively impact disputed legal interpretations and influence industrial norms.

24. Lee, 2015, p. 111, n.70.

25. Park, 2014, p. 535 (noting that Myriad "will litigate to protect [its monopoly] for as long as possible"). Relatedly, Jacob Sherkow and Christopher Scott have argued that Myriad Genetics followed a business model that relied too heavily on its patent portfolio, leaving it no other option but to focus on its litigation strategy because of the firm's poor business footing. See Sherkow & Scott, 2014.

26. Lee, 2015, p. 134.

27. In re *BRCA1*- and *BRCA2*-Based Hereditary Cancer Test Patent Litigation, Case No. 14-1361 (Fed. Cir. December 27, 2014), slip opinion, p. 15.

28. Andrew Pollack, "Myriad Genetics Ending Patent Dispute on Breast Cancer Risk Testing," *New York Times*, January 27, 2015, www.nytimes.com/2015/01/28/business/myriad-genetics-ending-patent-dispute-on-breast-cancer-risk-testing.html.

29. By the time of the settlement, the popularity of whole-genome sequencing had eclipsed the single-gene or panel sequencing of the kind that Myriad Genetics conducted, so other diagnostic alternatives were already emerging in the marketplace.

30. Examples of this trend are numerous. For some prominent illustrations, see E. Gordon Gee, "Colleges Must Find Innovative Ways to Finance Their Missions," *Chronicle of Higher Education*, October 30, 2011, http://chronicle.com/article/Colleges-Must-Find-Innovative/129568/ (by a former

Ohio State University president, arguing that universities must reconceptualize how they finance their core missions by "finding innovative ways to leverage the market" and "commercializing technological innovations"); Michael M. Crow, "Beyond the 'New Normal' in American Higher Education: Toward Perpetual Innovation," in *Smart Leadership for Higher Education in Difficult Times* (David W. Breneman & Paul J. Yakoboski eds., 2011), p. 58 (by the current Arizona State University president, arguing that "in order to maximize the potential for innovation, institutions must organize to exploit complementarities and establish new degrees of connectivity, both internally and externally, with stakeholders in the public and private sectors"); Goldie Blumenstyk, "U. of Maryland to Count Patents and Commercialization in Tenure Reviews," *Chronicle of Higher Education*, June 13, 2012, http://chronicle.com/article/U-of-Maryland-to-Count/132261/ (reporting that the University System of Maryland will give formal credit in tenure and promotion decisions for faculty work that leads to patents, as part of the system's "broader push to promote the commercialization of academic research"); Monica Mendoza, "Research Partners: UCCS Creating Legal Terms to Court Private Industry," *Colorado Springs Business Journal*, November 9, 2012 (reporting that the University of Colorado at Colorado Springs "is drawing up new legal agreements that list the university and private industry as co-developers. It's like a pre-nup of sorts: each partner—the university and the company—that comes to the union with its own intellectual property walks away with it. It's a shrewd move for [the university], but one that could woo more industry partnerships"), www.csbj.com/2012/11/09/research-partners-uccs-creating-legal-terms-to-court-private-industry/; John C. Lechleiter, "Let's Build on Our Strengths in the Life Sciences," *Indianapolis Star*, November 25, 2012, p. B7 (by the CEO of Indiana-based Eli Lilly & Co., arguing that "Indiana's great research universities—public and private—must embrace the notion that one of their prime functions is to actively assist in the process of translating new knowledge into useful products that serve the larger society. We need an infusion of entrepreneurial spirit into our research universities—more people open to pursuing the applications of their research, working collaboratively with others outside their own walls, including industry, and, yes, even starting companies"); Scott Jaschik, "Ties Grow between Drug Industry, Biomedical Research," *Inside Higher Ed*, November 26, 2012 (reporting that "the pharmaceutical industry has come to support more [biomedical] research [at universities] than does the federal government"), https://www.insidehighered.com/quicktakes/2012/11/26/ties-grow-between-drug-industry-biomedical-research/; Peter Lee, "Transcending the Tacit Dimension: Patents, Relationships, and Organizational Integration in Technology Transfer," 100 *California Law Review* 1503 (2012), p. 1572 (arguing that

organizational innovations are starting to "blur the institutional boundaries between universities and firms").

31. For examples, see Jens Krogstad, "Universities Struggle with Falling Invention Royalties," *USA Today*, November 25, 2012 (noting that "administrators are pushing faculty to patent and commercialize products" in light of budgetary woes and tightened research budgets, according to the Vice President for Research and Economic Development at Iowa State University), www.usatoday.com/story/money/business/2012/11/25/universities-struggle-with-falling-invention-royalties/1725591/; Ken Auletta, "Get Rich U.: There Are No Walls between Stanford and Silicon Valley; Should There Be?," *New Yorker*, April 30, 2012 (stating that "Stanford's entrepreneurial culture has also turned it into a place where many faculty and students have a gold-rush mentality and where the distinction between faculty and student may blur as, together, they seek both invention and fortune"), www.newyorker.com/magazine/2012/04/30/get-rich-u/; Graelyn Brashear, "Biotech U.: Marrying Academia and Industry in Charlottesville," *C-VILLE (VA) Weekly*, May 8, 2012 (reporting that the executive director of innovation at the University of Virginia "acknowledges that he measures his success as chief innovator in part by his ability to create conflicts of interest"), www.c-ville.com/Biotech_U_Marrying_academia_and_industry_in_Charlottesville/.

32. See Gold & Carbone, 2010, p. S64 (noting the difficulty of "liv[ing] under both the imperative to share and the requirement to patent"); Elizabeth Popp Berman, *Creating the Market University: How Academic Science Became an Economic Engine* (2012).

33. Sara Boettinger & Alan B. Bennett, "Bayh-Dole: If We Knew Then What We Know Now," 24 *Nature Biotechnology* 320 (2006), p. 323.

34. David E. Winickoff, "Private Assets, Public Mission: The Politics of Technology Transfer and the New American University," 54 *Jurimetrics Journal* 1 (2013), p. 5.

35. David C. Mowery, Richard R. Nelson, Bhaven N. Sampat, & Arvids A. Ziedonis, *Ivory Tower and Industrial Innovation: University-Industry Technology Transfer before and after the Bayh-Dole Act*, 2004, p. 49.

36. David C. Mowery, Richard R. Nelson, Bhaven N. Sampat, & Arvids A. Ziedonis, "The Growth of Patenting and Licensing by U.S. Universities: An Assessment of the Effects of the Bayh-Dole Act of 1980," 30(1) *Research Policy* 99 (2001), p. 104.

37. See Rebecca S. Eisenberg, "Public Research and Private Development: Patents and Technology Transfer in Government-Sponsored Research," 82 *Virginia Law Review* 1663 (1996).

38. 35 U.S.C. § 200. More recently, some argue that this "collaboration" has become too cozy, and that the law should be changed accordingly. See

Howard Markel, "Patents, Profits, and the American People—the Bayh-Dole Act of 1980," 369 *New England Journal of Medicine* 794 (2013), p. 795.

39. Jonathan R. Cole, *The Great American University: Its Rise to Preeminence, Its Indispensable National Role, Why It Must Be Protected* (2009), p. 163.

40. Gary W. Matkin, *Technology Transfer and the University* (1990), p. 5.

41. Valerie Landrio McDevitt, Joelle Mendez-Hinds, David Winwood, Vinit Nijhawan, Todd Sherer, John F. Ritter, & Paul R. Sanberg, "More than Money: The Exponential Impact of Academic Technology Transfer," 16 *Technology and Innovation* 75 (2014), p. 76.

42. Mowery et al., 2004 (providing a detailed history of the Bayh-Dole Act, TTOs, and patenting by universities in the United States).

43. Sheila Slaughter & Gary Rhoades, *Academic Capitalism and the New Economy: Markets, State, and Higher Education* (2004), p. 313.

44. 35 U.S.C. § 202(c)(4).

45. 35 U.S.C. § 202(a)(ii).

46. 35 U.S.C. § 203(a)(1)–(4).

47. See, for example, Carolyn L. Treasure, Jerry Avorn, & Aaron S. Kesselheim, "What Is the Public's Right to Access Medical Discoveries Based on Federally Funded Research?," 311(9) *JAMA: Journal of the American Medical Association* 907 (March 5, 2014); Michael S. Mireles, "The Intended and Unintended Consequences of the Bayh-Dole Act," in 2 *Intellectual Property and Information Wealth: Issues and Practices in the Digital Age* (Peter K. Yu ed., 2007), p. 287. Nonetheless, politicians and others do, from time to time, urge the government to march in. See Jacob S. Sherkow, "Administrating Patent Litigation," 90 *Washington Law Review* 2015 (2015).

48. Mowery et al., 2004, p. 80.

49. Diamond v. Chakrabarty, 447 U.S. 303 (1980); Diamond v. Diehr, 450 U.S. 175 (1981).

50. Arti K. Rai, John R. Allison, & Bhaven N. Sampat, "University Software Ownership and Litigation: A First Examination," 87 *North Carolina Law Review* 1519 (2009).

51. Henry Etzkowitz & Andrew Webster, "Entrepreneurial Science: The Second Academic Revolution," in *Capitalizing Knowledge: New Intersections of Industry and Academia* (Henry Etzkowitz, Andrew Webster, & Peter Healey eds., 1998).

52. Winickoff, 2013, p. 9.

53. Jerry Thursby & Marie Thursby, "Knowledge Creation and Diffusion of Public Science with Intellectual Property Rights," in 2 *Frontiers of Economics and Globalization* (2008), p. 205. See also Margo A. Bagley, "Academic Discourse and Proprietary Rights: Putting Patents in Their Proper Place," 47

Boston College Law Review 217 (2006); Adam B. Jaffe & Josh Lerner, *Innovation and Its Discontents: How Our Broken Patent System Is Endangering Innovation and Progress, and What to Do about It* (2004).

54. Milton Cerny & Kelly L. Hellmuth, "Economic Crisis? Technology Transfer to the Rescue," 21 *Taxation of Exempts* 6 (2010).

55. Board of Trustees of Leland Stanford Junior University v. Roche Molecular Systems, Inc., 131 S. Ct. 502 (2010).

56. The problem stems from the fact that tenured faculty are not bound to any substantial changes in their employment contracts without the provision of an additional consideration, such as money or something else of value. Some institutions, like the University of Pittsburgh, have changed their intellectual-property policies over the objections of their faculty. Any new hires are bound by the new policy, and the university refuses to sign grant applications from faculty members who do not agree to the new policy. See "New Deadline for IP Form Is Nov. 21," 47(6) *University [of Pittsburgh] Times: The Faculty & Staff Newspaper since 1968* 1 (November 6, 2014).

57. Matkin, 1990, p. 307.

58. Irwin Feller, "Technology Transfer from Universities," in 7 *Higher Education: Handbook of Theory and Research* (John C. Smart ed., 1997), p. 1.

59. Association of University Technology Managers (AUTM) STATT database, www.autm.net/resources-surveys/research-reports-databases/statt-database-%281%29/.

60. Ibid.

61. Mowery et al., 2004, p. 25.

62. McDevitt et al., 2014, p. 78 (noting that "universities themselves are now more frequently looking to technology transfer to find profitable technologies that will augment shrinking funding opportunities").

63. Goldie Blumenstyk, "Universities and Other Groups Earned $2.6 Billion from Inventions in 2012," *Chronicle of Higher Education*, August 6, 2013, http://chronicle.com/article/UniversitiesOther-Groups/140883/.

64. AUTM STATT database.

65. Ibid.

66. Ibid.

67. Walter W. Powell, Jason Owen-Smith, & Jeannette Colyvas, "Innovation and Emulation: Lessons from American Universities in Selling Private Rights to Public Knowledge," 45(2) *Minerva* 121 (2007), p. 128.

68. Michael N. Bastedo & Nathan F. Harris, "The State Role in Entrepreneurship and Economic Development: Governance, Oversight, and Public University Start-Up Innovation," 19 *Advances in the Study of Entrepreneurship, Innovation & Economic Growth* 215 (2009).

69. Cole, 2009, p. 167.

70. Joshua B. Powers & Eric G. Campbell, "University Technology Transfer: In Tough Economic Times," 41(6) *Change: The Magazine of Higher Learning* 43 (2009).

71. Walter D. Valdivia, "University Start-Ups: Critical for Improving Technology Transfer," Brookings Research Papers (November 20, 2013), p. 9, www.brookings.edu/research/papers/2013/11/university-start-ups-technology-transfer-valdivia.

72. Matthew M. Mars, Sheila Slaughter, & Gary Rhoades, "The State-Sponsored Student Entrepreneur," 79(6) *Journal of Higher Education* 638 (2008).

73. Cole, 2009, p. 169.

74. Paul Basken, "Chasing Nanotechnology, Greensboro Gambles with State Money," *Chronicle of Higher Education*, April 24, 2011, http://chronicle.com/article/Chasing-Nanotechnology/127241/.

75. K. Lance Anderson, "UC Ventures: How One Very Large Public University System Is Setting an Example; Or Is It?," *National Law Review*, January 4, 2015, www.natlawreview.com/article/uc-ventures-how-one-very-large-public-university-system-setting-example-or-it/.

76. John T. Aquino, "Universities Showing Flexibility on Industry-Sponsored Research," *Patent Trademark & Copyright Law Daily*, October 24, 2014.

77. Ibid.

78. Also influencing the thinking of university decision makers is the unspoken reality that faculty may flee to other institutions that are more willing to abide by their commercialization wishes if the original university does not grant an exclusive license to the faculty member's own spinoff company.

79. U.S.C. 35 §§ 202(c)(2) and 202(d). If a university elects not to retain ownership of a faculty member's invention under the Bayh-Dole Act, the funding agency may either receive title to the invention or allow the faculty inventor to retain rights to the invention.

80. Liza Vertinsky suggests that the Bayh-Dole Act should be amended to permit universities to own faculty inventions but not seek patent protection for them. See Vertinsky, "Universities as Guardians of Their Inventions," 2012 *Utah Law Review* 1949 (2012).

81. See Timothy Denny Green, "'All Substantial Rights': Toward Sensible Patent Licensee Standing," 22 *Federal Circuit Bar Journal* 1 (2012), pp. 6–7 (noting that "a license can be exclusive along several fronts, including: time, territory, field of use, or by core rights (make, use, or sell)").

82. U.S.C. § 202(c)(3). Under the Bayh-Dole Act, universities must seek patent protection for any invention made by a member of their faculty that

was conceived or "first actually reduced to practice" (i.e., a working model of the claimed invention was created to demonstrate that it would fulfill its intended purpose) in the performance of work under a federal funding agreement, provided that the university has chosen to retain title to the invention, which it need not do. But even if it retains title to an invention and seeks patent protection on it, the university has options for what to do with the patent. It could, for example, decide to license the patent for a nominal fee, on a nonexclusive basis, to anyone interested in licensing it, or to commercialize it through a dedication to the public domain. See also Christopher S. Hayter, "A Social Responsibility View of the 'Patent-Centric Linear Model' of University Technology Transfer," 54(1) *Duquesne Law Review* 7 (2016).

83. See, for example, Derek C. Bok, *Universities in the Marketplace: The Commercialization of Higher Education* (2003), p. 112 (observing that "zealous campus officials can slow commercial applications and drive up prices of valuable products by granting exclusive patent licenses, where nonexclusive licenses would be feasible, merely to let the university share in any monopoly profits that the exclusive licensee manages to earn").

84. See Mowery et al., 2004.

85. See also "Defending the Freedom to Innovate: Faculty Intellectual Property Rights after *Stanford v. Roche*," AAUP Reports and Publications, June 2014, www.aaup.org/report/defending-freedom-innovate-faculty-intellectual-property-rights-after-stanford-v-roche-o/.

86. Jane S. Smith, *Patenting the Sun: Polio and the Salk Vaccine* (1990), p. 338; Krimsky, 2003, p. 77 (noting that "neither Salk nor the March of Dimes, which supported his research, would patent or receive royalties for their discovery/invention").

87. Dan Morell, "Jay Bradner," *Atlantic*, November 2012, www.theatlantic.com/magazine/archive/2012/11/jay-bradner/309122/.

88. Brian J. Love, "Do University Patents Pay Off? Evidence from a Survey of University Inventors in Computer Science and Electrical Engineering," 16 *Yale Journal of Law and Technology* 285 (2014), p. 329.

89. Ibid.

90. Heidi Ledford, "Universities Struggle to Make Patents Pay," 501 *Nature* 471 (September 26, 2013).

91. Daniel R. Cahoy, Anthony M. Kwasnica, & Luis A. Lopez, "The Role of Auctions in University Intellectual Property Transactions," 54(1) *Duquesne Law Review* 53 (2016).

92. Compare Penn State's approach with how many institutions choose to handle their unused patents: by trafficking with patent trolls. The next section in this chapter explains this problem in more detail.

93. AUTM STATT database.

94. Valdivia, 2013.

95. Robert E. Litan & Robert M. Cook-Deegan, "Universities and Economic Growth: The Importance of Academic Entrepreneurship," in *Rules for Growth: Promoting Innovation and Growth through Legal Reform* (Robert E. Litan & Kauffman Task Force on Law, Innovation, and Growth eds., 2011), p. 72.

96. Lorelei Ritchie de Larena, "The Price of Progress: Are Universities Adding to the Cost?," 43 *Houston Law Review* 1373 (2007).

97. See "WiSys," WARF: Wisconsin Alumni Research Foundation, www.warf.org/about-us/background/affiliates/wisys/wisys.cmsx; Jeff Charis-Carlson, "UNI Partners with ISU to Commercialize More Inventions," *Des Moines Register*, June 11, 2015, www.desmoinesregister.com/story/news/education/2015/06/11/iowa-state-university-northern-inventions-partnership/71090308/.

98. See also James D. Clements, "Improving Bayh-Dole: A Case for Inventor Ownership of Federally Sponsored Research Patents," 49 *IDEA: The Intellectual Property Law Review* 469 (2009) (presenting the case for inventor ownership of patentable inventions derived from federal research dollars).

99. Litan & Cook-Deegan, 2011 (advocating serious consideration of the "free agency" model of technology transfer and/or inventor IP ownership); "Taking Action, Building Confidence: Five Common-Sense Initiatives to Boost Jobs and Competitiveness," President's Council on Jobs and Competitiveness (2011), p. 22 (advocating an "open source" approach to technology transfer), http://files.jobs-council.com/jobscouncil/files/2011/10/JobsCouncil_InterimReport_Oct11.pdf; American Association of University Professors, *Recommended Principles & Practices to Guide Academy-Industry Relationships* (2014) (recommending that "faculty inventor 'assignment' of an invention to a management agent, including the university that hosted the underlying research, should be voluntary and negotiated, rather than mandatory, unless federal statutes or previous sponsored research agreements dictate otherwise").

100. See Clements, 2009; Brian J. Love, "Subsidizing 'Patent Roulette,'" *Indianapolis Star*, March 5, 2012, p. A13.

101. Some view the existing system, albeit imperfect, as providing a more workable correlation between public funding and the public good.

102. Nonexclusive licensees do not have legal standing to sue for patent infringement, whether by themselves or in conjunction with the patent owner. See Sicom Systems, Ltd. v. Agilent Technologies, Inc., 427 F.3d 971, 976 (Fed. Cir. 2005) (ruling that "a nonexclusive license confers no constitutional

standing on the licensee to bring suit or even to join a suit with the patentee because a nonexclusive licensee suffers no legal injury from infringement").

103. The rationale for this rule is that permitting the patentee to decline involvement in litigation involving its exclusive licensee could potentially subject the same defendant to two lawsuits over the same alleged act of infringement: one initiated by the exclusive licensee, and the other by the patentee.

104. American Intellectual Property Law Association, *Report of the Economic Survey* (2013), pp. I-131–I-132.

105. Douglas J. Kline, "Patent Litigation: The Sport of Kings," *MIT Technology Review*, April 28, 2004, www.technologyreview.com/news/402686/patent-litigation-the-sport-of-kings/.

106. See Herbert M. Kritzer, *Risks, Reputations, and Rewards: Contingency Fee Legal Practice in the United States* (2004) (reporting contingency-fee rates ranging from 15% to 50%). See also David L. Schwartz, "The Rise of Contingent Fee Representation in Patent Litigation," 64 *Alabama Law Review* 335 (2012), p. 360 (reporting contingency-fee rates ranging from 28% to 40.2%). Blended arrangements—which combine contingency payments along with fee-for-service payments—also exist.

107. See Schwartz, 2012, pp. 343–356. A patent troll is a pejorative term for an entity that does not manufacture, develop, or sell any product covered by the patents it owns and instead sues alleged infringers as its primary method of reaping financial returns. Synonymous terms, without pejorative connotations, include "nonpracticing entity," "patent-assertion entity," and "patent aggregator." For a discussion of patent trolls and their function in today's patent system, see Colleen V. Chien, "From Arms Race to Marketplace: The New Complex Patent Ecosystem and Its Implications for the Patent System," 62 *Hastings Law Journal* 297 (2010). Or listen to Ira Glass & Chicago Public Media, "When Patents Attack!," *This American Life* podcast, episode 441 (July 22, 2011), www.thisamericanlife.org/radio-archives/episode/441/when-patents-attack/.

108. See Jay P. Kesan, "Transferring Innovation," 77 *Fordham Law Review* 2169 (2009), p. 2193 (noting the enduring view of universities as patent trolls and calling this perception "something that universities and their TTOs should take great care to avoid"); Arti K. Rai, "The Increasingly Proprietary Nature of Publicly Funded Biomedical Research: Benefits and Threats," in *Buying In Or Selling Out? The Commercialization of the American Research University* (R. G. Stein ed., 2004), p. 119 (noting that universities and their licensees have asserted their basic research patents "in a manner that hinders rather than facilitates commercial development").

109. James E. Bessen & Michael J. Meurer, "Lessons for Patent Policy from Empirical Research on Patent Litigation," in *Intellectual Property and Information Wealth* (Yu ed., 2007), p. 205; Ted M. Sichelman & Stuart J. H. Graham, "Patenting by Entrepreneurs: An Empirical Study," 17 *Michigan Telecommunications and Technology Law Review* 111 (2010), pp. 118–119 (noting that "the threat of damages and, typically, injunctive relief, is a proverbial club useful in securing license fees and other payments from actual and potential infringers").

110. Jason Owen-Smith, "Trends and Transitions in the Institutional Environment for Public and Private Science," 49 *Higher Education* 91 (2005), p. 94.

111. Jacob H. Rooksby, "Innovation and Litigation: Tensions between Universities and Patents and How to Fix Them," 15 *Yale Journal of Law & Technology* 312 (2013), p. 351.

112. Jacob H. Rooksby, "When Tigers Bare Teeth: A Qualitative Study of University Patent Enforcement," 46 *Akron Law Review* 169 (2013), p. 200.

113. Ibid., p. 201.

114. John R. Allison, Mark A. Lemley, & Joshua H. Walker, "Patent Quality and Settlement among Repeat Patent Litigants," 99 *Georgetown Law Review* 677 (2011), p. 678.

115. See Scott Shane & Deepak Somaya, "The Effects of Patent Litigation on University Licensing Efforts," 63(4) *Journal of Economic Behavior and Organization* 739 (2007).

116. Walter D. Valdivia, "Patent Infringement Suits Have a Reputational Cost for Universities," Brookings TechTank, November 10, 2015, www.brookings.edu/blogs/techtank/posts/2015/11/10-patent-infringement-university-reputation-valdivia.

117. Mark A. Lemley, "Are Universities Patent Trolls?," 18 *Fordham Intellectual Property, Media & Entertainment Law Journal* 611 (2008).

118. Katherine Lymn, "U Heads for 'Patent Cliff': Come 2013, Royalties from the HIV Drug Ziagen Will Trickle to Zero," *[University of] Minnesota Daily*, October 6, 2011, www.mndaily.com/2011/10/06/u-heads-%E2%80%98patent-cliff%E2%80%99/.

119. Association of University Technology Managers, "In the Public Interest: Nine Points to Consider in Licensing University Technology" [hereinafter "Nine Points"], white paper, March 6, 2007, p. 6, www.autm.net/AUTMMain/media/Advocacy/Documents/Points_to_Consider.pdf.

120. Winickoff, 2013, p. 30.

121. "Nine Points," 2007, p. 6.

122. Ibid., p. 8.

123. See "Nine Points to Consider: Signatories," Association of University Technology Managers, www.autm.net/advocacy-topics/government-issues/principles-and-guidelines/nine-points-to-consider-when-licensing-university/.

124. *Managing University Intellectual Property in the Public Interest: [National Research Council] Committee on Management of University Intellectual Property; Lessons from a Generation of Experience, Research, and Dialogue* (Stephen A. Merrill & Anne-Marie Mazza eds., 2010), www.nap.edu/openbook.php?record_id=13001/, p. 7.

125. Ibid., p. 73.

126. Love, 2014, p. 292.

127. See Joe Mullin, "The Web's Longest Nightmare Ends: Eolas' Patents Are Dead on Appeal," *ArsTechnica*, July 22, 2013, http://arstechnica.com/tech-policy/2013/07/the-webs-longest-nightmare-ends-eolas-patents-are-dead-on-appeal/; Tim Cushing, "After a Decade of Trolling, Eolas Has Its Dubious Patents on 'Web Interactivity' Invalidated," *TechDirt*, July 24, 2013, https://www.techdirt.com/articles/20130724/11295923926/after-decade-trolling-eolas-has-its-dubious-patents-web-interactivity-invalidated.shtml.

128. Mullin, 2013; Cushing, 2013.

129. See Tim Berners-Lee, February 9, 2012, https://twitter.com/timberners_lee/status/167724524299759616/.

130. Mullin, 2013.

131. Carnegie Mellon University v. Marvell Technology Group, Ltd. et al., Civ. Action No. 2:09-cv-00290, Memorandum Opinion (W.D. Pa. March 31, 2014), p. 64.

132. Justine Coyne, "CMU's $1.54B Award Reduced in Marvell Case," *Pittsburgh Business Times*, August 4, 2015, www.bizjournals.com/pittsburgh/news/2015/08/04/cmus-1-54b-award-reduced-in-marvell-case.html.

133. Susan Kelley, "Hewlett-Packard, Cornell Reach Settlement in Patent Case," *Cornell Chronicle*, June 9, 2010, www.news.cornell.edu/stories/2010/06/hewlett-packard-cornell-reach-settlement-patent-case/. For another perspective on this case, see Rai, Allison, & Sampat, 2009, p. 1554 (calling it "contrary to the spirit of Bayh-Dole").

134. Jeff Sistrunk, "Varian Settles with Pitt for $35M after Fed. Cir. Ruling," *Law360*, April 11, 2014, www.law360.com/articles/527522/varian-settles-with-pitt-for-35m-after-fed-circ-ruling/.

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137. David Schwartz, "BU Awarded $13 Million after Jury Finds Tech Companies Willfully Infringed on LED Patent," *Tech Transfer Central: Tech Transfer eNews Blog*, December 9, 2015, http://techtransfercentral.com/2015/12/09/bu-awarded-13-million-after-jury-finds-tech-companies-willfully-infringed-on-led-patent/.

138. Barlow, 2013.

139. Ibid.

140. Dennis Crouch, "Although 'without Tact,' Micron's Retaliatory Decision to Stop Hiring University of Illinois Graduates Is Not Illegal," *PatentlyO*, April 11, 2013, http://patentlyo.com/patent/2013/04/although-without-tact-microns-retaliatory-decision-to-stop-hiring-university-of-illinois-graduates-is-not-illegal.html.

141. Rooksby, "Innovation and Litigation," 2013, p. 352 (reporting a statistically significant finding from a study of universities that litigate patents: decision makers at public universities are more sensitive than decision makers at private ones to the perceived political influence of a potential defendant).

142. "Rembrandt University Solutions," advertisement hyperlinked in an AUTM Newsbrief email sent to subscribers on July 16, 2015. Document originally posted at www.multibriefs.com/briefs/autm/RembrandtUniversitySolutionsarticle1.pdf.

143. 35 U.S.C. § 202(c)(7)(A).

144. "Nine Points," 2007, p. 8.

145. Ledford, 2013; Robin Feldman & W. Nicholson Price II, "Patent Trolling: Why BIO & Pharmaceuticals Are at Risk," 17 *Stanford Technology Law Review* 773 (2014), pp. 777, 795–796 (noting that "there is increasing pressure on universities to monetize their patents by transferring rights to assertion entities" and that "there are increasing signs that universities are transferring rights to monetizers").

146. Tom Ewing & Robin Feldman, "The Giants among Us," 2012 *Stanford Technology Law Review* 1 (2012), pp. 7–8, 43. What this article does not make clear is how Intellectual Ventures obtained these patents: whether directly from universities, or through sales on the secondary market. The figure probably reflects a combination of both.

147. Paul Basken, "Under Financial Pressure, Universities Give Patent Buyers a Closer Look," *Chronicle of Higher Education*, November 1, 2013, p. A8.

148. Michael M. Crow, "The Research University as Comprehensive Knowledge Enterprise: A Prototype for the New American University," in *University Research for Innovation* (Luc Weber & James J. Duderstadt eds., 2010).

149. Holden Thorp & Buck Goldstein, *Engines of Innovation: The Entrepreneurial University in the Twenty-First Century* (2010).

150. See Rooksby, "Innovation and Litigation," 2013.

151. My thanks and acknowledgment to Brian Pusser, who stimulated my thinking on this topic and its ties to global pressures and trends in higher education. See Jacob H. Rooksby & Brian Pusser, "Learning to Litigate: University Patents in the Knowledge Economy," in *Academic Capitalism in the Age of Globalization* (Brendan Cantwell & Ilkka Kauppinen eds., 2014).

152. Goldie Blumenstyk, "Several Universities Oppose Pending 'Patent Reform' Legislation," *Chronicle of Higher Education: The Ticker*, June 21, 2011, http://chronicle.com/blogs/ticker/several-universities-oppose-pending-patent-reform-legislation/34091/.

153. "Obama Signs Patent Reform Bill," *CNN*, September 16, 2011, www.cnn.com/2011/POLITICS/09/16/obama.patent.reform/.

154. Richard Brandon & Sean D. Solberg, "Changes to the Patent Laws," in *The Technology Transfer Law Handbook* (Elizabeth Rodriguez & Sean Solberg eds., 2014).

155. Jason T. Nickla & Emily Harris, "Post-Grant Proceedings under AIA," in *Technology Transfer Law Handbook* (Rodriguez & Solberg eds., 2014).

156. Gene Quinn, "Post-Grant Patent Challenges Concern Universities, Pharma," IPWatchdog, April 1, 2015, www.ipwatchdog.com/2015/04/01/post-grant-patent-challenges-concern-universities-pharma/id=56351/.

157. See Jacob S. Sherkow, "Inter Partes Review Challenges to Orange Book–Listed Patents" (as of June 15, 2015), Harvard Dataverse, http://dx.doi.org/10.7910/DVN/RBWCRK.

158. Early data also show that parties are initiating IPRs in addition to challenging patent validity in the context of federal-court litigation. See Daniel Golub, "IPRs Complicate the Litigation Funding Landscape for Patent Owners," *Landslide: A Publication of the ABA Section of Intellectual Property Law* (September/October 2015), p. 22 (noting that "although IPRs were intended to serve as an alternative to litigation, accused infringers have used IPRs *in addition to* traditional litigation to overwhelm patent owners").

159. Lee, 2012. In 2007, the Supreme Court ruled that patent licensees can challenge the validity of a licensed patent at any time, even if their contractual agreement with the patentee purports to prohibit such a challenge. See MedImmune v. Genentech, 549 U.S. 118 (2007).

160. See Valdivia, 2015 (noting that "when university associations advocate for stronger patent protection, they do the majority of universities a disservice").

161. Ryan Davis, "Trolls File the Majority of Patent Litigation, Study Finds," *Law360*, April 9, 2013, www.law360.com/articles/431322/trolls-file-the-majority-of-patent-litigation-study-finds/.

162. James E. Bessen, Michael J. Meurer, & Jennifer Ford, "The Private and Social Costs of Patent Trolls," 34(4) *Regulation* 26 (2011).

163. Andrew Ramonas, "University Lobby Push: Higher Ed Asserts Voice in Patent Reform Effort," *National Law Journal*, April 7, 2014.

164. Timothy B. Lee, "Patent Trolls Have a Surprising Ally: Universities," *Washington Post*, November 30, 2013, https://www.washingtonpost.com/blogs/the-switch/wp/2013/11/30/patent-trolls-have-a-surprising-ally-universities/.

165. Higher education did receive some small concessions from industry as part of its support for the AIA. For example, under the AIA, universities can receive a 75% reduction in the governmental fees required of patent applicants. See Dennis Crouch, "Micro Entity Status: Who Is Filing for Micro Entity Status?," *PatentlyO*, February 13, 2014, http://patentlyo.com/patent/2014/02/entity-status-filing.html. But even this perk may redound to industry's benefit: university patents could be cheaper for industry to license than ever before, as fee reimbursements will be less. In short, industry will receive stronger patents from higher education for *less* money, not more. University patents may also be stronger because of the inability of alleged infringers to mount a defense known as "prior user rights" when the asserted patent is for an invention that "was made, owned, or subject to an obligation of assignment to either an institution of higher education . . . or a technology transfer organization" at the time it was made. See 35 U.S.C. § 273(e)(5)(A).

166. See Colleen Chien, "Why It's Time to Open Up Our Patent System," *Washington Post*, June 30, 2015 (arguing that "we should make it easier to waive and dedicate patent rights to the public and engage in technology transactions"), www.washingtonpost.com/blogs/innovations/wp/2015/06/30/why-its-time-to-open-up-our-patent-system/.

167. Morris Fishbein, "The Insulin Monopoly," 117(2) *JAMA: Journal of the American Medical Association* 112 (July 12, 1941).

Chapter 5. Copyright on Campus

1. Yann Ranaivo, "Virginia Tech Student Entrepreneurialism Is Encouraged, but Comes with Some Caveats," *Roanoke (VA) Times*, May 9, 2015, www.roanoke.com/business/news/blacksburg/virginia-tech-student-entrepreneurism-is-encouraged-but-comes-with-some/article_cc7c0750-314f-50fc-8823-55da97e3d42a.html.

2. Ibid.

3. Yann Ranaivo, "Virginia Tech Revamps Policy on Students' Inventions," *Roanoke (VA) Times*, June 10, 2015, www.roanoke.com/news/education/higher_education/virginia_tech/virginia-tech-revamps-policy-on-students-inventions/article_8ef5d30e-dec2-5d64-8f34-1603221ff455.html.

4. Ibid.

5. Bryce C. Pilz, "Student Intellectual Property Issues on the Entrepreneurial Campus," 2 *Michigan Journal of Private Equity & Venture Capital Law* 1 (2012), p. 5.

6. Ibid., pp. 5–8.

7. Anthony J. Luppino, "Fixing a Hole: Eliminating Ownership Uncertainties to Facilitate University-Generated Innovation," 78 *UMKC [University of Missouri–Kansas City] Law Review* 367 (2009), p. 369

8. David Weldon, "Xavier U to Launch 3D Printing as a Service," *Campus Technology*, August 6, 2015, http://campustechnology.com/articles/2015/08/06/xavier-u-to-launch-3d-printing-as-a-service.aspx; Dian Schaffhauser, "Rochester Institute of Tech to House 3D Printing R&D Center," *Campus Technology*, September 9, 2015, http://campustechnology.com/articles/2015/09/02/rochester-institute-of-tech-to-house-3d-printing-rd-center.aspx; Leila Meyer, "Montclair State U Opens New 3D Printing Lab," *Campus Technology*, February 22, 2016, https://campustechnology.com/articles/2016/02/22/montclair-state-u-opens-new-3d-printing-lab.aspx; Abigail Barrow, La Royce Batchelor, Alex Breger, Nathalie Duval-Couetil, Latanya Scott, Jeffrey Skinner, Phyl Speser, & Phil Weilerstein, *Managing Student Intellectual Property Issues at Institutions of Higher Education: An AUTM Primer*, in 2 *AUTM Technology Transfer Practice Manual* (August 2014), p. 11.

9. Michael Hart, "Sierra College Maker Space Fosters Student Innovation," *Campus Technology*, August 27, 2015, http://campustechnology.com/articles/2015/08/27/sierra-college-maker-space-fosters-student-innovation.aspx.

10. "US College Says 3D Michelangelo Replica Infringes Its Copyright," *WIPR: World Intellectual Property Review* 10 (January/February 2015).

11. A public domain does exist, even if some institutions of higher education seem unconvinced of this. Fisher's attorney argued that Augustana College's action undermined its stated mission to "enrich . . . lives by exposure to enduring forms of aesthetic and creative expressions." See Michael Weinberg, "3D Scanned Statute Copyright Debacle: How a University Got It Wrong," *Make: We Are All Makers*, January 23, 2015, http://makezine.com/2015/01/23/3d-scanned-statue-copyright-debacle-how-a-university-got-it-wrong/.

12. TyAnna K. Herrington, *Intellectual Property on Campus: Students' Rights and Responsibilities* (2010), p. 4 (noting that students' "facility with technology often leads them to create marketable work products based in new technologies and then to pursue entrepreneurial efforts to promote them. When students' work has the potential to be valuable, representatives of their educational institutions may claim interest in student products created within the educational setting").

13. Bill Gates and Paul Allen were both able to make nearly unfettered use of special computers at the University of Washington, even when Gates was still in high school. Gates told Malcolm Gladwell that he has been so generous in his donations to the university because of that use. See Gladwell, *Outliers: The Story of Success* (2011), p. 53.

14. These topics are important, but they do not typically pit institutional copyright interests against those of their faculty and students. Instead, fair use in higher education is largely a story of the copyright interests of the content owners (mostly publishers) versus the academic freedom of faculty. My article, "Copyright in Higher Education: A Review of Modern Scholarship," 54(1) *Duquesne Law Review* 197 (2016), discusses the fair-use issue in more detail.

15. What this chapter lacks, unlike others in the book, is data concerning the extent of higher education's assertion of copyright ownership. Unfortunately, while the copyright office maintains online records of copyright registrations since 1978, these records contain many inconsistencies, particularly in the early years, and conducting comprehensive searches is particularly difficult and time consuming.

16. Christopher Jon Sprigman, "Reform(aliz)ing Copyright," 57 *Stanford Law Review* 485 (2004).

17. Williams v. Weisser, 273 Cal. App. 2d 726 (Cal. 1969).

18. Academic commentators in this camp include Todd F. Simon, "Faculty Writings: Are They 'Works Made for Hire' under the 1976 Copyright Act?," 9 *Journal of College & University Law* 485 (1982–1983); Leonard D. DeBoff, "An Academic's Copyright: Publish and Perish," 32 *Journal of the Copyright Society of the U.S.A.* 17 (1984); Rochelle Cooper Dreyfuss, "The Creative Employee and the Copyright Act of 1976," 54 *University of Chicago Law Review* 590 (1987).

19. Academic commentators in this camp include Russ VerSteeg, "Copyright and the Educational Process: The Right of Teacher Inception," 75 *Iowa Law Review* 381 (1990); Laura G. Lape, "Ownership of Copyrightable Works of University Professors: The Interplay between the Copyright Act and University Copyright Policies," 37 *Villanova Law Review* 223 (1992); Robert A. Gorman, "Copyright Conflicts on the University Campus," 47 *Journal of the Copyright Society of the U.S.A.* 291 (2000).

20. Kenneth D. Crews, "Instructional Materials and 'Works Made for Hire' at Universities: Policies and Strategic Management of Copyright Ownership," in *The Center for Intellectual Property Handbook* (Kimberly M. Bonner and staff of the Center for Intellectual Property eds., 2006). Crews, arguably the leading scholar regarding copyright in higher education, wrote that the teacher's exception "is simply too elusive for educators and universities to rely upon" (p. 19).

21. Kenneth D. Crews, *Copyright, Fair Use, and the Challenge for Universities* (1993).

22. 17 U.S.C. § 204(a) (stating that "a transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent").

23. Luppino, 2009; Alan Prendergast, "Caleb Carr Has a Better Idea for Student Inventors' Intellectual Property Rights," *Westword* (Denver, CO), February 23, 2016, http://www.westword.com/news/caleb-carr-has-a-better-idea-for-student-inventors-intellectual-property-rights-7633073.

24. Herrington, 2010. She discusses all of these possibilities and notes that "difficulty arises with student employment because the lines between students' roles as students, employees, and individual workers become blurred in academic settings, where students are sometimes 'customers' who pay universities for learning opportunities and sometimes employees who provide services. And when learning and working processes conflate, it can be difficult to determine which aspect of the students' work was created as part of the learning process and which was created to fulfill job requirements" (p. 41).

25. National Council of Teachers Quality, Inc., v. Curators of the University of Missouri, 446 S.W.3d 723 (Mo. App. W.D. 2014).

26. Luppino, 2009, pp. 388–389. The problem is one of a lack of consideration and a failure of mutual assent, although case law generally supports the enforceability of these policies.

27. Tushar Rae, "iPhone App Raises Questions about Who Owns Student Inventions," *Chronicle of Higher Education: Wired Campus*, January 31, 2011, http://chronicle.com/blogs/wiredcampus/iphone-app-raises-questions-about-who-owns-student-inventions/29265/.

28. Alan Scher Zagier, "Student Inventors Seek Rule Change: Greater Financial Stake in College-Born Inventions Creates Drive for Students to Keep Rights in Work," *Charleston (WV) Daily Mail*, January 25, 2011, p. 9B.

29. The policy now specifies that students own rights to any intellectual property they generate from a school-sponsored contest, extracurricular activity, or individual initiative, but the university can assert an ownership right in intellectual property a student develops under a professor's supervision, using substantial institutional resources or grant money.

30. Bobby Blanchard, "UT Encourages Entrepreneurship While Addressing Hazy Intellectual Property Policy," *[University of Texas at Austin] Daily Texan*, March 3, 2014, www.dailytexanonline.com/news/2014/03/03/ut-encourages-entrepreneurship-while-addressing-hazy-intellectual-property-policy. The article noted that "many student business owners echoed concerns about whether the University owns a student's intellectual property,

which would grant the University access to a share of the student's profits. Students say the System's policy is not clear on the question of ownership."

31. Ibid.

32. Ibid.

33. University of Texas System, *Task Force on Intellectual Property: Disposition, Practices, and Mechanisms of Implementation*, report, August 7, 2014. Fortunately, the task force came to recognize that "the Board of Regents' *Rules and Regulations* concerning IP created by students are confusing as to whether students actually own the IP they create" (p. 10). The task force recommended new policy language that states students "own the IP they create in courses and extracurricular activities. This clear statement would address circumstances where the students are using resources and facilities of U.T. System institutions commonly provided for the student's use for which they have paid tuition and fees" (pp. 10–11). The Board of Regents apparently implemented the task force's recommendation concerning student intellectual property in August 2015.

34. Derek Quizon, "More IP Rights for Students Sought," *Daily Progress* (Charlottesville, VA), August 12, 2015, www.dailyprogress.com/news/more-ip-rights-for-students-sought/article_2b68d2c0-3e22-11e5-aa55-0b3612b48595.html. See also Students for Intellectual Property, http://studentsforiprights.com; Prendergast, 2016.

35. Shawn Drury, "One Student's Fight to Reclaim IP Revenues for Undergrads' Startups," *FastCompany*, January 22, 2015 (describing students' attempt to achieve clarity, through proposed legislation, as to when the use of university equipment leads to institutional ownership of the resulting intellectual property, and proposing a 75/25 revenue split in favor of students in such situations), www.fastcompany.com/3038461/one-students-fight-to-reclaim-ip-revenues-for-undergrads-startups.

36. Quizon, 2015.

37. Claire Martin, "Learning to Engineer a Better Brisket," *New York Times*, July 18, 2015, www.nytimes.com/2015/07/19/business/learning-to-engineer-a-better-brisket.html.

38. Quizon, 2015 (noting that "like unpaid internships, these projects typically motivate students with the promise of experience and the prospect of being discovered").

39. Pilz, 2012, p. 38.

40. Quizon, 2015.

41. "Student IP," Office of the Vice President for Research at Penn State, www.research.psu.edu/patents/policies/student-ip (emphases added).

42. Mariel Frank, "Q&A: How the University of Washington Is Aiming to Unleash a New Wave of Innovation," *GeekWire*, August 4, 2015, www.geekwire.com/2015/190949/.

43. Pilz, 2012, p. 41.

44. These perks may include lucrative consulting arrangements, board appointments, or other actual or promised benefits that risk clouding the faculty member's judgment about what occurs in the classroom.

45. Authors Guild, Inc., v. HathiTrust, 755 F.3d 87 (2nd Cir. 2014) (upholding as fair use the digital scanning of books from the collections of a consortium of leading university libraries); Authors Guild, Inc., v. Google, Inc., 954 F.Supp.2d 282 (S.D.N.Y. 2013) (upholding as fair use Google's digital scanning of books).

46. Brief of Digital Humanities and Law Scholars as *Amici Curiae* [Friends of the Court] in Support of Defendant-Appellees, Authors Guild, Inc. v. Google, Inc., Civ. No. 13-4829, Doc. No. 149, July 10, 2014, pp. 13–14.

47. Ibid., p. 17.

48. Michael Roy, "Either/Or? Both/And? Difficult Distinctions within the Digital Humanities," *EDUCAUSE Review* 16 (May/June 2014). Digital-humanities projects may also go by the names "digital scholarship" and "digital liberal arts." Donald J. Waters identifies the defining feature of digital humanities as "the application of digital resources and methods to humanistic inquiry." See Waters, "An Overview of the Digital Humanities," 284 *Research Library Issues: A Quarterly Report from ARL, CNI, and SPARC* 3 (2013).

49. "Mellon Foundation Grants Washington and Lee Funds for Digital Humanities, Study of History," *Augusta (VA) Free Press*, July 13, 2015, http://augustafreepress.com/mellon-foundation-grants-washington-and-lee-funds-for-digital-humanities-study-of-histor/.

50. Nancy L. Maron, "The Digital Humanities Are Alive and Well and Blooming: Now What?," *EDUCAUSE Review* 28 (September/October 2015).

51. See The Ancient Graffiti Project, http://ancientgraffiti.wlu.edu.

52. Eunice Brumskine, "Classics Students Present Research on Summer Visit to Italy," *[University of Richmond] Collegian*, November 16, 2014, www.thecollegianur.com/article/2014/11/students-present-summer-rome-research/.

53. Jennifer Howard, "Born Digital, Projects Need Attention to Survive," *Chronicle of Higher Education*, January 6, 2014, http://chronicle.com/article/Born-Digital-Projects-Need/143799/.

54. See "The Valley of the Shadow: Two Communities in the American Civil War," http://valley.lib.virginia.edu.

55. See Texas Slavery Project, www.texasslaveryproject.org; The Collected Papers of Albert Einstein, http://einsteinpapers.press.princeton.edu; The Walt Whitman Archive, www.whitmanarchive.org; College Women: Documenting the History of Women in Higher Education, www.collegewomen.org.

56. See Mapping Decline: St. Louis and the American City, http://mappingdecline.lib.uiowa.edu (mapping over 50 years of demographic trends in St. Louis).

57. Sponsorship of a project by an institution of higher education typically entails devoting staff and physical resources (such as software and hardware) toward maintaining the project.

58. Julianne Nyhan & Oliver Duke-Williams, "Is Digital Humanities a Collaborative Discipline? Joint Authorship Publication Patterns Clash with Defining Narrative," London School of Economics and Political Science: The Impact Blog, September 10, 2014, http://blogs.lse.ac.uk/impactofsocialsciences/2014/09/10/joint-authorship-digital-humanities-collaboration/.

59. "Examples of Collaborative Digital Humanities Projects," *Digital Scholarship in the Humanities*, June 1, 2009, https://digitalscholarship.wordpress.com/2009/06/01/examples-of-collaborative-digital-humanities-projects/.

60. Maron, 2015, p. 34.

61. Roy, 2014, p. 19.

62. Elijah Meeks, "How Collaboration Works and How It Can Fail," Stanford University Libraries: Digital Humanities Specialist, May 27, 2013, https://dhs.stanford.edu/natural-law/how-collaboration-works-and-how-it-can-fail/.

63. Spencer D. C. Keralis, essay in *Disrupting the Digital Humanities* (Dorothy Kim and Jesse Stommel eds., forthcoming).

64. See Infinite Ulysses, www.infiniteulysses.com.

65. Amanda Visconti, "Copyleft, IP Rights, and Digital Humanities Dissertations," *Literature Geek*, December 9, 2013, http://literaturegeek.com/2013/12/09/dhiprights/.

66. Roy, 2014, p. 20.

67. Lisa R. Carter, "Special at the Core: Aligning, Integrating, and Mainstreaming Special Collections in the Research Library," 283 *Research Library Issues: A Quarterly Report from ARL, CNI, and SPARC* 1 (2013).

68. "Special Issue on Special Collections and Archives in the Digital Age," 279 *Research Library Issues: A Quarterly Report from ARL, CNI, and SPARC* 1 (June 2012).

69. Laura N. Gasaway, "Copyright Ownership and the Impact on Academic Libraries," 13 *DePaul Journal of Art, Technology & Intellectual Property Law* 277 (2003), pp. 290–293 (discussing all these issues).

70. Sheila O'Hare & Andrew Smith, "Gifts Nobody Wants: The State of the Art in Dealing with Unwanted Donations," 1(1) *Kansas Library Association of College & University Libraries Section Proceedings* Article 10 (2011), p. 67.

71. Ibid., pp. 68–69; Gasaway, 2003, p. 293.

72. O'Hare & Smith, 2011, p. 73.

73. Patricia Cohen, "Museums Grapple with the Strings Attached to Gifts," *New York Times*, February 4, 2013, www.nytimes.com/2013/02/05/arts/design/museums-grapple-with-onerous-restrictions-on-donations.html.

74. Peter B. Hirtle, Anne R. Kenney, & Judy Ruttenberg, "Digitization of Special Collections and Archives: Legal and Contractual Issues," 279 *Research Library Issues: A Quarterly Report from ARL, CNI, and SPARC* 2 (June 2012).

75. 17 U.S.C. § 202 (stating that the "transfer of ownership of any material object . . . does not itself convey any rights in the copyrighted work embodied in the object"); 17 U.S.C. § 204(a) (noting that "a transfer of copyright ownership . . . is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent"). Were the law otherwise, purchasing a book would make the purchaser the owner of the copyright for the material contained in the book.

76. Kevin L. Smith, "Copyright Risk Managements: Principles and Strategies for Large-Scale Digitization Projects in Special Collections," 279 *Research Library Issues: A Quarterly Report from ARL, CNI, and SPARC* 17 (June 2012).

77. Gasaway, 2003, p. 296.

78. Alana Goodman, "Unconditional Surrender," *Washington (DC) Free Beacon*, August 4, 2014, http://freebeacon.com/issues/unconditional-surrender/.

79. The interview in question involved Hillary Clinton's first-person account of her role as a defense attorney representing an alleged child rapist in 1975.

80. Joe Amarante, "Yale Project Preserving Benny Goodman Film and Audio," *New Haven (CT) Register*, July 15, 2015, www.nhregister.com/arts-and-entertainment/20150715/yale-project-preserving-benny-goodman-film-and-audio/.

81. For example, the University of Texas at Austin canceled a plan to borrow, catalog, and digitize a massive archive of Olympic records after it grew concerned about copyright restrictions. See "University of Texas Settles Olympic Lawsuits," *Washington (DC) Times*, September 3, 2014, www.washingtontimes.com/news/2014/sep/3/university-of-texas-settles-olympics-lawsuits/.

82. Amarante, 2015.

83. 17 U.S.C. § 302. For works created by individuals after January 1, 1978, copyright protection lasts for the lifetime of the author plus seventy years after

the author's death. For published works of corporate authorship, the duration of copyright is 95 years from the date of publication, or 120 years from the date of creation, whichever occurs first.

84. Michael J. Madison, Brett M. Frischmann, & Katherine J. Strandburg, "The University as Constructed Cultural Commons," 30 *Washington University Journal of Law & Policy* 365 (2009), p. 379 (describing the university knowledge commons as one "of enormous dynamism," for reasons such as these). These authors have also edited an excellent book on knowledge commons, *Governing Knowledge Commons* (Frischmann, Madison, & Strandburg eds., 2014).

Chapter 6. In Pursuit of Brand

1. Baylor University v. JS, NAF Claim No. FA0801001141911 (March 14, 2008) (Grossman, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/1141911.htm.

2. John Stipe, telephone interview with the author, June 17, 2014, transcription on file with author.

3. Baylor University v. JS, NAF Claim No. FA0801001141911.

4. Stipe, interview.

5. "The Bear Truth," www.baylorbearssuck.us [last visited March 6, 2015; as of February 2016, the domain name no longer displayed any content upon a visit].

6. This question is more rhetorical than actual. In 2014, Baylor University sued the Baylor Alumni Association, seeking to stop it from using the Baylor name and trademarks after the formal relationship between the two broke down. See "Baylor U. Sues to Stop Alumni Group From Using Its Marks," *Inside Higher Ed*, June 11, 2014, www.insidehighered.com/quicktakes/2014/06/11/baylor-u-sues-stop-alumni-group-using-its-marks/. This lawsuit, and the UDRP action against John Stipe, suggest that the possibility of making headlines for suing its alumni may not be much of a deterrent for Baylor as it considers trademark-enforcement options.

7. The dispute did make local headlines as it unfolded in 2008. See Travis Measley, "Revenge.com: Baylor Files Lawsuit over Trademark Abuse in Websites Using Name, Mascot," *[Texas A&M University] Battalion Online*, February 27, 2008.

8. Stipe, interview.

9. Knowledge of these past efforts in the collective also might provide a handy roadmap for anyone looking to cause Baylor to incur more legal fees: simply register a domain name incorporating the university's name, then wait for the UDRP action to be filed.

10. Stipe, interview.

11. The four other domain names included in the UDRP action were BAYLORBEARS.BIZ, BAYLORBEARS.NAME, BAYLORBEARS.NET, and BAYLORBEARS.TV.

12. Portions of this section involving background information on brands are adopted from Jacob H. Rooksby and Chris Collins, "Trademark Trends and Brand Activity in Higher Education," *Review of Higher Education* (forthcoming). My thanks to Chris for expanding my thinking on this topic.

13. Any recognition of the role of trademarks in furthering or reflecting institutional brand efforts is mostly absent from previous discussions of brands in higher education. The prescient work of Sheila Slaughter and Gary Rhoades, in *Academic Capitalism and the New Economy: Markets, State, and Higher Education* (2004), addressed the interplay between brands and trademarks, but their focus was on the formidable alliances between universities and athletic companies like Nike and Adidas, and on how these relationships undermine students' independence from commercial interference. As they put it, "The students have dual institutional identities as educated persons and as loyal consumers of an increasing variety of intellectual property" (p. 277). Their emphasis was less on the institution as a brand and more on the dynamics of how institutions have brought commercial brands into higher education as part of the growing coziness between universities and corporations.

14. Deven R. Desai, "From Trademarks to Brands," 64 *Florida State Law Review* 981 (2012), p. 988.

15. Daniel Khaneman & Amos Tversky eds., *Choices, Values, and Frames* (2000).

16. David A. Aaker, *Managing Brand Equity: Capitalizing on the Value of a Brand Name* (1991).

17. Kevin Lane Keller, *Strategic Brand Management: Building, Measuring, and Managing Brand Equity* (2012).

18. Chris A. Myers, "Managing Brand Equity: A Look at the Impact of Attributes," 12(1) *Journal of Product & Brand Management* 29 (2003).

19. David A. Aaker & Erich Joachimsthaler, *Brand Leadership: Building Assets in an Information Economy* (2000); Keller, 2012.

20. J. Douglas Toma, Greg Dubrow, & Matthew Hartley, *The Uses of Institutional Culture: Strengthening Identification and Building Brand Equity in Higher Education* (2005).

21. Jay Blanton, "Engagement as a Brand Position in the Higher Education Marketplace," 7(2) *International Journal of Educational Advancement* 143 (2007); Rex Whisman, "Internal Branding: A University's Most Valuable Asset," 18(5) *Journal of Product & Brand Management* 367 (2009); Musa Pinar, Paul Trapp, Tulay Girard, & Thomas E. Boyt, "Utilizing the Brand Ecosystem

Framework in Designing Branding Strategies for Higher Education," 25(7) *International Journal of Educational Management* 724 (2011).

22. J. Harry McAlexander & Harold F. Koenig, "Contextual Influences: Building Brand Community in Large and Small Colleges," 20(1) *Journal of Marketing for Higher Education* 69 (2010).

23. Slaughter & Rhoades, 2004, p. 23.

24. Gary W. Matkin, *Technology Transfer and the University* (1990).

25. David C. Mowery, Richard R. Nelson, Bhaven N. Sampat, & Arvids A. Ziedonis, *Ivory Tower and Industrial Innovation: University-Industry Technology Transfer before and after the Bayh-Dole Act* (2004).

26. Holden Thorp & Buck Goldstein, *Engines of Innovation: The Entrepreneurial University in the Twenty-First Century* (2010).

27. Goldie Blumenstyk, "Penn State's Patent Auction Produces More Lessons Than Revenue," May 1, 2014, http://chronicle.com/blogs/bottomline/penn-states-patent-auction-produces-more-lessons-than-revenue/.

28. "UNHInnovation Launches New Website to Centralize Commercialization of UNH Assets," press release, University of New Hampshire, May 15, 2014, www.unh.edu/news/releases/2014/05/cd15innovation.cfm.

29. H. Brevy Cannon, "U.Va. Innovation among Nation's Best as Crowell Departs," May 1, 2014, University of Virginia: U.Va. Today, http://news.virginia.edu/content/uva-innovation-among-nation-s-best-crowell-departs/.

30. Jeffrey R. Young, "Commerce Department Hands Over '.edu' Domain to Educause," *Chronicle of Higher Education*, November 9, 2001, http://chronicle.com/article/Commerce-Department-Hands-Over/20208/.

31. Ibid.

32. Ibid.

33. In 2012, however, EDUCAUSE's policy board endorsed a proposal that would permit eligible institutions that do not currently have more than one .EDU domain name to register a second domain name, provided it is "associated with the entire entity and not just a subunit" (for example, a department or a school within a university). See "Policy Recommendations for the Domain," memorandum from Gregory A. Jackson, Vice President, to Policy Board for .edu 1, August 17, 2012, EDUCAUSE, http://net.educause.edu/edudomain/policy_board_9_26_2012.pdf.

34. "Policy Information," EDUCAUSE: .edu Administration, http://net.educause.edu/edudomain/policy.asp.

35. Dan Carnevale, "Don't Judge a College by Its Internet Address," *Chronicle of Higher Education*, November 26, 2004, http://chronicle.com/article/Dont-Judge-a-College-by-Its/8748/.

36. "Universities Offer Graduates an E-Mail Place to Call Home," *Milwaukee Journal Sentinel*, May 8, 2001, p. 02M.

37. Ibid.

38. "University Email Accounts for Sale in China," *Inside Higher Ed*, September 9, 2014, https://www.insidehighered.com/quicktakes/2014/09/09/university-email-accounts-sale-china/.

39. Josh Fischman, "Trading In '.edu' for '.com,'" *Chronicle of Higher Education: Wired Campus*, September 2, 2011, http://chronicle.com/blogs/wiredcampus/trading-in-edu-for-com/33033/.

40. Ibid. (noting Weber State University's use of GETINTOWEBER.COM for recruitment and admissions purposes).

41. Scott Bearby & Bruce Siegal, "From the Stadium Parking Lot to the Information Superhighway: How to Protect Your Trademarks from Infringement," 28 *Journal of College & University Law* 633 (2002), pp. 653–654.

42. Jacqueline D. Lipton, "Beyond Cybersquatting: Taking Domain Name Disputes Past Trademark Policy," 40 *Wake Forest Law Review* 1361 (2005), pp. 1363–1364 (arguing that "while ACPA [the Anti-Cybersquatting Consumer Protection Act] and the UDRP are extremely useful and effective in protecting trademark interests in the bad faith cybersquatting context, they are very limited in their ability to deal with disputes between two legitimate holders of similar trademarks with respect to a corresponding Internet domain name"); Milton L. Mueller, *Ruling the Root: Internet Governance and the Taming of Cyberspace* (2002), p. 67 (stating that "the application of trademark law, which was national in scope and industry- and use-specific to domain names, which were global in scope and were governed primarily by a uniqueness requirement, created as many conflicts as it resolved").

43. Federal-court litigation over domain names may include traditional claims of trademark infringement and trademark dilution, and/or additional claims for cybersquatting, which is a distinct cause for action that Congress created in the late 1990s, with passage of the Anticybersquatting Consumer Protection Act.

44. Jay P. Kesan & Andres A. Gallo, "The Market for Private Dispute Resolution Services—an Empirical Re-Assessment of ICANN-UDRP Performance," 11 *Michigan Telecommunications & Technology Law Review* 285 (2005), pp. 298–299. Five ICANN-approved providers existed in 2015. The first two providers, authorized in December 1999, were the World Intellectual Property Organization and the National Arbitration Forum. Two more providers, eResolution and the CPR Institute for Dispute Resolution, were added in 2000, but each of these subsequently lost its approval. In 2002, ICANN authorized a new provider, Asian Domain Name Dispute Resolution Centre. By 2015, additional providers included the Czech Arbitration Court

Arbitration Center for Internet Disputes (2009) and the Arab Center for Domain Name Dispute Resolution (2013). See "List of Approved Dispute Resolution Providers," ICANN, https://www.icann.org/resources/pages/providers-6d-2012-02-25-en.

45. Kesan & Gallo, 2005, p. 303.

46. Ibid. The single-person arbitrator is selected at random by the provider, while three-person panels are selected with input from the complainant, the respondent, and the provider.

47. "Uniform Domain-Name Dispute-Resolution Policy" [hereinafter "UDRP Policy"], ICANN, § 4(a), https://www.icann.org/resources/pages/policy-2012-02-25-en.

48. Ibid., § 4(b).

49. A. Michael Froomkin, "ICANN's 'Uniform Dispute-Resolution Policy'—Causes and (Partial) Cures," 67 *Brooklyn Law Review* 605 (2002), p. 612 (noting that ICANN's "power to make and break registries allows ICANN to require registries (and also registrars) to promise to subject all registrants to a mandatory third-party beneficiary clause in which every registrant agrees to submit to ICANN's UDRP upon the request of aggrieved third parties who believe they have a superior claim to the registrant's domain name").

50. Mueller, 2002, p. 192.

51. "UDRP Policy," § 4(k). The ten-day period gives a losing respondent an opportunity to file a lawsuit in court. If this occurs, the registry will not act on the panel's decision, pending the resolution of the court case. The UDRP, as a form of alternative dispute resolution, fills a void created by the inadequacy of courts to predictably handle disputes over domain-name ownership. Contesting parties often are not within the same geographic area over which a particular court's legal authority extends, which means that the enforcement of court verdicts can pose difficulties. Furthermore, the expense and slow speed of litigation makes it an unattractive dispute-resolution vehicle for many parties wishing to resolve Internet domain-name conflicts cheaply and quickly. In contrast to litigation, UDRP proceedings do not involve discovery (a pre-trial procedure where one side in a lawsuit can obtain relevant information and documents from the opposing side) or in-person hearings, and no monetary damages are available for complainants if decisions are in their favor. A decision is rendered within sixty days of filing. According to a 2012 survey conducted by the American Intellectual Property Law Association (AIPLA), a client's mean cost to have a lawyer prepare a UDRP complaint is $1,876 in legal fees, although that cost can be as high as $5,000 for some firms and in some markets. Others choose to proceed without the aid of an attorney, which the UDRP rules permit. The UDRP's chief selling points,

therefore, are that it is an international, nongovernmental, relatively inexpensive, fast, and essentially online-only dispute-resolution vehicle. That said, you can seek remedy through the UDRP while simultaneously pursuing federal-court litigation; the two avenues are not mutually exclusive.

52. Scott Jashik, "Names, Symbols, and Race," *Inside Higher Ed*, August 4, 2014, www.insidehighered.com/news/2014/08/04/u-mississippi-tries-new-approach-its-history-race-and-faces-criticism/.

53. See Western Washington University v. aak / Azra Ari Khan, WIPO Case No. D2004-0049 (April 5, 2004) (Barker, Arb.), WIPO Arbitration and Mediation Center Administrative Panel Decision, www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0049.html; American University v. Nente.com, NAF Claim No. FA0409000323761 (October 15, 2004) (Yachnin, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/323761.htm; Loma Linda University Adventist Science Center, et al. v. JM XTrade, Inc., Joseph Martinez, WIPO Case No. D2009-0036 (March 11, 2009) (Page, Arb.), WIPO Arbitration and Mediation Center Administrative Panel Decision, www.wipo.int/amc/en/domains/decisions/html/2009/d2009-0036.html.

54. See Amy Gajda, *The Trials of Academe: The New Era of Campus Litigation* (2009), p. 115 (noting that "universities seek legal protection not only for marketable inventions, but also for their marketable identity, with increasing attention paid to 'branding' and cyber rights").

55. See Baylor University v. Above.com Domain Privacy, NAF Claim No. FA1306001504429 (August 1, 2013) (Wilson, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/1504429.htm.

56. See Mesa State College v. Don't Panic Business Technologies, NAF Claim No. FA1106001393045 (August 8, 2011) (Foster, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/1393045.htm; Indiana University v. Linh Wang, NAF Claim No. FA0902001247095 (April 8, 2009) (Crary, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/1247095.htm.

57. Samantha King & Sheila Slaughter, "Sports 'R' Us: Contracts, Trademarks, and Logos," in Slaughter & Rhoades, 2004, p. 272.

58. See Board of Regents, University of Texas System v. Domain Admin c/o University of Texas, NAF Claim No. FA0806001208350 (July 31, 2008) (Condon, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/1208350.htm.

59. See West Virginia University Board of Governors for and on behalf of West Virginia University v. WV Sports Report, WIPO Case No. D2011-2154 (January 15, 2012) (Hill, Arb.), WIPO Arbitration and Mediation Center

Administrative Panel Decision, www.wipo.int/amc/en/domains/search/text.jsp?case=D2011-2154/.

60. See Baylor University v. Earth Yellow Pages, NAF Claim No. FA0907001274424 (August 31, 2009) (Yachnin, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/1274424.htm (concerning BAYLORYELLOWPAGES.COM); Baylor University v. Domains by Proxy, Inc., a/k/a Mark Felton a/k/a Thomas Bassett a/k/a William Bunn a/k/a Fertility Specialists of Dallas a/k/a Becky Chatham a/k/a Amanda Scott a/k/a Nathan Flaga a/k/a Lisa Payne a/k/a Victor Weir III, NAF Claim No. FA0802001145651 (May 26, 2008) (Limbury, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/1145651.htm (concerning BAYLORSALSA.COM and BAYLORFLORIST.COM, among other domain names); Baylor University v. Domain Park Ltd., Samoa, NAF Claim No. FA0802001142634 (March 25, 2008) (Carmody, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/1142634.htm (concerning BAYLORBANKS.COM, among other domain names); Baylor University v. Baylor University c/o Bob Hartland, NAF Claim No. FA0611000841917 (January 2, 2007) (Carmody, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/841917.htm (concerning BAYLORSTORE.COM, among other domain names).

61. See Jule Collins Smith Museum of Fine Art at Auburn University v. Khan, Zafar, NAF Claim No. FA1205001445535 (June 23, 2012) (Carmody, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/1445535.htm.

62. Red Butte Garden is the name of a botanical garden and arboretum operated by the University of Utah. KUHF are the call letters of a radio station affiliated with the University of Houston.

63. The most likely answer to this question seems to be "perhaps." Auburn University's library purchased three top-level domain names in the early 2000s, because it wanted "memorable and advertising-savvy URL[s]" to use for promotional purposes. See Robert H. McDonald, "Why Your Library Needs a .org, .com, and .net!," *Computers in Libraries*, September 1, 2001, p. 36. As of July 2015, of the three domain names the library purchased and once used (AULIBRARY.ORG, AULIBRARY.COM, and AULIBRARY.NET), one was available for registration and the two others appeared to be owned by an entity other than Auburn University.

64. As of July 2015, MY-TORERORESTORE.COM was available to register, and THETORERORESTORE.COM failed to display a webpage, not even five years after the UDRP decision awarding the transfer of those domain names to the university. See University of San Diego v. Hot Nix Webs, NAF Claim No.

FA1010001355316 (December 9, 2010) (Upchurch, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/1355316.htm.

65. See University of Houston System v. Salvia Corporation, NAF Claim No. FA0602000637920 (March 21, 2006) (Franklin, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/637920.htm.

66. Ibid., p. 4.

67. Presuming that the Latvian registrant had the University of Houston in mind when registering the offending domain name is dubious, at best. Four-letter domain names are valuable precisely because four letters, not registered as a trademark, can stand for nearly anything in multiple languages (not just English).

68. The university's branding objectives may have changed in 2010, when it acquired another radio station that was formerly operated by students at Rice University. See Karen Everhart, "Adding 2nd Service in Houston, KUHF Buys Rice U. Station," *Current*, August 23, 2010, www.current.org/wp-content/themes/current/archive-site/radio/radio1015houston.shtml. Assuming, for the sake of argument, that this acquisition led the university to back away from touting KUHF as a brand in favor of the umbrella term "Houston Public Media," what is notable is the university's decision to maintain the KUHF.COM registration for years as an essentially unused property.

69. See University of Miami v. Marchex Sales, Inc., NAF Claim No. FA1301001478911 (March 5, 2013) (Triana, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/1478911.htm.

70. See University of Iowa v. Juraj Vyletelka, WIPO Case No. D2002-0349 (May 31, 2002) (Brown, Arb.), WIPO Arbitration and Mediation Center Administrative Panel Decision, www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0349.html.

71. U.S. Trademark Registration No. 2,058,573 (registered May 6, 1997).

72. Others have noted the bias of some UDRP panels toward parties located in Western democracies, due to the abundance of domain-name registries existing and operating in such countries. See, for example, Julia Hörnle, "The Uniform Domain Name Dispute Resolution Procedure: Is Too Much of a Good Thing a Bad Thing?," 11 *SMU [Southern Methodist University] Science & Technology Law Review* 253 (2008), p. 275 (remarking that, "for example, for the .com generic top-level domain, most registrars are based in the U.S., Canada, Western Europe, some Asian countries, . . . Australia, and New Zealand. However, a .com domain-name registrant in, for example, Poland or Thailand would have to sign a registration agreement in a foreign language and thus conduct the proceedings in that language, as well as bear the cost of translation").

73. Even then, the registration was only for a design mark, not a word mark.

74. Both of these cases support the contention that academic medicine mostly looks like commercial medicine, with a significant amount of dollars being spent on branding strategies that might be more usefully funneled toward patient care. For an early account of this trend, see Thomas E. Andreoli, "The Undermining of Academic Medicine," *Academe* (November/December 1999), p. 32 (arguing that "academic values are losing out to mercantilism," and that patient care has suffered as a result).

75. Because he redshirted a season, RG3 played his final season at Baylor (in 2011) as a student, pursuing a master's degree in communications.

76. See Baylor University v. Justin Cox, NAF Claim No. FA1311001530937 (December 20, 2013) (Pfeuffer, Arb.), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/1530937.htm.

77. As is typical of UDRP proceedings, a federal trademark registration provides wide latitude to the complainant mark holder in defining the extent of its ownership interest. Accordingly, the panelist seemed not to consider the fact that BU could mean anything, including Boston University, which owns the registration for BU.EDU.

78. See President & Fellows of Harvard College v. A Happy DreamHost Customer / Cary Humphries, WIPO Case No. D2010-2184 (May 23, 2011) (Osborne, Arb.) (concerning HARVARDESSAYS.ORG), WIPO Arbitration and Mediation Center Administrative Panel Decision, www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-2184; Cornell University v. Steven Wells, NAF Claim No. FA0305000158423 (July 9, 2003) (Byrne, Arb.) (concerning CORNELLRENTALS.COM), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/158423.htm; Yale University v. Whois Agent, Whois Privacy Protection Service, Inc. / John Chow, imapa, WIPO Claim No. D2013-0405 (April 25, 2013) (Elliot, Arb.) (concerning YALEPARENTINGCENTER.ORG), WIPO Arbitration and Mediation Center Administrative Panel Decision, www.wipo.int/amc/en/domains/search/text.jsp?case=D2013-0405/; Board of Trustees of the Leland Stanford Junior University v. Computer Product Information, a/k/a Richard Leeds, NAF Claim No. FA0303000146571 (March 28, 2003) (McCotter, Jr., Arb.) (concerning STANFORDEVENTS.COM, among other domain names), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/146571.htm.

79. See, for example, Nicholas Lemann, "The Soul of the Research University," *Chronicle of Higher Education: Chronicle Review*, April 28, 2014, http://chronicle.com/article/The-Soul-of-the-Research/146155/ (stating that "higher education is expected to do so many things—teach everything from

philosophy to prison administration, operate winning sports programs, provide in-person management of the transition from adolescence to adulthood, make local economies prosper, be direct providers of medical care, and on and on").

80. Further examples of this activity include University of Central Florida v. Knight Publishing, Inc., NAF Claim No. FA0505000485962 (July 13, 2005) (Richard, Lowry, Fink, Arbs.) (concerning UCFINDIE.COM, among other domain names), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/485962.htm; Syracuse University v. Red Ant Hosting, NAF Claim No. FA0409000332354 (November 9, 2004) (Yachnin, Arb.) (concerning SUFACEBOOK.COM), National Arbitration Forum Decision, www.adrforum.com/domaindecisions/332354.htm; Board of Regents of the University of Nebraska v. Karolke, WIPO Case No. D2003-0307 (June 18, 2003) (Knopf, Arb.) (concerning HUSKERFEVERCARD.COM), WIPO Arbitration and Mediation Center Administrative Panel Decision, www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0307.html.

81. J. Thomas McCarthy & Paul M. Anderson, "Protection of the Athlete's Identity: The Right of Publicity, Endorsements, and Domain Names," 11 *Marquette Sports Law Review* 195 (2001), p. 198 (noting that "the right of publicity is not a kind of trademark. It is not just a species of copyright. And it is not merely another kind of privacy right. It is none of these things, although it bears some family resemblance to all three. The right of publicity is a wholly different and separate legal right").

82. The initial case, involving New York state law and the use of baseball players' images on baseball trading cards, is Haelan Laboratories, Inc., v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir. 1953).

83. Parks v. LaFace Records, 329 F.3d 437, 445 (6th Cir. 2003).

84. Ibid., p. 453.

85. McCarthy & Anderson, 2001, p. 195.

86. Arnold Palmer, who retired from competitive golf decades ago, last won a tournament in 1973 and earned $1.9 million in career prize money on the PGA Tour, but his endorsement income was over $40 million in 2013. See Kurt Badenhausen, "The Highest-Paid Retired Athletes," *Forbes*, February 27, 2014, www.forbes.com/sites/kurtbadenhausen/2014/02/27/the-highest-paid-retired-athletes/.

87. Marc Edelman, "The Future of Amateurism after Antitrust Scrutiny: Why a Win for the Plaintiffs in the NCAA Student-Athlete Name & Likeness Licensing Litigation Will Not Lead to the Demise of College Sports," 92 *Oregon Law Review* 1019 (2014), p. 1031.

88. Taylor Branch, "The Shame of College Sports," *Atlantic*, October 2011, www.theatlantic.com/magazine/archive/2011/10/the-shame-of-college-sports/308643/.

89. Edelman, 2014, p. 1032.

90. Ibid., p. 1054.

91. Steve S. Chang, "Face Value: Where's My NCAA Football Game?," *Landslide* 8 (March/April 2015), p. 9.

92. Most former players are expected to receive a few hundred dollars as part of the settlement. For more information on the lawsuits and settlements, see "NCAA and EA Videogame Likeness Settlements," www.ncaa-ea-likeness-settlement.com. Meanwhile, the attorneys who were involved in the lawsuits received $46 million out of the $60 million settlement. See Benjamin Horney, "Class Attys Get Over $44M in Fees in NCAA Likeness Deal," *Law360*, July 15, 2015, www.law360.com/ip/articles/678956. Student-athletes initiated an additional right-of-publicity lawsuit in 2014, challenging the uncompensated use of their names, images, and likenesses in television broadcasts of games. In that lawsuit, the court granted the motion to dismiss submitted by the defendants—various networks, athletic conferences, and licensing agencies (the NCAA was not among them)—ruling that the student-athletes had no publicity rights in broadcasts of their performances on fields of play. The plaintiffs have appealed the adverse decision. See Linda Chiem, "Ex-NCAA Athletes Take Publicity Rights Row to 6th Circ.," *Law360*, July 13, 2015, www.law360.com/ip/articles/678557.

93. Melissa Lipman, "NCAA Can Block Cash Payments to Athletes, 9th Circ. Says," *Law360*, September 30, 2015, www.law360.com/ip/articles/677977/.

94. Ibid.

95. Ben Strauss, "N.C.A.A. Appeal of Ruling in O'Bannon Case Is Heard," *New York Times*, March 18, 2015, www.nytimes.com/2015/03/18/sports/ncaa-appeal-of-ruling-in-obannon-case-is-heard.html.

96. Claudine McCarthy, "Colleges Challenge Fan Website," 15(7) *Campus Legal Advisor* 2 (March 2015).

97. John Keilman & Jared S. Hopkins, "College Athletes Routinely Sign Away Rights to Be Paid for Names, Images," *Chicago Tribune*, March 26, 2015, www.chicagotribune.com/sports/college/ct-ncaa-waivers-met-20150326-story.html.

98. University of Pittsburgh v. Champion Products, Inc., 686 F.2d 1040 (3d Cir. 1982).

99. "The Collegiate Licensing Company Names Top Sellers for Fiscal Year 2011–12," *Collegiate Licensing Company*, October 8, 2012, www.clc.com/News/Archived-Rankings/Rankings-Annual2012.aspx [page no longer available]; Suzette M. Thweatt, "Collegiate Licensing at the University of North Carolina: A Historical Review of the Past and Present Role of Licensing at UNC and Recommendations for Future Growth" (2001) (MA thesis, University of North Carolina at Chapel Hill), p. 2.

100. Louis D. Brandeis, "What Publicity Can Do," *Harper's Weekly*, December 20, 1913, p. 10.

101. A growing reliance on trade secrecy to obfuscate business operations that impact the public is by no means limited to higher education. Frank Pasquale has examined how Internet companies that otherwise serve as quasi-public utilities—in particular, Google and Facebook—rely on trade secrecy to create an opaque black box around the algorithms they use to deliver content to users. The same behavior exists in the financial sphere, where companies' algorithms—for example, those used by credit-rating agencies—are often beyond the comprehension of regulators and even industry insiders. See Pasquale, *The Black Box Society: The Secret Algorithms That Control Money and Information* (2015). Sheldon Krimsky has also detailed how corporations have claimed trade secrecy regarding research they pay academic scientists to conduct. See Krimsky, *Science in the Public Interest: Has the Lure of Profits Corrupted Biomedical Research?* (2003), p. 82.

102. Federal patent law is based on the public receiving a benefit—in the form of a description of a new, useful, and nonobvious invention—in exchange for granting limited rights to the applicant. By comparison, the public does not receive any such benefit in exchange for recognizing trade-secret protection under state and federal laws.

103. S.E.T.A. UNC-CH, Inc., v. Huffines, 399 S.E.2d 340, 343 (N.C. App. 1991).

104. Mississippi State University v. People for the Ethical Treatment of Animals, Inc., 992 So.2d 595 (Miss. 2008).

105. Ibid., p. 608.

106. See Pat Shockley, "The Availability of 'Trade Secret' Protection for University Research," 20 *Journal of College & University Law* 309 (1994).

107. S.E.T.A. UNC-CH, Inc., 399 S.E.2d at 342.

108. See Kaitlin Mulhere, "Scrutiny of Scholar's Emails," *Inside Higher Ed*, January 14, 2015, https://www.insidehighered.com/news/2015/01/14/open-records-and-academic-freedom-come-head-kansas/.

109. For a thoughtful discussion of these issues, see Jonathan Peters & Charles N. Davis, "When Open Government and Academic Freedom Collide," 12 *First Amendment Law Review* 295 (2013) (arguing that it would be "conceptually sound" to create an academic-freedom exception to open-records laws, for the purpose of exempting faculty materials from disclosure).

110. See California State University, Fresno Association, Inc., v. Superior Court, 108 Cal. Rptr. 2d 870 (2001).

111. University of Connecticut v. Freedom of Information Commission, 303 Conn. 724 (2012).

112. Ibid.

113. For one example, see State ex rel. Besser v. Ohio State University, 721 N.E.2d 1044 (Ohio 2000) (rejecting the claim that, as a governmental entity, Ohio State University could not have its own trade secrets).

114. Because the court stated that the list of donors to the library did not constitute "customers," it ruled that information about them could not be withheld on the basis of Connecticut's trade-secret exemption.

115. Amazon.com declined to speak with the press about the university's hardball stance on the issue. See Allison Enright, "Amazon's Deal with Purdue University Prompts a Lawsuit," *Internet Retailer*, April 2, 2015, https://www.internetretailer.com/2015/04/02/amazons-deal-purdue-university-prompts-lawsuit/.

116. Ibid.

117. Rick Armon, "University of Akron Refuses to Release Marketing Studies on Rebranding," *Ohio.com [Akron Beacon Journal]*, May 20, 2015, www.ohio.com/news/local/university-of-akron-refuses-to-release-marketing-studies-on-rebranding-1.593568/.

118. Kevin Opsahl, "Update: Maverik, Utah State University Release Contract Detailing Stadium Naming Deal," *Herald Journal* (Logan, UT), June 23, 2015, http://news.hjnews.com/business/update-maverik-utah-state-university-release-contract-detailing-stadium-naming/article_2c450755-43da-5d2e-bc0b-44d464732899.html.

119. Ibid.

120. Liz Young, "Ohio State Redacts Details of Nationwide, Lids Contracts, Citing 'Trade Secrets,'" *[Ohio State University] Lantern*, May 14, 2014, http://thelantern.com/2014/05/ohio-state-redacts-details-nationwide-lids-contracts-citing-trade-secrets/.

121. See Derek Bok, *Universities in the Marketplace: The Commercialization of Higher Education* (2004), pp. 118–119 (stating that "the principal advantage to the institution—money—will usually seem immediate, tangible, and extremely useful to help meet pressing needs. In contrast, the dangers—to the conscientiousness of faculty, or to the moral education of students, or to the trust of the public—are all intangible and remote. They may never materialize, at least not for a long time, so that it is all too easy to overlook them").

Chapter 7. Private Rights in the Public Interest

1. See Brian Pusser, "Power and Authority in the Creation of a Public Sphere through Higher Education," *Universities and the Public Sphere: Knowledge Creation and State Building in the Era of Globalization* (Brian Pusser ed., 2012), p. 43.

2. This question is more important for colleges and universities than it is for actors outside of academe, precisely because of higher education's

placement in the public sphere. The thoughtless accretion of trademarks by actors outside of higher education may not be advisable, but the ramifications of such behavior are less profound for the public. We expect businesses to make business judgments that are not necessarily in the public's best interests. Higher education certainly is a business, but the public's interest is never far from anything that this sector does—or, at least, it should not be.

3. Private, for-profit companies often are advised to establish a federal trademark portfolio as a method of adding value to the company and substantiating an asking price for it.

4. Some may counter this statement by noting that institutions of higher education are not the only nonprofits that seek and obtain federal trademark registrations that go beyond an institutional name or insignia. Though true, this point is distinguishable from what I argue, precisely because colleges and universities are not interchangeable in design, governance, or aspiration with other nonprofit organizations. Nonprofits outside of higher education answer primarily to those who fund them. In contrast, higher education institutions—whether public or private—at some level answer to the public, which funds colleges and universities both directly and indirectly. The public also reaps the byproducts of higher education—namely, an educated populace—in a way that is not analogous to benefits from the outputs of other nonprofits.

5. Peter Lee, "Patents and the University," 63 *Duke Law Journal* 1 (2013), p. 39.

6. Ibid.

7. Griffith v. Kanamaru, 816 F.2d 624, 628 (Fed. Cir. 1987) (declining Cornell University's request to relax the CAFC requirements for reasonably prompt action between the time when an invention is first conceived and when it is subsequently embodied in a working prototype, due to peculiarities in this university's research environment).

8. Those companies initiating legal actions on patents they have licensed from colleges and universities should be operating companies, not patent trolls created expressly for the purpose of engaging in litigation and obfuscating their connection to university innovations.

9. One reasonable limitation would be prohibiting partnerships with foreign companies.

10. Potential student complaints—for example, "We want jobs from the company, so having to sign away our intellectual property rights is better than not having the company in the classroom at all!"—offer no reason to discount this proposal. Students often individually seek special treatment or dispensations, either from faculty or administrators, that are not in the collective, long-term interest of all students, let alone that of the institution

or the public. If faculty bowed to every student wish, there would be no exams and no grades in most courses offered in higher education.

11. For examples, see Abigail Barrow, La Royce Batchelor, Alex Breger, Nathalie Duval-Couetil, Latanya Scott, Jeffrey Skinner, Phyl Speser, & Phil Weilerstein, *Managing Student Intellectual Property Issues at Institutions of Higher Education: An AUTM Primer* (August 2014), p. 13 (noting that "when students register for classes, the student IP policy could pop up similar to an end-user licensing agreement, which must be read and clicked on before the student navigates away from the page"); Anthony J. Luppino, "Fixing a Hole: Eliminating Ownership Uncertainties to Facilitate University-Generated Innovation," 78 *UMKC [University of Missouri–Kansas City] Law Review* 367 (2009), pp. 427 (suggesting language that faculty could add to their syllabi, telling students "it may be in your best interest to obtain . . . legal advice as soon as possible"), 419 (suggesting that more attorneys should be induced to provide pro bono legal services to students, potentially under the auspices of law-school clinics); TyAnna K. Herrington, *Intellectual Property on Campus: Students' Rights and Responsibilities* (2010), p. 41 (suggesting that "to clarify work arrangements between and among students, their professors, and institutions, it is wise for all parties to create and agree to their roles through contracting, so that all participants in endeavors to develop intellectual products clearly understand who controls the rights to intellectual products and to whom product development will be attributed").

12. Another inadequate suggestion is that individual faculty can be trusted to keep these onerous agreements out of their classrooms. In several disciplines, faculty come from industry and intend to return to industry, making it unlikely that they will zealously guard the intellectual freedom of their students when a corporate sponsor stands at the ready to provide data and information in exchange for copyright assignments or licensing agreements. In-house attorneys can only do so much to educate faculty about the pitfalls of these arrangements, particularly when faculty can be expected to quickly claim academic freedom in defense of these corporate relationships.

13. Carl Straumsheim, "When MOOC Profs Move," *Inside Higher Ed*, March 18, 2014 (describing the copyright-ownership question between institutions and faculty in the context of MOOCs), https://www.insidehighered.com/news/2014/03/18/if-mooc-instructor-moves-who-keeps-intellectual-property-rights/.

14. Otherwise, once alerted to the commercial potential of a faculty member's creative work, the institution could demand a transfer of the copyright at the expense of the faculty member's job (for untenured faculty), or threaten or carry out other forms of retribution.

15. For example, see Colleen Flaherty, "Rights to Scholarly Work," *Inside Higher Ed*, March 26, 2015 (describing faculty uncertainty and consternation at Ohio State University, resulting from proposed changes to the institution's intellectual-property policy specifically related to copyright), https://www.insidehighered.com/news/2015/03/26/ohio-state-faculty-object-draft-intellectual-property-policy/; Andy Thomason, "Pitt Professors Are Wary of Signing Away Intellectual-Property Rights," *Chronicle of Higher Education: The Ticker*, September 11, 2014 (discussing the same issue at the University of Pittsburgh), http://chronicle.com/blogs/ticker/u-of-pittsburgh-professors-are-wary-of-signing-away-intellectual-property-rights/85905/.

16. IRS tax deductions are subject to extremely complicated rules. If the donated property is considered a long-term capital-gain property that had belonged to the donor, the donor may be entitled to a charitable-contribution deduction equal to the value of the donated property. If the donated property does not meet this qualification, however, the deduction is limited to the donor's basis, which typically is the donor's original cost. See 26 U.S.C. § 170(e)(1). Furthermore, a charitable-contribution deduction is completely disallowed if the donor gives less than the entire interest in the property and fails to satisfy certain extremely technical rules. See 26 U.S.C. § 170(f)(3)(A). For example, if a donor owns both the copyright and the donated property and fails to donate the copyright, the tax deduction is denied, because the donation is treated as a gift constituting less than the donor's entire interest. Colleges and universities have no obligation to report these details to the federal government, so the possibility exists that donors may take different positions, depending on the audience. For instance, donors may claim full IRS deductions for their donations, yet insist on imposing restrictions on the donated objects in their interactions with donee institutions, even threatening to withhold future donations as a means of ensuring compliance with their wishes.

17. Laura N. Gasaway, "Copyright Ownership and the Impact on Academic Libraries," 13 *DePaul Journal of Art, Technology & Intellectual Property Law* 277 (2003), p. 295 (describing why libraries may wish to hold the copyrights for donated works).

18. Ibid.

19. For example, see 17 U.S.C. § 115 (describing a compulsory license and a royalty-payment scheme in the context of nondramatic musical compositions) and 17 U.S.C. § 116 (describing a negotiated license scheme for copyright owners and operators of "coin-operated phonorecord players," or jukeboxes).

20. It is both, and changes in academic culture can lead to changes in the law, as the history of affirmative action in higher education shows.

21. Sheldon Krimsky, *Science in the Public Interest: Has the Lure of Profits Corrupted Biomedical Research?* (2003), p. 177.

22. Corynne McSherry, *Who Owns Academic Work? Battling for Control of Intellectual Property* (2003), p. 64.

23. Vanna White v. Samsung Electronics America, Inc., 989 F.2d 1512 (9th Cir. 1993) (Kozinski, J., dissenting).

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